

ESTTA Tracking number: **ESTTA720321**Filing date: **01/13/2016**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91218001
Party	Defendant Mycoskie, LLC
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Signature	/Louis S. Ederer/
Date	01/13/2016
Attachments	2016-01-13 - Mycoskie's Notice of Cross-Motion.pdf(51379 bytes ) 2016-01-13 - Mycoskie's Memorandum Response & Cross- Motion - Public.pdf(1040332 bytes ) 2016-01-13 - L. Ederer Declaration.pdf(644453 bytes ) 2016-01-12 - J. Murray Declaration.pdf(141158 bytes ) Exhibit 1.pdf(4513664 bytes ) Exhibit 2.pdf(58259 bytes ) Exhibit 3.pdf(647294 bytes ) Exhibit 4.pdf(236750 bytes ) Exhibit 5.pdf(181747 bytes ) Exhibit 6.pdf(63416 bytes ) Exhibit 7.pdf(1309109 bytes ) Exhibit 8.pdf(215895 bytes ) Exhibit 9.pdf(47361 bytes ) Exhibit 10.pdf(49247 bytes ) Exhibit 11.pdf(52990 bytes ) Exhibit 12.pdf(125282 bytes ) Exhibit 13.pdf(62718 bytes ) Exhibit 14.pdf(73424 bytes ) Exhibit 15.pdf(201047 bytes ) Exhibit 16.pdf(70484 bytes ) Exhibit 17.pdf(42892 bytes ) Exhibit 18.pdf(91669 bytes ) Exhibit 19.pdf(690530 bytes ) Exhibit 20.pdf(76415 bytes ) Exhibit 21.pdf(68472 bytes ) Exhibit 22.pdf(36522 bytes ) Exhibit 23.pdf(2656812 bytes ) Exhibit 24.pdf(131122 bytes ) Exhibit 25 - PUBLIC - PLACEHOLDER SHEET RE CONFIDENTIALITY.pdf(35805 bytes ) Exhibit 26 - PUBLIC - PLACEHOLDER SHEET RE CONFIDENTIALITY.pdf(32655 bytes ) Exhibit 27.pdf(209999 bytes )

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Matter of Application Serial No. 86/004,044  
Published in the *Official Gazette* on April 29, 2014  
For the Mark: TOMS

In the Matter of Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344  
Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013  
For the Mark: TOMS

TOD'S S.P.A.,

Opposer/Petitioner,

-against-

MYCOSKIE, LLC,

Applicant/Respondent.

**Opposition No.: 91218001 (parent)**  
Cancellation No.: 92061234

**APPLICANT/RESPONDENT MYCOSKIE, LLC'S NOTICE OF CROSS-MOTION TO COMPEL THE ORAL DEPOSITION OF STEFANO SINCINI**


PLEASE TAKE NOTICE that pursuant to 37 C.F.R. § 2.120(e) and TBMP § 523, Applicant/Respondent Mycoskie, LLC (“Mycoskie”) hereby respectfully cross-moves this Court for an order compelling Opposer/Petitioner Tod’s S.p.A. (“Tod’s”) to (i) produce Stefano Sincini — Chief Executive Officer of Tod’s and Chairman of the Board of Tod’s U.S.-based subsidiary Deva, Inc. — for an in-person oral deposition to take place within Southern District of New York; or (ii), in the alternative, produce Mr. Sincini for an in-person oral deposition in Italy. In support of its cross-motion, Mycoskie relies upon (i) the accompanying Memorandum of Law in Opposition to Opposer/Petitioner Tod’s Motion to Amend and in Support of Mycoskie’s Cross-

Motion to Compel the Oral Deposition of Stefano Sincini, which contains, in a single document, arguments in support of both Mycoskie's Opposition to Tod's Motion to Amend and Mycoskie's Cross-Motion to Compel the Oral Deposition of Stefano Sincini; (ii) the Declaration of Louis S. Ederer; and (iii) the Declaration of Jessica Murray.

Pursuant to 37 C.F.R. § 2.127(a) and TBMP § 502.02, Tod's answering papers, if any, are to be served and filed within fifteen (15) days following service of this cross-motion, and any reply papers are to be served and filed within fifteen (15) days following Tod's service of any answering papers.

Dated: January 13, 2015

ARNOLD & PORTER LLP

By:   
Louis S. Ederer  
Matthew T. Salzmann  
Benjamin C. Wolverton

*Attorneys for Applicant/Respondent  
Mycoskie, LLC*



**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing  
**APPLICANT/RESPONDENT MYCOSKIE, LLC'S NOTICE OF CROSS-MOTION TO  
COMPEL THE ORAL DEPOSITION OF STEFANO SINCINI** was served upon the  
following attorneys of record for Opposer/Petitioner Tod's S.p.A. by email and U.S. Mail, this  
13th day of January, 2015:

Richard S. Mandel, Esq.  
Aryn M. Emert, Esq.  
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Benjamin C. Wolverton

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MYCOSKIE, LLC,

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**Opposition No.: 91218001 (parent)**

Cancellation No.: 92061234

**PUBLICLY FILED**

**APPLICANT/RESPONDENT MYCOSKIE, LLC'S MEMORANDUM OF LAW IN  
OPPOSITION TO OPPOSER/PETITIONER TOD'S S.P.A.'S MOTION TO AMEND  
AND IN SUPPORT OF APPLICANT/RESPONDENT'S CROSS-MOTION  
TO COMPEL THE ORAL DEPOSITION OF STEFANO SINCINI**

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## **I. Preliminary Statement**

Applicant/Respondent Mycoskie, LLC (“Mycoskie”), by and through its counsel Arnold & Porter LLP, respectfully submits this memorandum of law and the accompanying Declarations of Louis S. Ederer (“Ederer Decl.”) and Jessica Murray (“Murray Decl.”): (1) in opposition to Opposer/Petitioner Tod’s S.p.A.’s (“Tod’s”) last-minute motion to amend its pleadings; and (2) in support of Mycoskie’s cross-motion, pursuant to TBMP § 523, for an order compelling Tod’s to produce Stefano Sincini — Chairman of the Board of Tod’s U.S.-based subsidiary Deva, Inc. (“Deva”) — for an in-person oral deposition to take place within the district in which Mr. Sincini regularly conducts business, *i.e.*, the Southern District of New York. In the alternative, the Board should order Tod’s to produce Mr. Sincini for an in-person oral deposition in Italy.

On December 10, 2015, one-and-a-half years after the commencement of these proceedings, and three business days before the close of fact discovery, Tod’s counsel made two strategic moves calculated to counteract Tod’s inability to: (1) present any viable explanation for its eight-year delay in challenging any of Mycoskie’s TOMS applications and registrations; and (2) explain away Mycoskie’s survey results showing *zero consumer confusion* as between Mycoskie’s TOMS mark and Tod’s TOD’S mark. Realizing that its case was coming apart, Tod’s and its counsel waited until the eleventh hour to make two transparent and desperate gambits: *first*, to seek to amend its year-and-a-half old pleadings in order to (1) add a new claim alleging that Mycoskie lacked a bona fide intent to use its TOMS trademark for all of the goods in its Class 18 application, and, (2) more revealingly, to withdraw its claim that the TOD’S mark is famous and therefore would be diluted by the registration of Mycoskie’s TOMS mark (the latter amendment, it would subsequently come to light, being for the sole purpose of putting Tod’s in a position to undermine Mycoskie’s survey showing *zero consumer confusion*); and *second*, to amend Tod’s Initial Disclosures to identify Tod’s longstanding Chief Executive

Officer, Stefano Sincini, apparently the only individual within Tod's organization with first-hand knowledge of the reasons why Tod's waited *eight years* to take any action against Mycoskie's TOMS applications and registrations, thereby preserving its ability to call Mr. Sincini as a trial witness with respect to Mycoskie's delay defenses while at the same time preventing Mycoskie from deposing him.

The Board should not condone Tod's bad faith conduct, and should: (1) deny Tod's motion to amend its pleadings; (2) grant Mycoskie's cross-motion to compel the oral in-person deposition of Mr. Sincini in New York or, in the alternative, in Italy; (3) deny Tod's request that the proceedings be suspended; and (4) order that fact discovery be extended solely for the purpose of allowing Mycoskie to conduct Mr. Sincini's deposition.

## **II. Statement of Facts and Summary of Prior Proceedings**

As set forth in detail in the parties' pleadings and the accompanying Declarations of Louis S. Ederer and Jessica Murray, the facts and prior proceedings relevant to Tod's motion and Mycoskie's cross-motion are as follows:

1. Mycoskie, the long-time producer of footwear, apparel and related products under the well-known TOMS mark — which has been the subject of extensive promotion and press coverage since the inception of the brand — has been openly using, applying for and registering its TOMS trademark, both in standard character word and design mark forms, since the inception of the company in 2006. Currently, Mycoskie maintains fifteen such registrations, four of which are incontestable. Ederer Decl. ¶ 3, Ex. 1.

2. Tod's has been registering its TOD'S mark for footwear, apparel and related products in the U.S. since at least 1987, and has vigorously attempted to enforce its mark against third parties (other than Mycoskie) during that period. *Id.* ¶ 4, Ex. 2. Yet, for eight years Tod's did *nothing* to prevent Mycoskie from applying for or maintaining registrations of its TOMS

mark, even though Tod's admits, in its interrogatory responses, that it knew about Mycoskie's existence, and Mycoskie's use and registration of the TOMS mark, since at least as early as 2011. *Id.* ¶ 5, Ex. 3 (Response No. 20).

3. Despite Tod's awareness of Mycoskie's longtime use and registration of its TOMS mark, it was not until August 25, 2014, the date Tod's filed its Notice of Opposition to Mycoskie's application to register the TOMS word mark in Class 18 (the "Opposition Proceeding"), that Tod's made *any attempt* to prevent Mycoskie from maintaining a TOMS application or registration. *Id.* ¶ 6, Ex. 4. Notably, at that time, Mycoskie owned eight other TOMS word mark registrations in other classes going back as far as 2007 — none of which Tod's had ever sought to oppose or cancel — not to mention seven TOMS design mark applications and registrations, none of which Tod's has ever sought to oppose or cancel to this day. *Id.* ¶ 3, Ex. 1.

4. Mycoskie, in its Answer in the Opposition Proceeding, set forth all of the TOMS word and design mark registrations that Tod's had not objected to over many years, including the three incontestable TOMS word mark registrations in Class 25 (for footwear and apparel), all in support of its affirmative defenses of laches, waiver, acquiescence and estoppel (collectively, Mycoskie's "Delay Defenses"). *Id.* ¶ 7, Ex. 5 (p. 2-3).

5. In addition to likelihood of confusion with its TOD'S mark, Tod's also alleged in the Opposition Proceeding that its TOD'S mark was "distinctive and famous and had enjoyed such distinctiveness and fame since long prior to [Mycoskie's] filing of the Application," and that the registration of Mycoskie's TOMS word mark would dilute the distinctive qualities of the TOD'S mark. *Id.* ¶ 6, Ex. 4 (¶¶ 8-9). Significantly, this was not the first time Tod's had alleged in Board proceedings that its TOD'S mark was famous — indeed, two years earlier, in August

2012, Tod's twice made this very same assertion in Notices of Opposition to third-party applications to register the marks PODS (Opposition No. 91206390) and TODES (Opposition No. 91206808). *Id.* ¶¶ 8-9, Ex. 6 at (¶ 9), Ex. 7 (¶¶ 15-20).

6. Even after Mycoskie set out in detail Tod's *eight-year* failure to oppose or seek cancellation of *any* of Mycoskie's TOMS word or design mark applications or registrations in its Answer in the Opposition Proceeding, Tod's took no steps to seek to cancel any of those registrations. Thereafter, discovery proceeded in the Opposition Proceeding for the next seven months, during which time Mycoskie was called upon to produce documents and information relating to its Class 18 TOMS word mark application, including evidence relating to its intent to use the TOMS word mark for the various goods set forth in its Class 18 application. *Id.* ¶ 10, Ex. 8 (Interrog. Nos. 13-15, Request Nos. 25-27). During such discovery, in February 2015 Mycoskie produced thousands of pages of responsive documents and substantive answers to interrogatories. *Id.* ¶¶ 11-13, Ex. 9-11. Further, in response to a March 2015 letter from Tod's counsel relating to alleged deficiencies in Mycoskie's discovery responses, on March 20, 2015, Mycoskie's counsel directed Tod's counsel to a series of specific documents (all of which Mycoskie had produced in February 2015) relating to Mycoskie's bona fide intent to use the TOMS word mark for the goods in its Class 18 application. *Id.* ¶¶ 14-15, Ex. 12 (p. 2), Ex. 13 (p. 2). Thus, Tod's was in receipt of Mycoskie's discovery responses relating to its intent to use the TOMS mark in connection with Class 18 goods at least as early as February 2015.

7. In its Initial Disclosures served on December 3, 2015, Tod's identified the following witnesses as having discoverable information that it might use to support its claims in the Opposition Proceeding: Claudio Castiglioni, Tod's Global General Brand Manager, and Stephanie Rothfeld, Director of Retail of Tod's wholly-owned, New York City-based U.S.

subsidiary, Deva. *Id.* ¶ 16, Ex. 14 (p. 2). Mr. Sincini's name was conspicuously absent from Tod's list of witnesses with discoverable information, despite the fact that he was not only Tod's longstanding Chief Executive Officer, but, it turned out, Chairman of the Board of Tod's U.S. subsidiary, Deva, and, even more significantly, the individual who had authorized the commencement of the Opposition Proceeding. *Id.* ¶ 5, Ex. 3 (Response No. 15). It is now obvious that although Mr. Sincini was, much later in the proceedings, identified by Mr. Castiglioni as the person at Tod's who made the decision not to object to any of Mycoskie's TOMS applications or registrations prior to the filing of the Opposition Proceeding in August 2014, Tod's had deliberately not identified Mr. Sincini in its Initial Disclosures, signaling that it did not intend to call him at trial. Or so Mycoskie was led to believe for a year-and-a-half after the filing of the Opposition Proceeding.

8. In April 2015, at a point where discovery had nearly concluded in the Opposition Proceeding, out of the blue Tod's counsel advised Mycoskie's counsel that Tod's intended to file a Petition for Cancellation against all TOMS word mark registrations that had not yet achieved incontestability (the "Cancellation Action"). *Id.* ¶¶ 17-18, Ex. 15. Although Tod's counsel could offer no explanation for Tod's seven-month delay in bringing the Cancellation Action (other than that Mycoskie was relying on Tod's failure to take any such action to support its Delay Defenses, and Tod's therefore felt compelled to challenge Mycoskie's registrations), he nevertheless advised Mycoskie's counsel that Tod's had just then decided to file the Cancellation Action. *Id.* ¶ 19.

9. At the same time, Tod's counsel further requested that Mycoskie's counsel consent to the consolidation of the Cancellation Action with the Opposition Proceeding, since both proceedings presented common issues of law and fact, namely: (1) whether there was a

likelihood of confusion as between the parties' respective marks; (2) whether the registration of the TOMS mark diluted the distinctive qualities of the famous TOD'S mark; and (3) whether Tod's delay in bringing any proceedings with respect to Mycoskie's TOMS applications and registrations would support Mycoskie's Delay Defenses. Since both proceedings did, in fact, focus on the same key issues — that is, likelihood of confusion, dilution and delay — Mycoskie's counsel reluctantly consented to the proposed consolidation of the Cancellation Action with the Opposition Proceeding. *Id.* ¶¶ 18, 20.

10. Accordingly, on April 8, 2015, Tod's counsel filed the Cancellation Action. *Id.* ¶ 21, Ex. 16. Shortly thereafter, on May 27, 2015, Tod's counsel filed a Consent Motion to Consolidate the two proceedings. In its motion papers, Tod's set forth the following grounds for its motion: (1) both proceedings involved identical parties; (2) both proceedings involved common questions of fact and law; and (3) in both proceedings, Tod's grounds for opposing and cancelling Mycoskie's registrations for its TOMS marks were based on Tod's ownership of its TOD'S mark. *Id.* ¶ 22, Ex. 17 (p. 3-4).

11. Subsequently, on May 28, 2015, the Board granted Tod's Consent Motion to Consolidate, and reset the schedule in the Consolidated Proceedings. *Id.* ¶ 23, Ex. 18. Thereafter, on July 20, 2015, Tod's served Supplemental Initial Disclosures in the Consolidated Proceedings, once again identifying Mr. Castiglioni and Ms. Rothfeld, and adding Silvia Pinotti, Tod's Advertising Planner Associate for Online Commerce, to Tod's list of witnesses with discoverable information. *Id.* ¶ 24, Ex. 19 (p. 2-3). As with its first set of Initial Disclosures, Tod's did not identify Mr. Sincini as a witness with discoverable information. *Id.*

12. Notably, in the Cancellation Action, Tod's sought cancellation only of Mycoskie's TOMS word mark registrations — no claims were made with respect to any of



Mycoskie's TOMS design mark registrations. And, as with the Opposition Proceeding, the Cancellation Action sought relief based on claims of both likelihood of confusion and dilution, with Tod's again pleading that the TOD'S mark "is distinctive and famous and has enjoyed such distinctiveness and fame since long prior to [Mycoskie's] filing of the applications that matured into the Registrations." *Id.* ¶ 21, Ex. 16 (¶¶ 11-12).

13. In its Answer in the Cancellation Action, Mycoskie interposed the same Delay Defenses previously asserted in the Opposition Proceeding, and again recounted the fact that prior to August 25, 2014, and then for the seven months after Tod's had filed its Notice of Opposition, Tod's had taken *no steps whatsoever* to object to or seek cancellation of any of Mycoskie's TOMS word mark registrations. Mycoskie further noted that the Cancellation Action did not seek cancellation of Mycoskie's three incontestable TOMS word mark registrations, or any of Mycoskie's TOMS design mark registrations. *Id.* ¶ 25, Ex. 20 (p. 3-8).

14. Following the Board's May 28, 2015 consolidation of the Opposition Proceeding and the Cancellation Action, the parties again proceeded to engage in discovery. However, at no time after it filed its Cancellation Action (that is, until the last day of discovery on December 15, 2015) did Tod's propound any new written discovery requests, instead relying only on the requests it previously served in the Opposition Proceeding on December 11, 2014, which requested information solely concerning Mycoskie's Class 18 application. *Id.* ¶ 10, Ex. 8.

15. On October 8 and 9, 2015, Mycoskie's counsel took the depositions of two of the witnesses identified in Tod's Initial Disclosures, Mr. Castiglioni and Ms. Rothfeld. Among other things, Mr. Castiglioni, who had verified Tod's Answers to Interrogatories, was questioned about his knowledge of the reasons why Tod's had delayed for years in bringing *any* proceedings objecting to Mycoskie's TOMS registrations or applications. *Id.* ¶ 26, Ex. 21 (48:7 - 52:15). In

response, Mr. Castiglioni testified that although he personally had discussed his concerns about Mycoskie's use of the TOMS mark with Mr. Sincini at least as early as 2011, Tod's, and, in particular, Mr. Sincini, had decided to take no action until 2014, when Tod's filed the Opposition Proceeding. *Id.* Mr. Castiglioni further confirmed that Mr. Sincini, who was responsible for trademark-related issues of this nature, was the person who made the decision to wait until August 25, 2014 to file any trademark proceedings against Mycoskie. *Id.* (35:14 - 40:2). Finally, both Mr. Castiglioni and Ms. Rothfeld confirmed that during this entire period, Mr. Sincini has been employed as Chairman of the Board of Tod's U.S. subsidiary, Deva, and regularly traveled to the U.S., and in particular New York City, to conduct Tod's and Deva business, and to attend Deva Board meetings. *Id.* ¶¶ 26-27, Ex. 21 (19:22 - 27:8), Ex. 22 (24:24 - 26:17).

16. And yet, at no time following Mr. Castiglioni's and Ms. Rothfeld's depositions did Tod's counsel see fit to further supplement Tod's Initial Disclosures to identify Mr. Sincini as a witness with knowledge of discoverable information relating to Mycoskie's Delay Defenses, or any other issue for that matter — that is, until December 10, 2015, three business days before the close of discovery. *Id.* ¶ 28, Ex. 23 (p. 3).

17. On November 15, 2015, Mycoskie disclosed an expert report setting forth the results of a likelihood of confusion survey conducted by Mycoskie's survey expert, E. Deborah Jay, Ph.D. Dr. Jay's survey, which was conducted in the "*Eveready*" survey format typically used for testing marks that are alleged to be famous (just as Tod's had alleged in all pleadings it had ever filed with the Board, including the pleadings in these proceedings),<sup>1</sup> showing that not a

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<sup>1</sup>An *Eveready* survey "presents respondents with the contested mark, and then poses open-ended questions (questions that require respondents to answer in their own words) to measure the potential for confusion." E. Deborah Jay, *He Who Steals My Good Name: Likelihood-of-Confusion Surveys in TTAB Proceedings*, 104

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single survey respondent was confused and believed that there was any connection whatsoever between the TOMS and TOD'S marks, and/or between the TOMS mark and Tod's. That is, the result of Dr. Jay's survey was *zero consumer confusion*. *Id.* ¶ 29, Ex. 24 (p.13-14).

18. Facing a December 15, 2015 discovery cutoff, Tod's counsel nevertheless waited until November 19 and 20, 2015 to depose any of Mycoskie's witnesses. And, although one would not know it from examining Tod's motion papers, during these depositions Tod's counsel questioned not just one, but two Mycoskie witnesses about the issue of Mycoskie's intent to use its TOMS mark for the goods set forth in Mycoskie's Class 18 application: (a) Jessica Murray, Mycoskie's Director of Intellectual Property; and (b) Brigid Stevens, Mycoskie's Director of Marketing. Indeed, Tod's neglects to mention in its motion to amend that its counsel first questioned Ms. Murray about this subject on November 19, 2015, which is not surprising, since Ms. Murray testified that Mycoskie *did* in fact intend to use the TOMS mark on all such goods. Realizing, however, that Ms. Murray's testimony was not helpful to Tod's position, Tod's counsel cut short her questioning, apparently figuring he might have better luck with Ms. Stevens the following day. *Id.* ¶ 30, Ex. 25 (42:16 - 46:19).<sup>2</sup>

19. An examination of counsel's limited questioning of Ms. Stevens on this subject, however, reveals that she too did not testify to any facts that would support the proposition that

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Trademark Reporter No. 5, p. 1144 (2014). The *Eveready* format is the "most utilized format for assessing likelihood of confusion," and has been described by the Board as "reliable and therefore of probative value on the issue of likelihood of confusion," "persuasive," and "often approved." *Id.* at 1149-50 (citing TTAB proceedings). An *Eveready* survey is particularly probative of likelihood of confusion where an opposer or petitioner has alleged its mark to be famous. *Clear Choice Holdings, LLC v. Implant Direct, Int'l*, 2013 WL 5402082, at \*10 (T.T.A.B. Aug. 26, 2013) ("Given that opposer characterizes its mark as famous, we question why opposer's expert chose not to follow the *Ever-Ready* survey format, which we have accepted and which has been called the 'gold standard' in likelihood of confusion cases.") (footnotes omitted).

<sup>2</sup> As discussed below, had Tod's counsel asked Ms. Murray direct questions about Mycoskie's intent to use the TOMS mark on each of its applied-for Class 18 goods, Tod's would have learned that, in fact, Mycoskie did have such an intent. Murray Decl. ¶¶ 17-23.

Mycoskie did not have a bona fide intent to use the TOMS mark for all goods in Mycoskie's Class 18 application. In fact, during the course of Ms. Stevens' nearly three hour deposition, Tod's counsel failed to ask Ms. Stevens *a single question* about Mycoskie's intent to use the TOMS mark at the time Mycoskie filed its Class 18 application, instead focusing his questions on whether Mycoskie *presently* intended to produce each of the goods listed in the application. *Id.* ¶ 31, Ex. 26 (115:9 - 119:7). As with his questioning of Ms. Murray, Tod's counsel stopped far short of asking Ms. Stevens any direct questions that might actually support Tod's contention that Mycoskie did not have a bona fide intent to use the TOMS mark for all the applied-for goods at the time it filed its Class 18 application. Tellingly, of the 161 transcript pages for these two witnesses' depositions, Tod's counsel asked a combined total of seven transcript pages worth of questions on this issue. *Id.*

20. Thereafter, on December 10, 2015, three business days before the close of fact discovery, and without warning, Tod's counsel wrote to Mycoskie's counsel indicating that Tod's wished to do two things at this late date: *first*, to amend its pleadings to (1) add a claim opposing Mycoskie's Class 18 application based on Mycoskie's alleged lack of a bona fide intent to use the TOMS mark for all goods set forth in that application<sup>3</sup> (an issue never before raised in the Opposition Proceeding), relying on Ms. Stevens' testimony as well as the documents produced and interrogatory answers provided by Mycoskie back in February 2015, and also (2) to withdraw its dilution claim from its Opposition and Cancellation pleadings, thereby removing any allegation that the TOD'S mark was famous. In an apparent attempt to conceal the

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<sup>3</sup> In Tod's proposed amended pleadings, Tod's alleges that Mycoskie did not have a bona fide intent to use the TOMS mark only on the following goods in its Class 18 application: key bags, key wallets, garment bags for travel, wheeled shopping bags and purses, jewelry pouches, and leashes for animals. As stated in Ms. Murray's declaration, however, and as Ms. Murray would have testified had she been asked, Tod's had every intention of using its TOMS mark in connection with each of these goods at the time it filed its application. Murray Decl. ¶¶ 17-23.

implications of the latter proposed amendment, nearly the entire focus of Tod's counsel's request was on the addition of the "lack of bona fide intent to use" claim. *Id.* ¶ 32, Ex. 27.

21. *Second*, Tod's counsel served its second set of Supplemental Initial Disclosures, for the first time in the year-and-a-half old proceedings identifying Mr. Sincini as a witness with discoverable information that Tod's may use to support its claims at trial. Among the topics about which Mr. Sincini was listed as having discoverable information was the "enforcement of [the] TOD's marks," a topic on which Tod's had identified no previous witness as having discoverable information.<sup>4</sup> While Tod's counsel stated in his cover email that Tod's had no obligation to so supplement its Initial Disclosures, and that it was doing so merely "in an abundance of caution," this maneuver was obviously designed to allow Tod's to present Mr. Sincini as a fact witness at trial on Mycoskie's crucial, yet-to-be-responded-to Delay Defenses, while at the same time preventing Mycoskie from taking a discovery deposition of Mr. Sincini. *Id.* ¶ 28, Ex. 23 (p. 3).

22. In response, Mycoskie's counsel, while objecting to Tod's maneuvers, indicated that Mycoskie would consider consenting to the requested amendment provided that Mycoskie be permitted to (a) produce, if necessary, additional documents or witnesses in response to Tod's new "lack of bona fide intent to use" claim, and (b) take Mr. Sincini's oral deposition in the U.S., given his eleventh-hour identification. *Id.* ¶ 33, Ex. 28. Not surprisingly, Tod's counsel declined Mycoskie's proposal, instead taking the position that since Mr. Sincini is an Italian resident (notwithstanding his regular visits to New York City to carry out his duties as Chairman of the

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<sup>4</sup> See Ederer Decl. ¶ 28, Ex. 23 (p. 3). Mr. Sincini is also described as possessing discoverable information with respect to a litany of other subjects, about which neither Tod's nor any of its witnesses had ever indicated that he might be knowledgeable. *See id.*

Board of Deva), Tod's would rely on TBMP § 404.03(b), which provides that foreign residents may generally be deposed only by way of written questions. *Id.* ¶ 34, Ex. 29.

23. Three business days later, on December 15, 2015, the true reason for Tod's proposed pleading amendments became clear. On that date, Tod's served a rebuttal expert report purporting to respond to Dr. Jay's survey finding *zero consumer confusion*, in which Tod's survey expert, Sarah Butler, took the position that since the TOD'S mark was *not* famous in the U.S., Dr. Jay had conducted the wrong type of confusion survey. *Id.* ¶ 35, Ex. 30 (¶ 20). Then, using this as an excuse, Ms. Butler went on to conduct her own survey in the "*Squirt*" survey format, a format which, unlike the *Eveready* format, is infrequently used, and only when the senior user/registrant's mark is not famous (and typically is less well known than the junior user/applicant's mark), and requires that the senior user/registrant's mark (here, TOD'S) be shown to interviewees.<sup>5</sup> *Id.* (¶¶ 35-45). Not surprisingly, Ms. Butler concluded that there was a likelihood of confusion between the TOMS and TOD'S marks. *Id.* (¶ 56). Remarkably, Ms. Butler's survey made no mention of the fact that for the previous one-and-a-half years, Tod's had been alleging that its TOD'S mark was famous in the U.S. (an allegation that still stands in these proceedings), and that Dr. Jay had relied on Tod's allegations of fame in deciding to perform her *Eveready* survey. Instead, Ms. Butler stated matter-of-factly in a footnote: "It is my understanding that Tod's is in the process of amending its pleading and will no longer be pursuing a dilution claim requiring proof of fame." *Id.* (¶ 20 n.19).

24. Following receipt of the Butler rebuttal survey, it became abundantly clear that the real reason for Tod's belated attempt to amend its pleadings in these proceedings had

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<sup>5</sup> See Jerre B. Swann, *Likelihood of Confusion Studies and the Straitened Scope of Squirt*, 98 Trademark Reporter No. 3, p. 740 (2008) ("Over time, the Squirt format has come to be used in cases where the accessibility of the senior mark in consumers' memory is *low to non-existent* . . .") (emphasis added).

absolutely nothing to do with a legitimate desire to add a claim based on lack of a bona fide intent to use — the alleged basis for which Tod's had been in possession of since as early as February 25, 2015 — but rather to withdraw any allegation that the TOD'S mark was famous, so as to provide an artificial foundation for Ms. Butler to conduct her own “rebuttal” survey. Accordingly, Mycoskie's counsel informed Tod's counsel that Mycoskie would vigorously oppose the proposed amendment, and would also seek the oral deposition of Mr. Sincini in New York, in view of counsel's eleventh-hour attempt to include him as a trial witness. *Id.* ¶ 36, Ex. 31.

### **ARGUMENT**

#### **III. The Board Should Deny Tod's Motion to Amend**

##### **A. Tod's Attempt to Amend Its Pleadings is a Bad Faith Tactic Designed to Circumvent the Results of Mycoskie's Survey Evidence.**

Although the Board may grant leave to amend pleadings when justice so requires, it should decline to do so where the moving party's requested amendment is motivated by bad faith or dilatory tactics. Fed. R. Civ. P. 15(a); TBMP § 507.02; *Kellogg*, 2005 WL 1581551, at \*3 (quoting *Foman v. Davis*, 371 U.S. 178, 182 (1962)). Whether leave to amend has been sought in bad faith depends upon the moving party's reasons for not seeking leave to amend its pleadings earlier. See *Larios v. Nike Retail Servs., Inc.*, No. 11-cv-1600, 2013 WL 4046680, at \*3 (S.D. Cal. Aug. 9, 2013). Specifically, a proposed amendment should be denied where the moving party has sought to primarily gain a tactical advantage or avoid a loss on the merits simply by belatedly altering its claims. See *Larios*, 2013 WL 4046680, at \*3.<sup>6</sup>

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<sup>6</sup> See also *Rusyniak v. Gensini*, 629 F. Supp. 2d 203, 216 (N.D.N.Y. 2009) (“When it appears that leave to amend is sought in anticipation of an adverse ruling on the original claims . . . the court is free to deny leave to amend.”); *Lee v. Regal Cruises, Ltd.*, 916 F. Supp. 300, 304 (S.D.N.Y. 1996) (denying plaintiff's motion for leave to amend its complaint on grounds that amendment was sought in bad faith since plaintiff had moved to amend only once it became clear plaintiff was “in serious danger of losing”).

As the above chronology demonstrates, the true impetus for Tod's eleventh-hour motion to amend was not, as Tod's disingenuously claims, its revelation at Ms. Stevens' deposition that Mycoskie lacked a bona fide intent to use its TOMS mark with respect to all of the goods in its Class 18 application (particularly since, as explained above, this is not even close to what Tod's counsel asked Ms. Stevens or Ms. Murray, nor what they testified to). Rather, Tod's true motivation for seeking leave to amend was Dr. Jay's expert report, showing that *not a single consumer* believed the TOMS mark to be sponsored, approved by, or in any way affiliated with Tod's. Recognizing that Dr. Jay's *Eveready*-format confusion survey, which was based on Tod's own allegation that its TOD'S mark was famous, would completely undermine Tod's likelihood of confusion claim, Tod's needed to come up with some excuse for arguing that Mycoskie's confusion survey should simply be disregarded.

Ultimately, Tod's settled on sacrificing its dilution claim — and, thereby, its allegation that the TOD'S mark is famous in the U.S. — so that its expert could critique Dr. Jay's decision to conduct an *Eveready* survey. All of this became clear when Tod's served what purported to be its “rebuttal” expert disclosures on December 15, 2015, five days after Tod's counsel had attempted to obtain Mycoskie's counsel's consent to Tod's proposed amendments. Thus, in her December 15, 2015 rebuttal report, Ms. Butler criticized Dr. Jay for conducting an *Eveready* survey, since the TOD'S mark is *not* sufficiently famous to be known to consumers. Ederer Decl. ¶ 35, Ex. 30 (¶ 20). Ms. Butler went on to explain that the *Squirt* survey she conducted — which purports to show a minimal level of consumer confusion (just as *Squirt* surveys are designed to do)<sup>7</sup> — was the proper way to measure consumer confusion. So, not only did Ms.

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<sup>7</sup> Unlike an *Eveready* survey, a *Squirt* survey “exposes respondents to both parties’ marks (rather than just the contested mark), and then asks closed-ended questions (questions that offer respondents a list of answer choices) to assess likelihood of confusion.” Jay, *He Who Steals My Good Name*, at 1145; see also Swann, *Likelihood of*  
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Butler criticize Dr. Jay for having used the wrong survey format, but she then took the opportunity to conduct her own survey, the basis and methodology for which cannot now be rebutted by Mycoskie.

To date, Tod's has yet to offer any explanation for its about-face concerning its longstanding dilution claim, or when exactly Tod's discovered that its TOD'S Mark was no longer famous. Accordingly, the Board should not reward Tod's belated attempt to gain a tactical advantage by amending its pleadings, but should instead deny in its entirety Tod's motion to amend on the grounds that such request has been made in bad faith.

**B. Tod's Undue Delay in Seeking to Amend Its Pleadings Is Without Justification and Would Unfairly Prejudice Mycoskie.**

In addition, the Board should deny leave to amend since the proposed amendment would severely prejudice Mycoskie. Fed. R. Civ. P. 15(a); TBMP § 507.02. "The question of prejudice is largely dependent upon the timing of the motion to amend, and the burden to explain a delay is on the party that seeks leave to amend." *Kellogg Co. v. Shakespeare Co.*, Opp. 91154502, 2005 WL 1581551, at \*2-3 (T.T.A.B. June 30, 2005); *Media Online Inc. v. El Clasificado, Inc.*, 88 U.S.P.Q.2d 1285, 2008 WL 4419361, at \*2 (T.T.A.B. Sept. 29, 2008) ("The timing of the motion

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*Confusion Studies and the Straitened Scope of Squirrt*, at 740 (since the *Squirrt* format is used in cases where the senior mark is not well known, "it must be made *externally available* to respondents as part of the survey design") (emphasis in original). The use of "*Squirrt*" surveys in Board proceedings has been roundly criticized, given that the format's use of leading questions — through which respondents are first shown examples of the registrant's mark and then immediately asked whether that mark is affiliated with any of the marks appearing on a list of names — virtually guarantees that at least some survey respondents will select the registrant's name even if they are not familiar with the registrant. See Jay, *He Who Steals My Good Name*, at 1162 ("[T]he Board for the most part has been critical of *Squirrt* surveys in opposition and cancellation proceedings."); Swann, *Likelihood of Confusion Studies and the Straitened Scope of Squirrt*, at 740 ("Because a *Squirrt* test uses closed-ended questions, it has historically been criticized by pundits and the courts.") (emphasis in original); *Marshall Field & Co. v. Mrs. Field's Cookies*, 25 U.S.P.Q.2d 1321, 1333-34 (T.T.A.B. 1992) (finding *Squirrt* survey questionnaire to be "seriously flawed" as a result of leading questions); *Bass Pro Trademarks, LLC v. Sportsman's Warehouse, Inc.*, 89 U.S.P.Q.2d 1844, 1859 (T.T.A.B. 2008) (according *Squirrt* survey "little probative value" since survey suggested an affiliation between the parties' marks).

for leave to amend is a major factor in determining whether respondent would be prejudiced by allowance of the proposed amendment.”). A motion for leave to amend must be filed as soon as the asserted ground for such amendment becomes apparent, and any unexplained delay in filing such a motion can by itself render the proposed amendment untimely. *Media Online*, 2008 WL 4419361 at \*2.

Here, Tod’s fails to carry its burden of explaining the basis for its *one-and-a-half year delay* in seeking to amend its pleadings, particularly since the facts upon which it purports to have based its proposed amendment to add a lack of bona fide intent claim were known to Tod’s at the outset of discovery (and, presumably, it knew its TOD’S mark was not famous even before it filed these proceedings). As detailed above, in February 2015 Tod’s received a production of documents from Mycoskie showing that Mycoskie had a bona fide intent to use the TOMS Mark in connection with the goods identified in Mycoskie’s Class 18 application. Ederer Decl. ¶¶ 10-13, Ex. 8 (Interrog. Nos. 13-15, Request Nos. 25-27), Ex. 9-11. In addition, on February 17, 2015, Mycoskie served answers to interrogatories (executed by Ms. Murray), in which it responded to questions concerning its intent to use the TOMS mark on the applied-for Class 18 goods. *Id.* ¶ 37, Ex. 32 (Response Nos. 13-15). Then, on March 20, 2015, Mycoskie identified various documents it had produced in response to Tod’s requests which demonstrated Mycoskie’s bona fide intent to use its TOMS mark on the applied-for Class 18 goods. *Id.* ¶ 15, Ex. 13 (p. 2). Notably, it is that document production and those answers to interrogatories (in addition to Ms. Stevens’ testimony, which does not support Tod’s proposed new claim),<sup>8</sup> that

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<sup>8</sup> As explained above, Tod’s claim that it first learned the basis for its bona fide lack of intent to use claim during the deposition of Ms. Stevens is demonstrably false. Tod’s counsel did not ask even a *single question* about Mycoskie’s intent to use the TOMS mark at the time it filed its application. Ederer Decl. ¶ 31, Ex. 26 (115:9 - 119:7). Indeed, particularly in light of Tod’s counsel’s abandonment of this exact line of questioning during Ms. Murray’s deposition — as well as Tod’s convenient failure to even mention her deposition testimony, that Mycoskie *did*, in

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Tod's relies on as a basis for its proposed amendment.<sup>9</sup> In light of the fact that the purported grounds for Tod's new opposition claim were known to Tod's (or, as Tod's maintains, conceded by Mycoskie) *nearly a year ago*, there is simply no justification for Tod's last-minute attempt to switch out the issues that have long been the focus of these proceedings — proceedings which were consolidated at Tod's request precisely *because* the same issues, *i.e.*, likelihood of confusion, dilution and Tod's delay, were involved. *Id.* ¶ 18, Ex. 15.

Although such an unjustified delay itself requires the denial of Tod's motion to amend, the motion should also be denied due to the extreme prejudice Mycoskie will suffer if the amendment is allowed. *First*, with respect to Tod's claim that Mycoskie lacked a bona fide intent to use the TOMS mark, it is introducing into these year-and-a-half old proceedings a completely new issue. Previously, the only issues presented by Tod's were related to its confusion and dilution claims, and Mycoskie's defenses to such claims that Tod's had unduly delayed in waiting eight years to bring them — indeed, as Tod's counsel himself stated in Tod's Consent Motion to Consolidate, the very basis for consolidation was that both the Opposition and Cancellation Proceedings presented only those common issues.

*Second*, Tod's proposed withdrawal of its dilution claim would be severely prejudicial to

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fact, intend to use the TOMS mark in connection with each good listed in its Class 18 application — it is clear that Tod's reliance on its belated discovery of a potential claim is complete pretext. In fact, had Tod's counsel bothered to complete his questioning of Ms. Murray on this subject, he would have learned that the intended development of every single one of the goods listed in Mycoskie's Class 18 application — including the six products (key bags, key wallets, garment bags for travel, wheeled shopping bags and purses, jewelry pouches, and leashes for animals) that Tod's claims Mycoskie did not have a bona fide intent to make at the time it filed its application — had been discussed and confirmed by Ms. Murray with Mycoskie's product development team prior to the July 8, 2013 filing of the application. Murray Decl. ¶¶ 17-23.

<sup>9</sup> Even more tellingly, Tod's claims in its motion papers that Mycoskie "conceded," in response to Tod's Interrogatory No. 14, that "the only steps [Mycoskie] took with regard to its intended use of the TOMS mark in connection with the goods set forth in the Application were with respect to its handbags." Opp./Pet. Br. at 3. According to Tod's, Mycoskie "conceded" the basis for Tod's last-minute amendment when it responded to Tod's interrogatories — that is, on February 17, 2015, nearly a year ago.

Mycoskie, given Tod's obvious attempt to undermine the survey results commissioned by Mycoskie at significant expense, while at the same time preventing Mycoskie from offering its own rebuttal to Tod's so-called "rebuttal" report and survey. Indeed, if Tod's proposed amendment is not allowed, then its rebuttal goes out the window, and its likelihood of confusion claim is severely undermined. Accordingly, under no circumstances should Tod's be allowed to retract its allegation of fame at this late date, when it could have done so any time during the last year-and-a-half, since Mycoskie conducted a costly survey specifically based on Tod's allegations of fame.<sup>10</sup> In its brief, Tod's argues that there would be no prejudice if it were to withdraw its dilution claim, because it has decided not to pursue that claim at trial in any event.<sup>11</sup> That, however, is beside the point. The issue is not whether Tod's plans to support the claim, but whether it can retract its allegations of fame now for tactical reasons. This it should not be allowed to do.<sup>12</sup>

In light of the substantial prejudice Mycoskie would suffer as a result of Tod's proposed amendment, and the fact that these amendments should have been made long ago, the Board should deny Tod's motion to amend in all respects. *See Media Online*, 2008 WL 4419361 at \*2 (denying petitioner's motion to amend where added claims were "based on facts within

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<sup>10</sup> Ederer Decl. ¶ 29, Ex. 24 (p. 2, n.3).

<sup>11</sup> Opp./Pet. Br. at 6 n.1.

<sup>12</sup> To the extent the Board allows Tod's to amend its pleadings to add a lack of bona fide intent to use claim, Mycoskie should be allowed the opportunity to supplement its production or identify additional witnesses, if necessary, to present any additional evidence of its intent to use the TOMS mark in connection with the applied-for Class 18 goods. While Tod's may argue that Mycoskie has already had this opportunity, the fact remains that the bona fides of Mycoskie's intent to use has never been an issue in this proceeding, and on that basis Mycoskie objected to Tod's discovery requests going to that issue on the grounds of relevance and otherwise. *See Ederer Decl. ¶ 37-38, Ex. 32 (Response Nos. 13-15), Ex. 33 (Response Nos. 25-27)*. If the Board will now allow this amendment, to avoid prejudice to Mycoskie, it should allow Mycoskie a complete opportunity to defend itself against Tod's new claim. *See Dollar Tree Stores, Inc. v. Everything for a Dollar Store, Inc.*, Cancellation No. 26850, 2001 WL 315045, at \*2 (Mar. 30, 2001). Further, and in any case, the Board should under no circumstances allow Tod's to retract its longstanding allegations that the TOD'S mark is famous in the U.S., in light of the extreme prejudice to Mycoskie, as discussed above.

petitioner's knowledge" when it filed its pleadings, and since petitioner's seven-month delay in amending its pleadings "would unfairly prejudice respondent by increasing the time, effort, and money that respondent would be required to expend to defend against petitioner's challenge to its registration"); *Kellogg*, 2005 WL 1581551, at \*3 (denying opposer's motion to amend where "[a]ll of the facts forming the basis for the amended grounds were known or should have been known far earlier," and where opposer offered "no explanation or sufficient justification" for its failure to amend its pleadings when it became aware or could have become aware of the basis for such amendment); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 U.S.P.Q.2d 1540, 2001 WL 1869327, at \*2 (T.T.A.B. Dec. 19, 2001) (denying opposer's motion to add dilution claim despite finding that applicant would *not* be prejudiced by the amendment, since proposed amendment was based on facts within opposer's possession eight months prior to its motion for leave to amend). As Tod's has offered no legitimate justification or explanation for its *year-and-a-half delay* in seeking to amend its pleadings, and as this unjustified delay would unduly prejudice Mycoskie, Tod's motion to amend should be denied for these reasons alone.

#### **IV. The Board Should Grant Mycoskie's Cross-Motion and Compel Tod's To Produce Stefano Sincini for Oral Deposition**

As noted above, together with its bad faith attempt to amend its pleadings to gain a tactical advantage, simultaneously (and, once again, three business days before the close of discovery) Tod's counsel informed Mycoskie that "in an abundance of caution," it was amending its Initial Disclosures in the Consolidated Proceedings to add its CEO, Mr. Sincini, who is also the longstanding Board Chairman of Tod's U.S. subsidiary company, as an individual with discoverable information in this case. Obviously, Mr. Sincini was being added to the Initial Disclosures so that Tod's could use him as a witness in the trial phase, and even more obviously Tod's waited until the close of discovery to identify him, so that it would be too late for

Mycoskie to take his deposition. Such tactics should not be countenanced, and the Board should order Mr. Sincini to appear for an in-person, oral deposition in New York.

**A. The Board Should Permit Mycoskie to Depose Tod's Belatedly-Identified Witness Stefano Sincini.**

It is beyond dispute that Tod's yet-to-be explained delay in opposing Mycoskie's eight-year use and registration of its TOMS word mark — an issue prominently raised by Mycoskie in September 2014 in the Opposition Proceeding, and later in the Cancellation Action, as the foundation for its Delay Defenses — has become a key issue in these proceedings. As detailed above, however, notwithstanding that this issue is central to Tod's ability to challenge Mycoskie's registration of the TOMS mark, Tod's has *never* given any indication over the past year-and-a-half that it planned to introduce testimony from Mr. Sincini on this or any other subject, instead effectively signaling to Mycoskie, on two separate occasions, that it *did not* intend to rely on Mr. Sincini's testimony. First, on December 3, 2014, over a month after Mycoskie first asserted its Delay Defenses in the Opposition Proceeding, Tod's served its Initial Disclosures, listing only two individuals who were likely to have discoverable information — Mr. Castiglioni and Ms. Rothfeld — neither of whom was identified as having any information concerning Tod's decision to file its Notice of Opposition, much less why Tod's had not taken any action against Mycoskie's registrations of the TOMS mark for eight years. Mr. Sincini, on the other hand, was conspicuously absent from this list. Ederer Decl. ¶ 16, Ex. 14.

Subsequently, on July 20, 2015, after Tod's felt compelled to deal with Mycoskie's Delay Defenses by attacking Mycoskie's TOMS registrations in the Cancellation Action<sup>13</sup> — that is, only those registrations that had not become incontestable — Tod's served Supplemental Initial Disclosures, this time identifying only Ms. Pinotti as an additional person with discoverable

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<sup>13</sup> See Ederer Decl. ¶ 19.

information. *Id.* ¶ 24, Ex. 19. Notably, these disclosures came after Mycoskie had once again asserted its Delay Defenses in its May 18, 2015 Answer to the Cancellation Action (and eight months after Mycoskie had raised the same issues in its Answer to the Opposition Proceeding), and *once again* these disclosures failed to make any mention of Mr. Sincini.<sup>14</sup>

Subsequent events have made clear that Mr. Sincini has at all times possessed relevant and discoverable information relating to the central issue in this case, that is, Tod's delay in taking any action with respect to Mycoskie's TOMS registrations. His belated inclusion in Tod's Supplemental Initial Disclosures, three business days before the close of discovery and "in an abundance of caution," indicates that Tod's has long had every intention of relying on his trial testimony on this topic. Indeed, during his October 9, 2015 deposition, Mr. Castiglioni testified that he had nothing to do with Tod's decision to commence these proceedings or to challenge Mycoskie's registrations of the TOMS mark, and that Mr. Sincini was responsible for making such decisions on Tod's behalf.<sup>15</sup> Nevertheless, although Tod's begrudgingly acknowledged that Mr. Sincini was the person who made the initial decision to bring the Opposition Proceeding (both at Mr. Castiglioni's deposition and in Tod's September 11, 2015 responses to Mycoskie's Second Set of Interrogatories),<sup>16</sup> at no point did it ever give any indication that Mr. Sincini

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<sup>14</sup> The Board has repeatedly stated that, although Fed. R. Civ. P. 26(a)(1) does not require parties to identify in their initial disclosures particular individuals as prospective trial witnesses *per se*, they are required to identify any individuals with discoverable information that the disclosing party *may use to support its claims or defenses*. *AmeriCareers LLC v. Internet Employment Linkage, Inc.*, Opp. No. 91198027, 2011 WL 5014032, at \*2 (T.T.A.B. Oct. 5, 2011); *Jules Jurgensen/rhapsody, Inc. v. Baumberger*, 91 U.S.P.Q.2d 1443, 2009 WL 1940147, at \*1 n.1 (T.T.A.B. July 6, 2009). In practice, however, individuals identified in initial disclosures can "reasonably be viewed as possible witnesses." *Jules Jurgensen/rhapsody, Inc.*, 2009 WL 1940147, at \*1 n.1.

<sup>15</sup> See Ederer Decl. ¶ 26, Ex. 21 (35:14 - 40:2).

<sup>16</sup> On December 3, 2014, Mycoskie served an interrogatory calling upon Tod's to identify the date upon which it became aware of Mycoskie's use of the TOMS mark, but Tod's maintained that it was unable to determine such date. Only when Mycoskie pointedly asked Tod's to identify the date upon which the TOMS mark became known to the person who decided that Tod's should file the Opposition Proceeding did Tod's acknowledge, on September 11, 2015, that Mr. Sincini was at all involved in these matters. Ederer Decl. ¶¶ 5, 39-40, Ex. 3 (Response No. 20), Ex. 34 (Interrog. No. 5), Ex. 35 (Response No. 5).

possessed information concerning Mycoskie's Delay Defenses that Tod's would rely on at trial — that is, until Tod's knew that it would be far too late for Mycoskie to pursue Mr. Sincini's deposition.<sup>17</sup>

As explained above, Tod's waited nearly thirteen months after Mycoskie first raised its Delay Defenses, and until three business days remained in discovery, before finally disclosing what it knew all along — that Mr. Sincini possessed discoverable information concerning Mycoskie's Delay Defenses and other issues, and that Tod's intended to rely on his testimony at trial. Knowing that Mycoskie would object to Tod's attempt to introduce testimony from a witness who it had repeatedly signaled it had no intention of calling at trial, Tod's counsel advised Mycoskie's counsel that Tod's supplement to its Initial Disclosures was made merely “in an abundance of caution,” that is, in an effort to protect against the possibility that Mr. Sincini might be precluded from testifying if he was not identified as a witness until the trial phase of these proceedings.<sup>18</sup>

While it is anticipated that Tod's will argue that Mycoskie knew about Mr. Sincini earlier in the case and could have sought his deposition then, Mycoskie is under no obligation to depose witnesses who are not identified as having discoverable information that will be relied on at trial. Furthermore, the Board's precedents confirm that a party should, at the very least, be allowed an

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<sup>17</sup> As Tod's will likely point out, it has offered to make Mr. Sincini available for deposition on written questions, maintaining that he is not subject to oral deposition in the U.S. despite his regular employment here as the Chairman of the Board of Deva, Tod's U.S.-based subsidiary. Even if Tod's position were correct (and it is not), evidently Tod's intended to avoid *any question* of whether Mr. Sincini could be deposed in the U.S. by electing to wait until it would be too late for Mycoskie to pursue Mr. Sincini's deposition at all.

<sup>18</sup> The Board has on several occasions precluded a witness from testifying where the disclosing party was aware that the witness possessed discoverable information, yet failed to disclose the identity of such witness until after the opportunity for discovery had passed. *See, e.g., Spier Wines (Pty) Ltd. v. Shepherd*, 105 U.S.P.Q.2d 1239, 2012 WL 2364347, at \*8 (T.T.A.B. 2012) (excluding testimony from opposer's witness on grounds that the failure to identify the witness as having discoverable information until after the opportunity for discovery had passed was a prejudicial surprise to applicant). Here, the identification of a witness three business days before the close of discovery is effectively the same thing.



opportunity to take a discovery deposition of individuals who are improperly omitted from a party's initial disclosures, even where that witness was previously identified in discovery. For example, in *Byer California v. Clothing for Modern Times, Ltd.*, the Board reopened discovery to allow for the deposition of a witness identified by the applicant in its interrogatory responses, but who had been omitted from the applicant's initial and amended initial disclosures until after the close of discovery, on grounds that Fed. R. Civ. P. 26(a) requires parties to disclose "each individual likely to have discoverable information that the disclosing party may use to support its claims or defenses," and since the applicant's belated identification had prevented opposer from deposing the witness during the discovery period. 2010 WL 1822099, at \*2-4 (T.T.A.B. 2010).<sup>19</sup> While Tod's evidently believes it has fulfilled its discovery obligations by supplementing its Initial Disclosures to include Mr. Sincini ("in an abundance of caution") moments before the close of discovery, Tod's intentionally late amendment of its Initial Disclosures leaves Mycoskie no time to take Mr. Sincini's deposition.<sup>20</sup>

To date, Tod's has provided no explanation whatsoever for its last-minute realization that Mr. Sincini does, after all, possess discoverable information that Tod's may use to support its claims in these proceedings, nor why Tod's counsel felt compelled to supplement Tod's Initial Disclosures. Of course, the only possible explanation is that Tod's intended all along to wait until the last possible moment to advise Mycoskie that Tod's planned to present trial testimony from Mr. Sincini without risking his exclusion, but at a time when it knew it would no longer be possible for Mycoskie to schedule Mr. Sincini's deposition. Accordingly, Mycoskie respectfully

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<sup>19</sup> See also *Great Seats, Inc. v. Great Seats, Ltd.*, 100 U.S.P.Q.2d 1323, 2011 WL 4871871, at \*5 (T.T.A.B. 2011) (allowing opposer to submit testimony from witness first disclosed after the close of discovery *provided* that applicant first be given an opportunity to conduct a discovery deposition of the belatedly identified witness).

<sup>20</sup> Under 37 C.F.R. § 2.120(a)(3) and TBMP § 403.02, all discovery depositions must be completed prior to the close of fact discovery.

requests that the Board reject Tod's strategic efforts to shield Mr. Sincini from deposition, and instead order Tod's to promptly make him available.

**B. The Board Should Order Mr. Sincini to Appear for Oral Deposition in the Southern District of New York.**

In Board proceedings, the deposition of a natural person "shall be taken in the [f]ederal judicial district where the person resides or is regularly employed . . . ." 37 C.F.R. § 2.120(b). Here, as Chairman of Deva, Tod's New York-based subsidiary, there is ample evidence that Mr. Sincini is, at the very least, "regularly employed" in the Southern District of New York, and therefore should be deposed orally in-person and in that District.

As discussed above, when Tod's counsel first identified Mr. Sincini as possessing information about Mycoskie's Delay Defenses upon which Tod's intends to rely in these proceedings on December 10, 2015, Mycoskie immediately requested that Mr. Sincini be made available for an oral deposition in the U.S. Tod's counsel, however, refused that request, on the grounds that Mr. Sincini resides in Italy, and so if Mycoskie wanted to take his deposition, it could do so only on written questions.<sup>21</sup> Mycoskie promptly responded to Tod's counsel's gamesmanship, especially given the evidence that had been developed of Mr. Sincini's regular involvement in the business of Deva and regular presence in the U.S., and indicated that Mycoskie would move to compel Mr. Sincini's in-person deposition.<sup>22</sup>

Regardless of where Mr. Sincini principally resides, as Mr. Castiglioni and Ms. Rothfeld both clearly testified at their depositions, Mr. Sincini is the longstanding Chairman of the Board of Deva, Tod's U.S.-based subsidiary, and in that capacity frequently travels to the U.S. to conduct Tod's and Deva's business. Indeed, in his capacity as Board Chairman, Mr. Sincini

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<sup>21</sup> See Ederer Decl. ¶ 34, Ex. 29.

<sup>22</sup> See Ederer Decl. ¶ 36, Ex. 31.

makes regular business trips to Deva's headquarters in New York City to conduct Deva's business.<sup>23</sup> Further, Tod's has repeatedly made corporate filings in the U.S. identifying Mr. Sincini as the Chairman of Deva, each time listing his contact address as Deva's headquarters in New York City.<sup>24</sup> Accordingly, the Board should not allow Tod's to assert in public filings that Mr. Sincini is a U.S.-based company official, and later deny the same when it is to its benefit to do so.<sup>25</sup>

Mycoskie expects Tod's will argue that the language of 37 C.F.R. § 2.120(b) is trumped by the provisions of 37 C.F.R. § 2.120(c), which states that the discovery deposition of a person residing in a foreign country must be taken on written questions, whether or not that person is "regularly employed" in the U.S. There is, however, no TTAB case or other precedent that addresses this issue or supports such a juxtaposition of the two provisions; rather, Section 2.120(b) simply provides that if an individual either resides *or* is regularly employed within a particular federal judicial district, he may be deposed there. Here, the evidence is clear that Mr. Sincini is "regularly employed" within the Southern District of New York.<sup>26</sup>

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<sup>23</sup> See Ederer Decl. ¶¶ 26-27, Ex. 21 (19:22 - 27:8), Ex. 22 (24:24 - 26:17).

<sup>24</sup> See Ederer Decl. ¶ 41, Ex. 36. In the period 2012 to 2015, Deva made four corporate filings identifying Mr. Sincini as Chairman of the Board of that company, and listing his contact address as 450 West 15th Street, New York, New York 10011. At his deposition, Mr. Castiglioni confirmed that Mr. Sincini is still currently Deva's Board Chairman. *Id.* ¶ 26, Ex. 21 (24 :5-10).

<sup>25</sup> Mycoskie notes that in analogous situations, far less evidence has been required than Mr. Sincini's numerous connections to New York to compel a finding that a person is regularly employed in the U.S. for discovery purposes. See *Halliburton Energy Servs., Inc. v. M-I, LLC*, No. H06MC00053, 2006 WL 2663948, at \*2 (S.D. TX Sept. 15, 2006) (ruling that a foreign-based witness's four annual business trips to Houston, Texas were sufficient to find that the witness "regularly transacts business" within the U.S. as required to support a deposition subpoena under Fed. R. Civ. P. 45(c)(3)(A)(ii)).

<sup>26</sup> Mycoskie further anticipates that Tod's will point to the header of TBMP § 404.03(a), entitled "Person Residing in the United States — Party," as an indication that the language of 37 C.F.R. § 2.120(b) is applicable only to persons who are residents of the U.S. Notably, such a requirement appears nowhere in Section 2.120(b) itself, the C.F.R. provision with which TBMP § 404.03(a) purports to be aligned. Further, both the TBMP itself and a federal court of appeals have stated that the TBMP is not intended to be an end-all interpretation of the C.F.R.; to the contrary, the TBMP "does not modify, amend, or serve as a substitute for any statutes, rules or decisional law and is not binding upon the Board." TBMP, Intro; see *Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises, Ltd.*, 511

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Accordingly, Mycoskie requests that the Board order Tod's to produce Mr. Sincini within the federal district where he regularly conducts business as the Chairman of the Board of Deva, *i.e.*, the Southern District of New York, for an in-person oral deposition.

**C. Good Cause Exists to Order Mr. Sincini to Appear for Oral Deposition in Italy.**

To the extent the Board determines that notwithstanding Mr. Sincini's many years of leadership of a U.S.-based business and frequent presence here, he should not be compelled to appear for an oral deposition in New York, it should still find good cause to order Mr. Sincini to appear for an oral deposition in Italy, either in-person or by video conference, pursuant to 37 C.F.R. § 2.120(c) and TBMP § 520. Notwithstanding the provisions of TBMP § 404.03(b), it is well settled that the Board may order a witness to appear for an oral discovery deposition in a foreign country. *Orion Group, Inc. v. Orion Ins. Co.*, Opp. No. 79,009, 12 U.S.P.Q.2d 1923, 1989 WL 274396, at \*3-4 (T.T.A.B. June 29, 1989) (finding good cause to order a foreign deposition on oral questions, where the testimony sought involved one of the "central issues in

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F.3d 437, 448 (4th Cir. 2007). And in any event, if ever there were circumstances under which a witness who purports to reside in a foreign country should be required to appear at a discovery deposition in the U.S. under the "regularly employed" prong of Section 2.120(b), this is the case.

It should be further noted that both the C.F.R. and TBMP anticipate that the deposition of a foreign resident may take place in the U.S. at any time such person is present in this country. More specifically, both 37 C.F.R. § 2.120(c)(2) and TBMP 404.03(d) provide that any such deposition should be taken in the federal judicial district where that person "resides or is regularly employed," indicating that the rules anticipate the distinct possibility that a foreign resident may also be regularly employed in the U.S., and should thus be deposed here on that basis. Since there is ample evidence that Mr. Sincini is not only regularly employed in the Southern District of New York, but that he is physically present in the New York several times a year for the purpose of conducting business in connection with that employment, it would, at the very least, be appropriate for the Board to order his in-person deposition in New York to occur in conjunction with his next scheduled presence in New York on business, provided the deposition takes place within a reasonable period of time (*e.g.*, not to exceed 60 days). In this regard, we note that had Tod's identified Mr. Sincini in its initial disclosures when it should have, that is, at the outset of the Opposition Proceeding, Mycoskie surely would have exercised its right to notice his in-person deposition in the U.S., under 37 C.F.R. § 2.120(c)(2), at such time that he next travelled to the U.S. to conduct business. Since, as Board Chairman of Deva, Mr. Sincini has surely been present in the U.S. on Deva/Tod's business in the last year-and-a-half, his in-person oral deposition in U.S. would have long been concluded, and Mycoskie would not have had to burden the Board with this issue.

[the] opposition proceeding” and the witness to be deposed was aware of facts solely within the applicant’s control). In determining whether good cause exists to order an oral deposition in a foreign country, the Board must “weigh[] the equities, including the advantages of an oral deposition and any financial hardship that the party to be deposed might suffer if the deposition were taken orally in the foreign country . . . .” *Orion Group*, 1989 WL 274396, at \*2.

Here, there is no question that Mr. Sincini is the Tod’s employee uniquely capable of testifying with respect to Tod’s as-yet unexplained eight-year delay in challenging Mycoskie’s registrations of the TOMS’ mark — indeed, Tod’s own witness, Mr. Castiglioni, so testified.<sup>27</sup> Considering that Mr. Sincini is now also the only person identified in Tod’s Initial Disclosures who has first-hand knowledge of such a critical issue in these proceedings — an issue for which the facts are exclusively within Tod’s control — and in light of the Board’s acknowledgment that depositions on written questions are often unwieldy and unhelpful,<sup>28</sup> there is more than sufficient cause to order that Mr. Sincini’s deposition proceed on oral questions, even if the Board rules that he must appear in Italy.<sup>29</sup>

Accordingly, in the event that the Board declines to compel Mr. Sincini to be deposed in the U.S., Mycoskie respectfully requests that the Board order his oral deposition in Italy, upon good cause shown, in accordance with 37 C.F.R. § 2.120(c).

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<sup>27</sup> See Ederer Decl. ¶ 26, Ex. 21 (48:7 - 52:15).

<sup>28</sup> As for Tod’s position that any such deposition should take place only on written questions, the importance of the issues to which Mr. Sincini will testify (namely, the reasons for Tod’s eight-year delay), coupled with the reality that all facts concerning those issues are within Tod’s control, makes such a cumbersome mechanism inappropriate under these circumstances. See TBMP § 404.07(j) (“A deposition on written questions is a cumbersome, time-consuming procedure . . . . Moreover, it deprives an adverse party of face-to-face confrontation and the opportunity to ask follow-up questions based on answers to previous questions.”); *Orion Group*, 1989 WL 274396, at \*3-4.

<sup>29</sup> In the event that the Board does find Mr. Sincini to be subject to deposition only within Italy, Mycoskie is agreeable to paying the travel and accommodation costs of ensuring that Tod’s counsel of record is present in Italy for any such deposition.

**V. The Proceedings Should Not Be Delayed Pending the Outcome of this Motion**

Given the many delays Tod's has caused by virtue of its litigation tactics throughout these proceedings, first waiting until nearly the close of discovery in the Opposition Proceeding to file the Cancellation Action, and then waiting until the close of discovery in the Consolidated Proceedings to seek to amend its pleadings and add a witness to its Initial Disclosures, all in an effort to gain a tactical advantage in these proceedings, Tod's should not benefit from any further delay. Rather, subject to the completion of any additional discovery proceedings ordered by the Board, the proceedings should move forward on the current schedule, or as close thereto as possible.

**VI. Mycoskie's Good Faith Effort to Resolve the Discovery Dispute**


As set forth above, Mycoskie's counsel has made good faith efforts to resolve the above discovery dispute with Tod's counsel, as required by 37 CFR § 2.120(e) and TMBP § 523.02, but those efforts have been unsuccessful.

**VII. Conclusion**

For all of the foregoing reasons, Mycoskie respectfully requests that the Board (1) deny Tod's motion to amend its pleading, (2) grant Mycoskie's cross-motion to compel the oral in-person deposition of Sincini in New York or, in the alternative, in Italy, (3) deny Tod's request that the proceedings be suspended, and (4) order that fact discovery be extended solely for the purpose of allowing Mycoskie to conduct Mr. Sincini's deposition.

Dated: January 13, 2016

ARNOLD & PORTER LLP

By: 

Louis S. Ederer

Matthew T. Salzmann

Benjamin C. Wolverton

*Attorneys for Applicant/Respondent  
Mycoskie, LLC*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing  
**APPLICANT/RESPONDENT MYCOSKIE, LLC'S MEMORANDUM OF LAW IN  
OPPOSITION TO OPPOSER/PETITIONER TOD'S S.P.A.'S MOTION TO AMEND  
AND IN SUPPORT OF APPLICANT/RESPONDENT'S CROSS-MOTION TO COMPEL  
THE ORAL DEPOSITION OF STEFANO SINCINI** was served upon the following attorneys  
of record for Opposer/Petitioner Tod's S.p.A. by U.S. Mail, this 13th day of January, 2015:

Richard S. Mandel, Esq.  
Aryn M. Emert, Esq.  
COWAN, LIEBOWITZ & LATMAN, P.C.  
1133 Avenue of the Americas  
New York, New York 10036-6799

*Attorneys for Opposer/Petitioner Tod's S.p.A.*

  
Benjamin C. Wolverton



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Matter of Application Serial No. 86/004,044  
Published in the *Official Gazette* on April 29, 2014  
For the Mark: TOMS

In the Matter of Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344  
Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013  
For the Mark: TOMS

TOD'S S.P.A.,	)	
	)	
Opposer/Petitioner,	)	<b>Opposition No.: 91218001 (parent)</b>
	)	Cancellation No.: 92061234
-against-	)	
	)	
MYCOSKIE, LLC,	)	
	)	
Applicant/Respondent.	)	

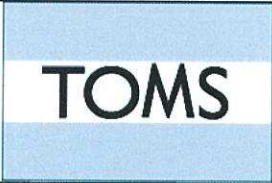
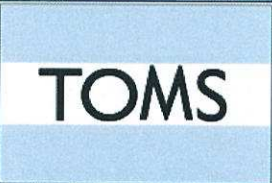
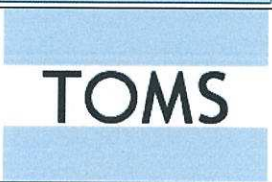
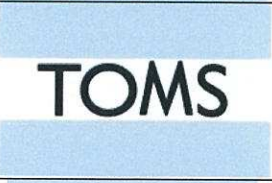

**DECLARATION OF LOUIS S. EDERER**

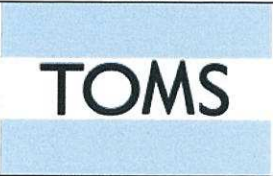

I, Louis S. Ederer, pursuant to 28 U.S.C. § 1746 and Rule 2.20 of the Trademark Rules of Practice, declare as follows:

1. I am a member of the firm of Arnold & Porter LLP, attorneys of record for Applicant/Respondent Mycoskie, LLC ("Mycoskie"). I submit this declaration in support of Mycoskie's Memorandum of Law in Opposition to Opposer/Petitioner Tod's S.p.A.'s ("Tod's") Motion to Amend and in Support of Mycoskie's Cross-Motion to Compel the Oral Deposition of Stefano Sincini.

2. The facts contained in this declaration are within my own knowledge and experience, and I believe them to be true.

3. Set forth below is a list of subsisting U.S. registrations for word and design marks incorporating the TOMS mark owned by Mycoskie:

Mark	Reg. Number	Class	Registration Date
TOMS	3,353,902	25	December 11, 2007 (Incontestable)
TOMS	3,566,093	25	January 20, 2009 (Incontestable)
TOMS	3,662,112	25	July 28, 2009 (Incontestable)
TOMS	4,097,948	25	February 14, 2012
TOMS	4,192,925	9	August 21, 2012
TOMS	4,313,981	9	April 2, 2013
TOMS	4,410,344	35	October 1, 2013
TOMS	4,602,798	30	September 9, 2014
	3,765,503	25	March 23, 2010 (Incontestable)
	4,274,178	35	January 15, 2013
	4,403,205	43	September 17, 2013
	4,517,359	9	April 22, 2014
	4,602,814	30	September 9, 2014

Mark	Reg. Number	Class	Registration Date
	4,805,580	18	September 1, 2015
	4,827,152	21, 43	October 6, 2015

Attached hereto as Exhibit 1 are true and correct copies of such registrations.

4. Attached hereto as Exhibit 2 is a true and correct copy of Tod's registration certificate for the mark TOD'S and Design (U.S. Registration No. 1,459,226), issued on September 29, 1987.

5. Attached hereto as Exhibit 3 is a true and correct copy of Tod's Responses to Mycoskie's Second Set of Interrogatories, dated September 11, 2015.

6. Attached hereto as Exhibit 4 is a true and correct copy of Tod's Notice of Opposition in these proceedings (the "Opposition Proceeding"), filed on August 25, 2014.

7. Attached hereto as Exhibit 5 is a true and correct copy of Mycoskie's Answer to Tod's Notice of Opposition, filed on September 30, 2014.

8. Attached hereto as Exhibit 6 is a true and correct copy of Tod's Notice of Opposition to the registration of the mark PODS (Opp. No. 91206390), filed on August 3, 2012.

9. Attached hereto as Exhibit 7 is a true and correct copy of Tod's Notice of Opposition to the registration of the mark TODES (Opp. No. 91206808), filed on August 28, 2012 (without exhibits).

10. Attached hereto as Exhibit 8 are true and correct copies of Tod's First Set of Interrogatories and First Request for Production of Documents and Things, dated December 11, 2014.

11. Attached hereto as Exhibit 9 is a true and correct copy of a letter from Louis S. Ederer, Esq., to Richard S. Mandel, Esq., dated February 17, 2015.

12. Attached hereto as Exhibit 10 is a true and correct copy of a letter from Louis S. Ederer, Esq., to Richard S. Mandel, Esq., dated February 19, 2015.

13. Attached hereto as Exhibit 11 is a true and correct copy of a letter from Louis S. Ederer, Esq., to Richard S. Mandel, Esq., dated February 25, 2015.

14. Attached hereto as Exhibit 12 is a true and correct copy of a letter from Richard S. Mandel, Esq., to Louis S. Ederer, Esq., dated March 13, 2015.

15. Attached hereto as Exhibit 13 is a true and correct copy of a letter from Louis S. Ederer, Esq., to Richard S. Mandel, Esq., dated March 20, 2015.

16. Attached hereto as Exhibit 14 is a true and correct copy of Tod's Initial Disclosures, dated December 3, 2014.

17. According to the case management schedule in the Opposition Proceeding (Dkt. Entry No. 2), discovery in that proceeding was scheduled to close on May 2, 2015.

18. On April 8, 2015, I received an email from Tod's counsel, Richard Mandel, Esq., advising me that Tod's had filed a Petition for Cancellation seeking to cancel various TOMS word mark registrations (the "Cancellation Action"). A true and correct copy of Mr. Mandel's email is attached hereto as Exhibit 15 (without attachment). In his email, Mr. Mandel also requested that Mycoskie consent to the consolidation of the Cancellation Action with the Opposition Proceeding, "[b]ecause of the obvious overlapping issues."

19. In response to Mr. Mandel's request, on or about April 9, 2015, I spoke with him by telephone, and asked why Tod's had waited until just prior to the close of discovery in the Opposition Proceeding to file the Cancellation Action. Mr. Mandel replied that Tod's felt compelled to do so since Mycoskie was "making a big deal" in the Opposition Proceeding about the fact that Tod's had not previously challenged Mycoskie's TOMS word mark registrations.

20. In considering Mr. Mandel's request, it did appear as though the Opposition Proceeding and the proposed Cancellation Action would present common issues of law and fact, namely, whether: (a) there was a likelihood of confusion as between the parties' respective marks; (b) the registrations of the TOMS mark diluted the distinctive qualities of the famous TOD'S mark; and (c) Tod's delay in bringing any proceedings with respect to Mycoskie's TOMS applications and registrations would support Mycoskie's affirmative defenses based on delay. After consulting with my client, I therefore reluctantly advised Mr. Mandel that Mycoskie would consent to the consolidation of the Cancellation Action with the Opposition Proceeding.

21. Attached hereto as Exhibit 16 is a true and correct copy of Tod's Petition for Cancellation, filed on April 8, 2015.

22. Attached hereto as Exhibit 17 is a true and correct copy of Tod's Consent Motion to Consolidate the Opposition Proceeding and the Cancellation Action, filed on May 27, 2015.

23. Attached hereto as Exhibit 18 is a true and correct copy of an order of the Board, dated May 28, 2015, granting Tod's Consent Motion to Consolidate the Opposition Proceeding and the Cancellation Action.

24. Attached hereto as Exhibit 19 is a true and correct copy of Tod's first Supplemental Initial Disclosures, dated July 20, 2015.

25. Attached hereto as Exhibit 20 is a true and correct copy of Mycoskie's Answer to Tod's Petition for Cancellation, filed on May 18, 2015.

26. Attached hereto as Exhibit 21 is a true and correct copy of excerpts from the transcript of the deposition of Claudio Castiglioni, Tod's Global General Brand Manager, taken on October 9, 2015.

27. Attached hereto as Exhibit 22 is a true and correct copy of excerpts from the transcript of the deposition of Stephanie Rothfeld, Director of Retail of Tod's wholly-owned, New York City-based U.S. subsidiary, Deva, Inc., taken on October 8, 2015.

28. Attached hereto as Exhibit 23 is a true and correct copy of Tod's second Supplemental Initial Disclosures, dated December 10, 2015.

29. Attached hereto as Exhibit 24 is a true and correct copy of Applicant/Respondent's expert report prepared by E. Deborah Jay, Ph.D., dated November 9, 2015 (without exhibits).

30. Attached hereto as Exhibit 25 is a true and correct copy of excerpts from the transcript of the deposition of Jessica Murray, Mycoskie's Director of Intellectual Property, taken on November 19, 2015.

31. Attached hereto as Exhibit 26 is a true and correct copy of excerpts from the transcript of the deposition of Brigid Stevens, Mycoskie's Director of Marketing, taken on November 20, 2015.

32. Attached hereto as Exhibit 27 is a true and correct copy of an email from Richard S. Mandel, Esq., to Louis S. Ederer, Esq., dated December 10, 2015 (without attachments).

33. Attached hereto as Exhibit 28 is a true and correct copy of an email from Louis S. Ederer, Esq., to Richard S. Mandel, Esq., dated December 14, 2015 (without attachment).

34. Attached hereto as Exhibit 29 is a true and correct copy of an email from Richard S. Mandel, Esq., to Louis S. Ederer, Esq., dated December 15, 2015.

35. Attached hereto as Exhibit 30 is a true and correct copy of Opposer/Petitioner's expert report prepared by Sarah Butler, dated December 15, 2015 (without exhibits).

36. Attached hereto as Exhibit 31 is a true and correct copy of an email from Louis S. Ederer, Esq., to Richard S. Mandel, Esq., dated December 16, 2015.

37. Attached hereto as Exhibit 32 is a true and correct copy of Mycoskie's Responses to Tod's First Set of Interrogatories, dated February 17, 2015.


38. Attached hereto as Exhibit 33 is a true and correct copy of Mycoskie's Responses to Tod's First Set of Document Requests, dated February 17, 2015.

39. Attached hereto as Exhibit 34 is a true and correct copy of Mycoskie's First Set of Interrogatories, dated December 3, 2014.

40. Attached hereto as Exhibit 35 is a true and correct copy of Tod's Responses to Mycoskie's First Set of Interrogatories, dated February 4, 2015.

41. Attached hereto as Exhibit 36 are true and correct copies of corporate filings by Deva for the years 2012 to 2015. Copies of these public filings were marked as an exhibit at the deposition of Mr. Castiglioni.

I hereby declare under penalty of perjury that the foregoing is true and correct. Executed this 13th day of January, 2016.

  
\_\_\_\_\_  
Louis S. Ederer

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Matter of Application Serial No. 86/004,044  
Published in the *Official Gazette* on April 29, 2014  
For the Mark: TOMS

In the Matter of Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344  
Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013  
For the Mark: TOMS

TOD'S S.P.A.,

Opposer,

-against-

MYCOSKIE, LLC,

Applicant.

**Opposition No.: 91218001 (parent)**  
Cancellation No.: 92061234

**DECLARATION OF JESSICA MURRAY**

I, Jessica Murray, pursuant to 28 U.S.C. § 1746 and Rule 2.20 of the Trademark Rules of Practice, declare as follows under the penalty of perjury:

1. I am Intellectual Property Director for Toms Shoes LLC ("Toms"), a subsidiary of Applicant/Respondent Mycoskie, LLC ("Mycoskie"). I have held that position since May 2013.

2. In my position as Intellectual Property Director for Toms, I am responsible for the maintenance and management of Mycoskie's trademark portfolio, including the well-known TOMS trademark for shoes, apparel, and related goods, on a worldwide basis. Among other things, I act as a liaison between Mycoskie and outside counsel, and am responsible for compiling the information needed for counsel to prepare and file applications to register Mycoskie's trademarks in the United States Trademark Office, and in the trademark offices of over 50 countries around the world.



3. Prior to becoming employed by Toms, I held intellectual property-related and brand positions at Gucci America, Hilton Worldwide and Richemont, with responsibility for protecting some of the world's best-known trademarks. Altogether, I have been employed as an intellectual property professional for over twelve years.

#### **Mycoskie's Class 18 Application**

4. In or about May 2013, I was advised by the Toms product development and design team that our company was planning to come out with a line of handbags and related accessories sometime in 2014. I was therefore asked to work with outside counsel to apply for the registration of TOMS trademarks in the U.S., and in other countries around the world where Toms planned to introduce the line.

5. Based on my prior experience at Toms, I understood that when Toms introduces a new line of products, the line tends to be expansive, and not just limited to the core products, such as, in this case, handbags. The reason for this, among other things, is that a critical component of the TOMS brand's business model, for which it has become widely known, involves "One for One" charitable giving — *i.e.*, for every product sold by Toms at wholesale or retail, it donates a related type of product to a person in need. In the case of the proposed bag line, the discussion at the development meetings in May and June 2013, which I attended, was that the "give" products were to involve many sorts of related accessory products, in which various items could be carried.

6. Also, from prior experience, I had come to know that many of the Toms product lines include products that are intended not only for everyday use, but also for travel. In particular, travel is a major theme in Toms' campaign to market and promote its product lines, since representatives of the company, as part of its "One for One" giving program, are constantly

traveling around the world in search of people and countries in need, so that they can become part of our giving program.

7. Accordingly, in my early discussions with the product development and design team beginning in May 2013, I made sure to instruct team members to provide me with a complete list of every product Toms was then discussing internally as potentially part of the new handbag line, including not only the retail products we were planning to produce, but also all related products we would develop to expand the One for One giving model.

8. Further, in my discussions with various product development and design team members, I was informed that Toms was then planning to develop a very expansive line of goods as part of the introduction of the new handbag line, not only for retail sale but also for the “give”. Included in that line were not just handbags, but many other related carrying products, including cases and holders of various kinds, a line of carrying products intended for use in travel, and even some products that were to be used by pets.

9. The information I received about the intended development of various pet-related products was not surprising, since around that same time, the company was planning to introduce an entire giving initiative centered around pets and other animals in need. The product development and design team therefore advised me that it would be developing designs for a variety of pet products, including certain products that would fall in Class 18.

10. Similarly, I was not surprised to learn, in June 2013, that the Toms product development and design team was planning to develop and produce various carrying devices for jewelry, since at that same time Toms was planning to introduce, for the first time, its own line of retail jewelry products. The introduction of jewelry pouches, therefore, was a natural extension of these plans.

11. Working with various members of the product development and design team in July 2013, together we came up with an extensive list of products that were intended for development as part of the planned introduction of the handbag line. In those discussions, I explained to the team members that we should only include in our trademark applications products that the company then intended to produce, and made sure, to my satisfaction, they understood that. Together we then came up with the following list of products which were included in our Class 18 application both in the U.S. Trademark Office and in countries around the world:

goods made of leather or imitations of leather, namely, card wallets, clutch bags, clutch purses, cosmetic bags sold empty, cosmetic cases sold empty, key bags, key cases, key wallets, and luggage; bags, namely, all-purpose carrying bags, all-purpose athletic bags, and backpacks; trunks; valises; suitcases; tote bags; travelling bags; garment bags for travel; rucksacks; satchels; holdalls; handbags; shoulder bags; canvas shopping bags; wheeled shopping bags and purses; jewelry pouches; wallets; credit card holders of leather and imitations of leather; pochettes; luggage label holders and tags; collars for pets; and leashes for animals.

12. Mycoskie's U.S. application to register the TOMS mark in Class 18 was filed on July 8, 2013 (App. Serial No. 86/004,044). I carefully reviewed the application before it was filed to make sure the list of goods included in the application was accurate, and was consistent with my discussions with the product development and design team.

#### **Tod's Motion to Amend**

13. I have reviewed the motion papers Tod's S.p.A. ("Tod's") has filed with the TTAB seeking leave to amend its pleadings in its Opposition against Mycoskie's Class 18 application. My understanding is that Tod's is claiming that when taking the deposition of Brigid Stevens, Toms' Director of Marketing, on November 30, 2015 (which I attended), it learned for the first time that Mycoskie did not have a bona fide intent to use its TOMS mark on

all goods included in the Class 18 application, and in particular the following goods: key bags; key wallets; garment bags for travel; wheeled shopping bags and purses; jewelry pouches; and leashes for animals.

14. I found Tod's motion papers to be misleading and inaccurate in the following respects. First, Tod's completely fails to mention that on the previous day, November 29, 2015, Tod's counsel took my deposition. During my deposition, Tod's counsel very briefly questioned me about the list of goods that had been included in Mycoskie's Class 18 application, and whether Mycoskie had an intent to use the TOMS mark on all of these goods. After first asking me questions directed only to the issue of what Class 18 products Toms had ever produced, counsel began asking me questions about what Class 18 products Toms intended to develop back in May 2013, when it first decide to come out with a handbag line.

15. In response to counsel's questions, I began to explain that Mycoskie did in fact have an intent to use the TOMS mark on all of the applied-for goods in its Class 18 application when it filed its application in July 2013, including the reasons why I knew that — namely, my discussions with the product development and design team, my knowledge of the “One for One” giving program, etc. For example, on pages 45-46 of the transcript of my deposition, I testified as follows:

**Q** Okay. And what I'm asking is do you know whether the work that began on or about May 22nd, 2013, related solely to handbags or covered any other Class 18 products that were the subject of the TOMS work [sic] mark application.

[. . .]

**THE WITNESS:** My understanding was that it would cover most or all of Class 18.

**Q BY MR. MANDEL:** And when you say it would cover, you mean the work that it actually began?

A Yes.

Q And do you know, what's the basis for that understanding?

A So when a concept is launched it is launched with the idea of always one for one so there's always the idea of a give. And so when the idea of this project was launched it was to provide an additional one for one so the product was -- there was a lot of discussion around what types of products could be included in the range of the collection.

Q And would that also include discussion about what gifts might be given as a result of the sale?

[. . .]

**THE WITNESS:** A gift. Do you mean the give?

Q **BY MR. MANDEL:** The give.

A Toms always -- for every new product there is always a give so there is always a thought to how to give and what to give. So it is -- it is obviously a process for many reasons and so there's always the development is centered around the give.

However, after asking me these few short questions on this subject, Tod's counsel moved on to a completely different subject.

16. As for Ms. Stevens' testimony on November 30, I have reviewed the portion of her testimony on which Tod's is relying in its motion to amend, and, consistent with my recollection, her testimony also does not support Tod's motion. In fact, a review of Ms. Stevens' testimony confirms that Tod's counsel was merely questioning her about whether Toms had ever actually produced the goods listed in Mycoskie's Class 18 application, and if not, whether it had then-present plans to do so. Indeed, Ms. Stevens was not asked a single question about Mycoskie's intent to use the TOMS mark on these goods *in July 2013*, when its Class 18 application was filed. In addition, in certain instances, Ms. Stevens was asked about goods that were included in the application that she did not recognize by the description used in the

application, and so she simply testified that she did not know what type of product was being described. However, at no time did Ms. Stevens testify that Mycoskie did not have a bona fide intent to develop any of the products listed in its Class 18 application in July 2013, at the time it was filed.

17. As for the specific goods Tod's now claims Toms did not have a bona fide intent to develop in July 2013 when Mycoskie filed its Class 18 application, I can attest as follows. First, with respect to "key bags," I can confirm, based on my discussions with Toms' product development and design team beginning in May 2013, that Mycoskie did in fact plan to use the TOMS mark on such products. Although it is unlikely that members of Toms' marketing team (like Ms. Stevens) would be familiar with the specific term "key bags" as used by Mycoskie in filing the Class 18 application, I can recall specific discussions with members of the product development and design team about their plans to develop small bags that were to be used to carry keys.

18. Second, with respect to "key wallets," I can confirm, based on my discussions with Toms' product development and design team beginning in May 2013, that Mycoskie did in fact plan to use the TOMS mark with respect to such products. These products, like the "key bags" referred to in the previous paragraph, were also intended to be wallets with clips for holding keys. Again, I can attest to the fact that Toms planned to develop these products, notwithstanding the fact that our marketing teams would not likely have referred to them by the description "key wallets," as used in the Class 18 application.

19. Third, with respect to "garment bags for travel," I can confirm, based on my discussions with Toms' product development and design team beginning in May 2013, that Mycoskie did in fact plan to use the TOMS mark with respect to such products. Indeed, I recall

specific discussions with the team about the development of these products, as a part of a line of carry bags Toms was developing in connection with its company-wide focus on travel, and the production of travel-themed products.

20. Fourth, with respect to “wheeled shopping bags and purses,” I can confirm, based on my discussions with Toms’ product development and design team in May 2013, that Mycoskie did in fact plan to use the TOMS mark with respect to such products. Indeed, I specifically recall that Toms’ product development and design team created prototypes of a shopping bag and large-size purse with wheels, similar to the “rollerboard”-type luggage and carry bags that people use as carry-ons for air travel, once again as part of its plan to develop a variety of TOMS travel-themed products.

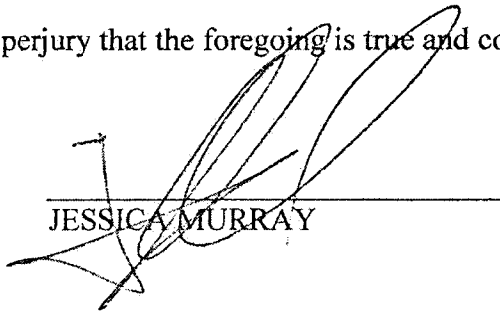
21. Fifth, with respect to “jewelry pouches,” I can confirm, based on my discussions with Toms’ product development and design team beginning in May 2013, that Mycoskie did in fact plan to use the TOMS mark with respect to such products. Indeed, the plan in May and June 2013 was to develop carrying cases for jewelry products, both for retail sale and potentially as a “give” item, as part of the planned introduction of an entire new line of TOMS jewelry products. Accordingly, these products were consistent with Mycoskie’s plans to introduce its own line of jewelry products, which the Toms’ product development and design team was working on at the time.

22. Finally, with respect to “leashes for animals,” I can confirm, based on my discussions with Toms’ product development and design team beginning in May 2013, that Mycoskie did in fact have an intent to use the TOMS mark with respect to such products. In fact, I specifically recall a discussion with the product development and design team about its intention to develop an entire line of pet-related products, including both pet collars and pet

leashes (both of which were included in the Class 18 application). The plan to develop these products as of June 2013 was consistent with the initiative to launch a giving program focusing on animals and pets.

23. Once again, with respect to all of the above goods, and all other goods set forth in Mycoskie's Class 18 application, I can attest to the fact that based on my direct discussions with Toms' product development and design team beginning in May 2013, I was completely satisfied that Mycoskie had a bona fide intent to use the TOMS mark on all such goods. Given my extensive professional experience in this area, I would not have provided that list of goods to outside counsel to include in the application if I was not completely satisfied of this.

I hereby declare under penalty of perjury that the foregoing is true and correct. Executed this 12th day of January, 2016.



JESSICA MURRAY



# **EXHIBIT 1**

**Int. Cl.: 25**

**Prior U.S. Cls.: 22 and 39**

**United States Patent and Trademark Office**

**Reg. No. 3,353,902**

**Registered Dec. 11, 2007**

**TRADEMARK  
PRINCIPAL REGISTER**

**TOMS**

MYCOSKIE, BLAKE (UNITED STATES INDIVIDUAL)  
809 SAN MIGUEL  
VENICE, CA 90291

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: CANVAS SHOES; SHOES, IN CLASS 25 (U.S. CLS. 22 AND 39).

SN 78-816,215, FILED 2-16-2006.

FIRST USE 4-22-2006; IN COMMERCE 4-22-2006.

CARRIE GENOVESE, EXAMINING ATTORNEY

**Int. Cl.: 25**

**Prior U.S. Cls.: 22 and 39**

**United States Patent and Trademark Office**

**Reg. No. 3,566,093**

**Registered Jan. 20, 2009**

**TRADEMARK  
PRINCIPAL REGISTER**

**TOMS**

MYCOSKIE, BLAKE (UNITED STATES INDIVIDUAL)  
809 SAN MIGUEL  
VENICE, CA 90291

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: CLOTHING, NAMELY, CANVAS SHOES, SHOES, CAPS, SHIRTS, T-SHIRTS AND HATS, IN CLASS 25 (U.S. CLS. 22 AND 39).

SN 78-980,827, FILED 5-12-2006.

FIRST USE 5-8-2006; IN COMMERCE 5-20-2006.

CARRIE GENOVESE, EXAMINING ATTORNEY

**Int. Cl.: 25**

**Prior U.S. Cls.: 22 and 39**

**Reg. No. 3,662,112**

**United States Patent and Trademark Office**

**Registered July 28, 2009**

**TRADEMARK  
PRINCIPAL REGISTER**

**TOMS**

MYCOSKIE, BLAKE (UNITED STATES INDIVIDUAL)  
809 SAN MIGUEL  
VENICE, CA 90291

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: CLOTHING, NAMELY, HOODS, JERSEYS, TOPS AND JACKETS, IN CLASS 25 (U.S. CLS. 22 AND 39).

SN 78-981,138, FILED 5-12-2006.

FIRST USE 10-1-2007; IN COMMERCE 10-1-2007.

CARRIE GENOVESE, EXAMINING ATTORNEY

# United States of America

United States Patent and Trademark Office

# TOMS

**Reg. No. 4,097,948**

**Registered Feb. 14, 2012**

**Int. Cl.: 25**

**TRADEMARK**

**PRINCIPAL REGISTER**

MYCOSKIE, LLC (CALIFORNIA LIMITED LIABILITY COMPANY)  
STAGE C  
3025 OLYMPIC BOULEVARD  
SANTA MONICA, CA 90404

FOR: CLOTHING, NAMELY, ONE PIECE GARMENTS FOR INFANTS AND BABIES, IN  
CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 11-15-2008; IN COMMERCE 11-15-2008.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PAR-  
TICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 3,765,503.

SER. NO. 85-189,009, FILED 12-2-2010.

MIDGE BUTLER, EXAMINING ATTORNEY



*David J. Kyros*

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
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**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE:** Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

# United States of America

United States Patent and Trademark Office

# TOMS

**Reg. No. 4,192,925**

**Registered Aug. 21, 2012**

**Int. Cl.: 9**

**TRADEMARK**

**PRINCIPAL REGISTER**

MYCOSKIE, LLC (CALIFORNIA LIMITED LIABILITY COMPANY)  
STAGE C  
3025 OLYMPIC BOULEVARD  
SANTA MONICA, CA 90404

FOR: SUNGLASSES AND CASES FOR SUNGLASSES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 6-7-2011; IN COMMERCE 6-7-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 3,353,902, 3,662,112 AND OTHERS.

SER. NO. 85-338,976, FILED 6-6-2011.

MEGHAN REINHART, EXAMINING ATTORNEY



*David J. Kyros*

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

**First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

**Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**



# United States of America

United States Patent and Trademark Office

# TOMS

**Reg. No. 4,313,981**

**Registered Apr. 2, 2013**

**Int. Cl.: 9**

**TRADEMARK**

**PRINCIPAL REGISTER**

MYCOSKIE, LLC (CALIFORNIA LIMITED LIABILITY COMPANY)  
5404 JANDY PLACE  
LOS ANGELES, CA 90066

FOR: EYEWEAR, NAMELY, SUNGLASSES, EYEGLASSES AND OPHTHALMIC FRAMES  
AND CASES THEREFORE, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 6-6-2011; IN COMMERCE 6-6-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 3,353,902, 3,662,112, AND OTHERS.

SN 85-446,584, FILED 10-13-2011.

BILL DAWE, EXAMINING ATTORNEY



*Lisa Street Lee*

Acting Director of the United States Patent and Trademark Office

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**Requirements in the First Ten Years\***

**What and When to File:**

**First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

**Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

# United States of America

United States Patent and Trademark Office

# TOMS

**Reg. No. 4,410,344**

**Registered Oct. 1, 2013**

**Int. Cl.: 35**

**SERVICE MARK**

**PRINCIPAL REGISTER**

MYCOSKIE, LLC (CALIFORNIA LIMITED LIABILITY COMPANY)  
5404 JANDY PLACE  
LOS ANGELES, CA 90066

FOR: ON-LINE RETAIL STORE SERVICES FEATURING FOOTWEAR, APPAREL, EYEWEAR, JEWELRY, BOOKS, JOURNALS, AND GIFT PACKS CONSISTING OF DVDS AND POSTERS; RETAIL STORE SERVICES FEATURING FOOTWEAR, APPAREL, EYEWEAR, JEWELRY, BOOKS, JOURNALS, AND GIFT PACKS CONSISTING OF DVDS AND POSTERS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 5-15-2006; IN COMMERCE 5-15-2006.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 3,353,902, 4,313,981 AND OTHERS.

SER. NO. 85-829,961, FILED 1-23-2013.

ROBIN CHOSID, EXAMINING ATTORNEY



*Lea Street Lea*

Deputy Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
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**Requirements in the First Ten Years\***  
**What and When to File:**

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***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***  
**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

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**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

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**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

# United States of America

United States Patent and Trademark Office

# TOMS

**Reg. No. 4,602,798**

**Registered Sep. 9, 2014**

**Int. Cl.: 30**

MYCOSKIE, LLC (CALIFORNIA LIMITED LIABILITY COMPANY)  
5404 JANDY PLACE  
LOS ANGELES, CA 90066

FOR: COFFEE AND COFFEE-BASED BEVERAGES; AND ARTIFICIAL COFFEE, IN CLASS  
30 (U.S. CL. 46).

**TRADEMARK**

FIRST USE 3-15-2014; IN COMMERCE 3-15-2014.

**PRINCIPAL REGISTER**

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 4,274,178, 4,403,201, AND 4,403,205.

SN 85-982,306, FILED 6-20-2013.

MARILYN IZZI, EXAMINING ATTORNEY



*Michelle K. Lee*

Deputy Director of the United States  
Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
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**Requirements in the First Ten Years\***

**What and When to File:**

**First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

**Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

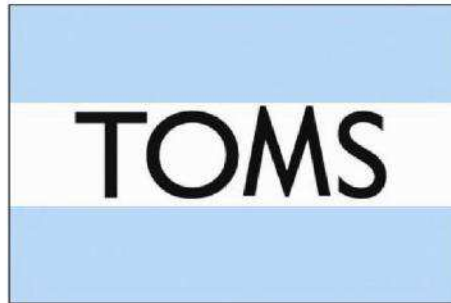
**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

# United States of America

United States Patent and Trademark Office



**Reg. No. 3,765,503** MYCOSKIE, LLC (CALIFORNIA LIMITED LIABILITY COMPANY)  
Registered Mar. 23, 2010 3025 OLYMPIC BOULEVARD, STAGE C  
SANTA MONICA, CA 90404

**Int. Cl.: 25** FOR: BASEBALL CAPS; CAPS; HATS; CANVAS SHOES; FOOTWEAR FOR MEN AND WOMEN; SHOES; AND SHIRTS, IN CLASS 25 (U.S. CLS. 22 AND 39).

**TRADEMARK** FIRST USE 5-7-2006; IN COMMERCE 5-7-2006.  
**PRINCIPAL REGISTER**

THE APPLICANT CLAIMS COLOR AS A FEATURE OF THE MARK, NAMELY, BLACK, BLUE AND WHITE.

THE MARK CONSISTS OF A FLAG-LIKE LOGO WITH THREE EQUAL SIZED STRIPES, THE STRIPES ARE BLUE ON THE TOP AND BOTTOM AND WHITE IN THE MIDDLE WITH THE TERM TOMS PRINTED IN BLACK LETTERING IN THE MIDDLE WHITE STRIPE, AND A THIN BLACK LINE OUTLINING THE ENTIRE MARK.

SN 78-831,855, FILED 3-8-2006.

CARRIE GENOVESE, EXAMINING ATTORNEY

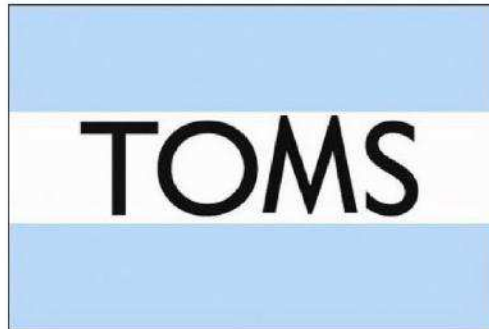


*David J. Kyros*

Director of the United States Patent and Trademark Office

# United States of America

United States Patent and Trademark Office



**Reg. No. 4,274,178**

**Registered Jan. 15, 2013**

**Int. Cl.: 35**

**SERVICE MARK**

**PRINCIPAL REGISTER**

MYCOSKIE, LLC (CALIFORNIA LIMITED LIABILITY COMPANY)  
STAGE C 3025  
OLYMPIC BOULEVARD  
SANTA MONICA, CA 90404

FOR: RETAIL STORE SERVICES AND ON-LINE RETAIL STORE SERVICES IN THE FIELD OF FOOTWEAR, APPAREL, EYEWEAR, JEWELRY, BOOKS, JOURNALS, AND GIFT PACKS CONSISTING OF DVDS AND POSTERS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 5-15-2000; IN COMMERCE 5-15-2000.

OWNER OF U.S. REG. NOS. 3,353,902, 3,662,112 AND OTHERS.

THE COLOR(S) BLUE, WHITE AND BLACK IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF A FLAG-LIKE LOGO WITH THREE EQUAL SIZED STRIPES. THE STRIPES ARE BLUE ON THE TOP AND BOTTOM AND WHITE IN THE MIDDLE WITH THE TERM "TOMS" PRINTED IN BLACK LETTERING IN THE MIDDLE WHITE STRIPE, AND A THIN BLACK LINE OUTLINING THE ENTIRE MARK.

SER. NO. 85-446,592, FILED 10-13-2011.

BILL DAWE, EXAMINING ATTORNEY



*David J. Kappas*

Director of the United States Patent and Trademark Office



**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

**First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

**Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

# United States of America

United States Patent and Trademark Office



TOMS

**Reg. No. 4,403,205**

**Registered Sep. 17, 2013**

**Int. Cl.: 43**

**SERVICE MARK**

**PRINCIPAL REGISTER**

MYCOSKIE, LLC (CALIFORNIA LIMITED LIABILITY COMPANY)  
5404 JANDY PLACE  
LOS ANGELES, CA 90066

FOR: CHARITABLE SERVICES, NAMELY, PROVIDING SAFE DRINKING WATER TO THOSE IN DEVELOPING COUNTRIES, IN CLASS 43 (U.S. CLS. 100 AND 101).

FIRST USE 4-15-2010; IN COMMERCE 4-15-2010.

OWNER OF U.S. REG. NOS. 3,566,093, 4,313,981 AND OTHERS.

THE COLOR(S) BLUE, WHITE AND BLACK IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF TWO BLUE BARS WITH A WHITE BAR IN THE MIDDLE, AND THE WORD "TOMS" IN BLACK INSIDE THE WHITE BAR.

SER. NO. 85-845,080, FILED 2-8-2013.

ROBIN CHOSID, EXAMINING ATTORNEY



*Lea Street Lee*

Deputy Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE:** Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

# United States of America

United States Patent and Trademark Office



**Reg. No. 4,517,359**

**Registered Apr. 22, 2014**

**Int. Cl.: 9**

**TRADEMARK**

**PRINCIPAL REGISTER**

MYCOSKIE, LLC (CALIFORNIA LIMITED LIABILITY COMPANY)  
5404 JANDY PLACE  
LOS ANGELES, CA 90066

FOR: EYEWEAR, NAMELY, SUNGLASSES, EYEGLASSES AND OPHTHALMIC FRAMES  
AND CASES THEREFORE, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 6-6-2011; IN COMMERCE 6-6-2011.

OWNER OF U.S. REG. NOS. 4,192,925, 4,313,981 AND OTHERS.

THE COLOR(S) BLACK, BLUE AND WHITE IS/ARE CLAIMED AS A FEATURE OF THE  
MARK.

THE MARK CONSISTS OF A FLAG-LIKE LOGO WITH THREE EQUAL SIZED STRIPES,  
THE STRIPES ARE BLUE ON THE TOP AND BOTTOM AND WHITE IN THE MIDDLE WITH  
THE TERM "TOMS" PRINTED IN BLACK LETTERING IN THE MIDDLE WHITE STRIPE,  
AND A THIN BLACK LINE OUTLINING THE ENTIRE MARK.

SER. NO. 86-006,856, FILED 7-10-2013.

MARILYN IZZI, EXAMINING ATTORNEY



*Michelle K. Lee*

Deputy Director of the United States  
Patent and Trademark Office



**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

**First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

**Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

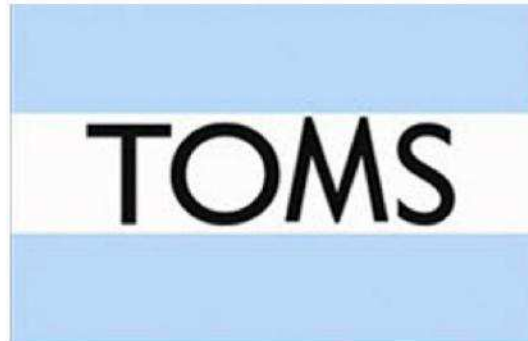
**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

# United States of America

United States Patent and Trademark Office



**Reg. No. 4,602,814**

**Registered Sep. 9, 2014**

**Int. Cl.: 30**

**TRADEMARK**

**PRINCIPAL REGISTER**

MYCOSKIE, LLC (CALIFORNIA LIMITED LIABILITY COMPANY)  
5404 JANDY PLACE  
LOS ANGELES, CA 90066

FOR: COFFEE AND COFFEE-BASED BEVERAGES; AND ARTIFICIAL COFFEE, IN CLASS 30 (U.S. CL. 46).

FIRST USE 3-15-2014; IN COMMERCE 3-15-2014.

OWNER OF U.S. REG. NOS. 4,274,178, 4,403,201, AND 4,403,205.

THE COLOR(S) BLACK, BLUE AND WHITE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF FLAG-LIKE LOGO WITH THREE EQUAL SIZED STRIPES, THE STRIPES ARE BLUE ON THE TOP AND BOTTOM AND WHITE IN THE MIDDLE WITH THE TERM "TOMS" PRINTED IN BLACK LETTERING IN THE MIDDLE WHITE STRIPE, AND A THIN BLACK LINE OUTLINING THE ENTIRE MARK.

SN 85-982,450, FILED 6-20-2013.

MARILYN IZZI, EXAMINING ATTORNEY



*Michelle K. Lee*

Deputy Director of the United States  
Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

**First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

**Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

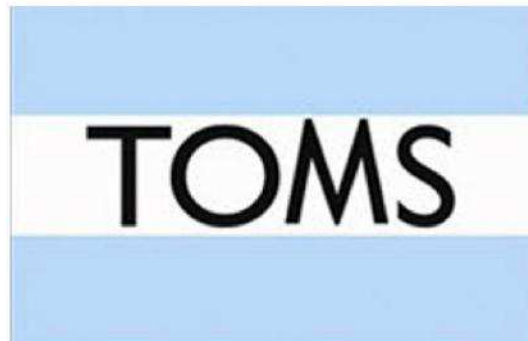
**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**



# United States of America

United States Patent and Trademark Office



**Reg. No. 4,805,580**

**Registered Sep. 1, 2015**

**Int. Cl.: 18**

**TRADEMARK**

**PRINCIPAL REGISTER**

MYCOSKIE, LLC (CALIFORNIA LIMITED LIABILITY COMPANY)  
5404 JANDY PLACE  
LOS ANGELES, CA 90066

FOR: GOODS MADE OF LEATHER OR IMITATIONS OF LEATHER, NAMELY, CARD WALLETS, CLUTCH BAGS, CLUTCH PURSES, COSMETIC BAGS SOLD EMPTY, COSMETIC CASES SOLD EMPTY, KEY WALLETS, AND LUGGAGE; BAGS, NAMELY, ALL-PURPOSE CARRYING BAGS, ALL-PURPOSE ATHLETIC BAGS, AND BACKPACKS; TRUNKS; TOTE BAGS; TRAVELLING BAGS; RUCKSACKS; SACHELS; HOLDALLS; HANDBAGS; SHOULDER BAGS; CANVAS SHOPPING BAGS; PURSES; WALLETS; CREDIT CARD HOLDERS OF LEATHER AND IMITATIONS OF LEATHER; POCHETTES; LUGGAGE LABEL HOLDERS AND TAGS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

FIRST USE 2-25-2015; IN COMMERCE 2-25-2015.

OWNER OF U.S. REG. NOS. 3,327,341, 3,765,503, AND OTHERS.

THE COLOR(S) BLACK, BLUE, AND WHITE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF FLAG-LIKE LOGO WITH THREE EQUAL SIZED STRIPES, THE STRIPES ARE BLUE ON THE TOP AND BOTTOM AND WHITE IN THE MIDDLE WITH THE TERM "TOMS" PRINTED IN BLACK LETTERING IN THE MIDDLE WHITE STRIPE.

SN 86-976,806, FILED 7-8-2013.

MARILYN IZZI, EXAMINING ATTORNEY



*Michelle K. Lee*

Director of the United States  
Patent and Trademark Office



**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

**First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

**Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

**NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.**

# United States of America

United States Patent and Trademark Office



**Reg. No. 4,827,152**

**Registered Oct. 6, 2015**

**Int. Cls.: 21 and 43**

**TRADEMARK**

**SERVICE MARK**

**PRINCIPAL REGISTER**

MYCOSKIE, LLC (CALIFORNIA LIMITED LIABILITY COMPANY)  
5404 JANDY PLACE  
LOS ANGELES, CA 90066

FOR: CUPS, MUGS, INSULATED COFFEE AND BEVERAGE CUPS, AND BEVERAGE GLASSWARE; THERMAL INSULATED BOTTLES; PORTABLE BOTTLES SOLD EMPTY; INSULATING SLEEVES FOR BEVERAGE CUPS; PAPER AND PLASTIC CUPS, IN CLASS 21 (U.S. CLS. 2, 13, 23, 29, 30, 33, 40 AND 50).

FIRST USE 3-15-2014; IN COMMERCE 3-15-2014.

FOR: CAFÉ SERVICES, COFFEE BAR SERVICES AND COFFEE HOUSE SERVICES, IN CLASS 43 (U.S. CLS. 100 AND 101).

FIRST USE 3-15-2014; IN COMMERCE 3-15-2014.

OWNER OF U.S. REG. NOS. 3,353,902, 3,765,503 AND OTHERS.

THE COLOR(S) BLACK, BLUE, AND WHITE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF THREE EQUAL SIZED STRIPES. THE STRIPES ARE BLUE ON THE TOP AND BOTTOM AND WHITE IN THE MIDDLE WITH THE TERM "TOMS" PRINTED IN BLACK LETTERING IN THE MIDDLE WHITE STRIPE.

SER. NO. 86-582,778, FILED 3-31-2015.

DANIEL CAPSHAW, EXAMINING ATTORNEY



*Michelle K. Lee*

Director of the United States  
Patent and Trademark Office



**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
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**Requirements in the First Ten Years\***

**What and When to File:**

**First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

**Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

**NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.**

# **EXHIBIT 2**

Int. Cls.: 18 and 25

Prior U.S. Cls.: 3 and 39

United States Patent and Trademark Office

Reg. No. 1,459,226

Registered Sep. 29, 1987

TRADEMARK  
PRINCIPAL REGISTER



TOMAIFICIO 2D S.R.L. (ITALY LIMITED COMPANY)  
VIALE MONTEMANOVRA  
COMUNANZA, ASCOLI PICENO, ITALY

FOR: PURSES, HANDBAGS, BRIEFCASES, LEATHER AND/OR HEAVY CLOTH HANDBAGS AND SUITCASES, IN CLASS 18 (U.S. CL. 3).

FOR: SHOES, OVERSHOES, RUBBER OVERSHOES, BOOTS, SLIPPERS, AND BELTS, IN CLASS 25 (U.S. CL. 39).

PRIORITY CLAIMED UNDER SEC. 44(D) ON ITALY APPLICATION NO. 33813/C86, FILED 4-11-1986, REG. NO. 340133, DATED 2-4-1985, EXPIRES 4-11-2006.

THE LINING IS A FEATURE OF THE MARK AND DOES NOT INDICATE COLOR.

SER. NO. 601,237, FILED 5-29-1986.

DEBORAH S. COHN, EXAMINING ATTORNEY

# **EXHIBIT 3**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. 86/004,044

Filed: July 8, 2013

For Mark: TOMS

Published in the Official Gazette: April 29, 2014

In re Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344

Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013

For Mark: TOMS

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TOD'S S.P.A.,

Opposer,

v.

Opposition No. 91218001

MYCOSKIE, LLC,

Applicant.

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TOD'S S.P.A.,

Petitioner,

v.

Cancellation No. 92061234

MYCOSKIE, LLC,

Respondent.

----- X

**OPPOSER/PETITIONER'S RESPONSES TO  
APPLICANT/RESPONDENT'S SECOND SET OF INTERROGATORIES**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and 37 C.F.R. §2.120,  
Opposer/Petitioner Tod's S.p.A. hereby responds to Applicant/Respondent's Second Set of  
Interrogatories as follows:

## **GENERAL OBJECTIONS TO ALL REQUESTS**

A. Opposer/Petitioner objects to all interrogatories to the extent they purport to require the disclosure of information which is subject to the attorney-client privilege, the attorney's work product privilege or any other applicable privilege or immunity on the ground that such discovery is impermissible under Rule 26(b) of the Federal Rules of Civil Procedure. None of Opposer/Petitioner's specific responses shall be construed to mean that Opposer/Petitioner intends to provide privileged information or produce privileged documents in the absence of an intentional waiver. Any inadvertent disclosure of privileged information or production of privileged documents shall not constitute a waiver of an otherwise valid claim of privilege, and any failure to assert a privilege as to certain information or documents shall not be deemed to constitute a waiver of the privilege as to any other information or documents so protected.

B. Opposer/Petitioner objects to all interrogatories to the extent they seek disclosure of confidential or proprietary technical, commercial, financial/economic or business information or trade secrets. Such information or documents containing or comprising such information will only be provided in accordance with the terms of the Board's standard protective order applicable to this case or some other protective order agreed to by the parties and entered by the Board.

C. Opposer/Petitioner objects to all interrogatories insofar as they purport to require the disclosure of information outside its possession, custody or control.

D. Opposer/Petitioner objects to the definition of "Tod's," "You" or "Your" on the grounds that they are overbroad and unduly burdensome and purport to impose obligations on Opposer/Petitioner to provide information outside its possession, custody or control.



E. Opposer/Petitioner states that it has made a good faith effort to respond to the interrogatories, but reserves the right to provide any additional information that might be located at any future time.

F. Without waiving these general objections and the additional objections set forth below in response to specific requests, Opposer/Petitioner responds, subject to these objections, as set forth below.

### **RESPONSES TO INTERROGATORIES**

#### **INTERROGATORY NO. 13:**

Identify any watch service with whom You have contracted to identify possible infringements of, or otherwise monitor the strength of, the TOD'S Mark.

#### **RESPONSE NO. 13**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving those objections, Opposer/Petitioner identifies CompuMark as a watch service with which its counsel has contracted on behalf of Opposer/Petitioner with respect to the TOD'S Mark.

#### **INTERROGATORY NO. 14:**

Identify any Person, including any Person employed by You, who is responsible for identifying possible infringements, or otherwise monitoring the strength of, the TOD'S Mark.

#### **RESPONSE NO. 14**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving those objections, Opposer/Petitioner identifies:

Andrea Varsavia  
General Counsel (Tod's)  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

**INTERROGATORY NO. 15:**

Identify the Person(s) who decided to file and/or approved the filing of the Notice of Opposition.

**RESPONSE NO. 15**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving those objections, Opposer/Petitioner identifies:

Stefano Sincini  
Co-Chief Executive Officer, Executive Director, General Manager  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

**INTERROGATORY NO. 16:**

Identify the Person(s) who decided to file and/or approved the filing of the Petition for Cancellation.

**RESPONSE NO. 16**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving those objections, Opposer/Petitioner identifies:

Andrea Varsavia  
General Counsel (Tod's)  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

**INTERROGATORY NO. 17:**

Identify any Person(s), employed by You, responsible for deciding whether to file an opposition and/or cancellation proceeding.

**RESPONSE NO. 17**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving those objections, Opposer/Petitioner identifies:

Andrea Varsavia  
General Counsel (Tod's)  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

**INTERROGATORY NO. 18:**

Identify any Person(s), employed by You, responsible for deciding whether to file a lawsuit alleging infringement(s) of the TOD'S Mark.

**RESPONSE NO. 18**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving those objections, Opposer/Petitioner identifies:

Andrea Varsavia  
General Counsel (Tod's)  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

**INTERROGATORY NO. 19:**

State the date(s) upon which the Person(s) identified in response to Interrogatory No. 14 first became aware of the TOMS brand and/or the TOMS Marks.

**RESPONSE NO. 19**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving those objections, Opposer/Petitioner states that, to the best of its knowledge and control, Andrea Varsavia, General Counsel of Opposer/Petitioner, first became aware of the TOMS brand and/or the TOMS Marks in or around December 2014.

**INTERROGATORY NO. 20:**

State the date(s) upon which the Person(s) identified in response to Interrogatory No. 15 first became aware of the TOMS brand and/or the TOMS Marks.

**RESPONSE NO. 20**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous, unduly burdensome and seeks information which is outside Opposer/Petitioner's possession, custody or control. Subject to and without waiving those objections, Opposer/Petitioner states that, to the best of its knowledge and control, Stefano Sincini, Co-Chief Executive Officer, Executive Director, General Manager of Opposer/Petitioner, first became aware of the TOMS brand and/or the TOMS Marks in or around July 2011.

**INTERROGATORY NO. 21:**

State the date(s) upon which the Person(s) identified in response to Interrogatory No. 16 first became aware of the TOMS brand and/or the TOMS Marks.

**RESPONSE NO. 21**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving those objections, Opposer/Petitioner states that, to the best of its knowledge and control, Andrea Varsavia, General Counsel of Opposer/Petitioner, first became aware of the TOMS brand and/or the TOMS Marks in or around December 2014.

**INTERROGATORY NO. 22:**

State the date(s) upon which the Person(s) identified in response to Interrogatory No. 17 first became aware of the TOMS brand and/or the TOMS Marks.

**RESPONSE NO. 22**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving those objections, Opposer/Petitioner states that, to the best of its knowledge and control, Andrea Varsavia, General Counsel of Opposer/Petitioner, first became aware of the TOMS brand and/or the TOMS Marks in or around December 2014.

**INTERROGATORY NO. 23:**

State the date(s) upon which the Person(s) identified in response to Interrogatory No. 18 first became aware of the TOMS brand and/or the TOMS Marks.

**RESPONSE NO. 23**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving those objections, Opposer/Petitioner states that, to the best of its knowledge and control, Andrea Varsavia, General Counsel of Opposer/Petitioner, first became aware of the TOMS brand and/or the TOMS Marks in or around December 2014.

**INTERROGATORY NO. 24:**

State the earliest date upon which any current officer of Tod's first became aware of the TOMS brand and/or the TOMS Marks, and identify that Person by name and current title with Tod's.

**RESPONSE NO. 24**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous, overbroad and unduly burdensome. Subject to and without waiving those objections, Opposer states that the information requested is not reasonably available as, among other things, Opposer/Petitioner's organization is comprised of numerous individuals who may qualify as officers within the meaning of U.S. law and it is not reasonably practicable to ascertain the date on which each such person may or may not have been aware of the TOMS brand and/or the TOMS Marks.

**INTERROGATORY NO. 25:**

State the date upon which Claudio Castiglioni first became aware of the TOMS brand and/or the TOMS Marks.

**RESPONSE NO. 25:**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving those objections, Opposer/Petitioner states that, to the best of its knowledge and control, Claudio Castiglioni first became aware of the TOMS brand and/or the TOMS Marks in or around July 2011.

**INTERROGATORY NO. 26:**

State the date upon which Stephanie Rothfeld first became aware of the TOMS brand and/or the TOMS Marks.

**RESPONSE NO. 26:**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving those objections, Opposer/Petitioner states that, to the best of its knowledge and control, Stephanie Rothfeld first became aware of the TOMS brand and/or the TOMS Marks in or around 2010.

**INTERROGATORY NO. 27:**

State the date upon which Silvia Pinotti first became aware of the TOMS brand and/or the TOMS Marks

**RESPONSE NO. 27:**

Opposer/Petitioner objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving those objections, Opposer/Petitioner states that, to the best of its knowledge and control, Silvia Pinotti first became aware of the TOMS brand

and/or the TOMS Marks in January 2015.

Dated: New York, New York  
September 11, 2015

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.  
Attorneys for Opposer/Petitioner

By: 

Richard S. Mandel

Aryn M. Emert

1133 Avenue of the Americas  
New York, New York 10036-6799  
(212) 790-9200



**VERIFICATION**

On behalf of Opposer/Petitioner, Claudio Castiglioni declares as follows: I am General Brand Manager (Tod's) for Opposer/Petitioner Tod's S.p.A. and am authorized to make this verification on behalf of Opposer/Petitioner; I have read the foregoing Opposer/Petitioner's Responses to Applicant/Respondent's Second Set of Interrogatories and know the responses set forth therein to be true and accurate to the best of my knowledge and belief based upon my personal knowledge, review of company records and/or discussions with relevant individuals employed by or acting on behalf of Tod's. I declare under penalty of perjury under the laws of the United States that the foregoing is true and accurate.

Dated: Milan, Italy  
September 08, 2015

  
\_\_\_\_\_  
CLAUDIO CASTIGLIONI



# **EXHIBIT 4**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 86/004,044

Filed: July 8, 2013

For Mark: TOMS

Published in the Official Gazette: April 29, 2014

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TOD'S S.P.A.,

:

Opposer,

:

Opposition No.

v.

:

**NOTICE OF OPPOSITION**

MYCOSKIE, LLC,

:

Applicant.

:

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Opposer Tod's S.p.A., an Italian joint stock company located at Via Filippo Della Valle, 1, Sant'Elpidio A Mare, Ascoli Piceno, 63019, ITALY, believes that it would be damaged by registration of the mark shown in Serial No. 86/004,044 filed July 8, 2013 and having been granted an extension of time to oppose up to and including August 27, 2014, hereby opposes same.





As ground for opposition, it is alleged that:


1. For many years, Opposer, including its affiliated and related companies (collectively, "Opposer"), has been in the business of selling apparel, shoes, bags and other goods and accessories.

2. Since well prior to Applicant's filing of its application for the mark at issue in this proceeding, Opposer has used the mark TOD'S in connection with a wide variety of goods and services, including various goods in Class 18.

3. As a result of the extensive sales and promotion of its goods and services bearing or offered in connection with Opposer's TOD'S mark, Opposer has built up highly valuable goodwill in the TOD'S mark, and said goodwill has become closely and uniquely identified and associated with Opposer.

4. Opposer is the owner of several federal trademark registrations for marks containing the TOD'S mark together with other words and/or design elements, including the following registrations which were obtained prior to the filing date of the Application:

Mark	Reg. No.	Intl. Class	Reg. Date
	2,749,125	16, 18, 25, 35	Aug. 12, 2003
	1,459,226	18, 25	Sept. 29, 1987
	3,602,493	25	April 7, 2009
	3,831,949	3, 8, 9, 14, 16, 19, 20, 21, 24, 35	Aug. 10, 2010

	4,036,992	9, 14, 18, 25	Oct. 11, 2011
TOD'S SIG	4,333,244	3, 9, 14, 18, 25	May 14, 2013

5. Upon information and belief, on July 8, 2013, Applicant filed an intent-to-use application in the United States Patent and Trademark Office, Serial No. 86/004,044 (the “Application”), to register the mark TOMS (“Applicant’s Mark”) for “Goods made of leather or imitations of leather, namely, card wallets, clutch bags, clutch purses, cosmetic bags sold empty, cosmetic cases sold empty, key bags, key cases, key wallets, and luggage; bags, namely, all-purpose carrying bags, all-purpose athletic bags, and backpacks; trunks; valises; suitcases; tote bags; travelling bags; garment bags for travel; rucksacks; satchels; holdalls; handbags; shoulder bags; canvas shopping bags; wheeled shopping bags and purses; jewelry pouches; wallets; credit card holders of leather and imitations of leather; pochettes; luggage label holders and tags; collars for pets; and leashes for animals “ in International Class 18.

6. The goods offered by Applicant under Applicant’s Mark are identical and/or closely related to the goods and services offered by Opposer under Opposer’s TOD’S mark.

7. Applicant’s Mark so resembles Opposer’s TOD’S mark as to be likely, when used in connection with the applied for goods, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant’s goods have their origin with Opposer and/or that such goods are approved, endorsed or sponsored by Opposer or associated in some way with Opposer.

8. Opposer's TOD'S mark is distinctive and famous and has enjoyed such distinctiveness and fame since long prior to Applicant's filing of the Application.

9. Applicant's Mark is likely to dilute the distinctiveness of Opposer's famous TOD'S Mark by blurring.

10. Opposer would be injured by the granting to Applicant of a registration for Applicant's Mark for the goods recited in the Application because such mark so resembles Opposer's TOD'S mark as to be likely, when used in connection with Applicant's goods, (a) to cause confusion, or to cause mistake, or to deceive; (b) to falsely suggest a connection with Opposer and/or its TOD'S branded goods and services; (c) to damage Opposer's valuable goodwill in its TOD'S mark; (d) to interfere with Opposer's own use and exploitation of its TOD'S mark; and (e) to dilute the distinctiveness of Opposer's TOD'S mark.

WHEREFORE, Opposer, by its attorneys, respectfully requests that its opposition be sustained and the application for registration be denied.

Dated: New York, New York  
August 25, 2014

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.  
Attorneys for Opposer

By: /Richard S. Mandel/  
Richard S. Mandel  
Lindsay M. Rodman  
1133 Avenue of the Americas  
New York, New York 10036-6799  
(212) 790-9200

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of this Notice of Opposition was served upon the correspondent for the opposed application by mailing a copy thereof by first class mail, postage prepaid, on August 25, 2014 addressed as follows:

Louis S. Ederer, Esq.  
Arnold & Porter LLP  
555 12<sup>th</sup> St NW, Suite 100  
Washington, D.C. 20004-1206

/Richard S. Mandel/  
RICHARD S. MANDEL, ESQ.

# **EXHIBIT 5**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 86/004044  
Filed: July 8, 2013  
Published in the *Official Gazette* on April 29, 2014  
For the mark: TOMS

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	:	
TOD'S S.P.A.,	:	
	:	
<i>Opposer,</i>	:	OPPOSITION NO.: 91218001
	:	
v.	:	
	:	
MYCOSKIE, LLC,	:	
	:	
<i>Applicant.</i>	:	
-----	X	

**ANSWER TO NOTICE OF OPPOSITION**

Applicant Mycoskie, LLC ("Applicant"), by and through its undersigned counsel, hereby answers the Notice of Opposition filed by Tod's S.p.A. ("Opposer") against Applicant's application to register the word mark TOMS, identified in Application Serial No. 86/004044 ("Applicant's TOMS Mark") in International Class 18, as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 1, and accordingly denies such allegations.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 2, and accordingly denies such allegations.
3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 3, and accordingly denies such allegations.
4. Applicant admits the allegations in Paragraph 4.






5. Applicant admits the allegations in Paragraph 5.
6. Applicant denies the allegations in Paragraph 6.
7. Applicant denies the allegations in Paragraph 7.
8. Applicant denies the allegations in Paragraph 8.
9. Applicant denies the allegations in Paragraph 9.
10. Applicant denies the allegations in Paragraph 10.

**FACTS COMMON TO ALL AFFIRMATIVE DEFENSES**

1. Applicant is the proprietor of the well-known TOMS brand for footwear, eyewear, apparel, and other related products and services. Applicant's TOMS mark has been continuously in use in the United States since May 2006.
2. Applicant owns the following federal trademark registrations and/or pending applications for the TOMS word mark for various related goods and services (collectively, the "TOMS Marks"):

<b>International Class and Goods/Services</b>	<b>Reg. No./ Serial No.</b>
25 (Canvas shoes, Shoes)	Reg. No. 3,353,902 Reg. Date: 12/11/07 Status: Incontestable as of 11/30/13
25 (Clothing, namely, canvas shoes, shoes, caps, shirts, t-shirts and hats)	Reg. No. 3,566,093 Reg. Date: 1/20/2009 Status: Incontestable as of 4/1/14
25 (Clothing, namely, hoods, jerseys, tops and jackets)	Reg. No. 3,662,112 Reg. Date: 7/28/09 Status: Section 8 & 15 filed 8/28/14

<b>International Class and Goods/Services</b>	<b>Reg. No./ Serial No.</b>
25 (clothing, namely, one piece garments for infants and babies)	Reg. No. 4,097,948 Reg. Date: 2/14/12
9 (Sunglasses and cases for sunglasses)	Reg. No. 4,192,925 Reg. Date: 8/21/12
9 (Eyewear, namely, sunglasses, eyeglasses and ophthalmic frames and cases therefore)	Reg. No. 4,313,981 Reg. Date: 4/2/13
35 (On-line retail store services featuring footwear, apparel, eyewear, jewelry, books, journals, and gift packs consisting of DVDs and posters; Retail store services featuring footwear, apparel, eyewear, jewelry, books, journals, and gift packs consisting of DVDs and posters)	Reg. No. 4,410,344 Reg. Date: 7/16/13
30 (Coffee and coffee-based beverages; and artificial coffee)	Reg. No. 4,602,798 Reg. Date: 9/9/14
30 (Tea; cocoa)	Ser. No. 85/965,239 App. Date: 1/20/13 Status: Published for Opposition on 12/3/13, not opposed

3. Applicant also owns numerous applications and registrations for the mark TOMS and Design (  ), including applications including Class 18 for the same goods as Applicant's TOMS Mark, namely,  (Ser. No. 86/004,053), and  (Ser. No. 86/242,690) (collectively, the "TOMS and Design Marks"). The foregoing marks have been published for opposition, and have not been opposed.

4. Opposer has never filed any opposition or cancellation proceedings against any of the TOMS Marks or TOMS and Design Marks referenced in Paragraphs 2 and 3 above, and all such marks have either registered, or are awaiting registration.

5. Since at least as early as May 2006, identical and/or related products and services bearing the TOMS Marks and Opposer's TOD'S mark have coexisted in the United States marketplace — frequently being sold in the very same retail locations, including, without limitation, the Nordstrom and Neiman Marcus department store chains — without any known instances of actual confusion, or any indication whatsoever that confusion is likely.

#### **AFFIRMATIVE DEFENSES**

6. The Notice of Opposition fails to state a claim upon which relief can be granted.

7. Opposer is barred from any relief because there is no likelihood of confusion between Applicant's TOMS Mark and Opposer's TOD'S mark.

8. Opposer is barred from any relief because Applicant owns prior registrations for essentially the same mark in connection with essentially the same goods and/or services as Applicant's TOMS Mark.

9. Opposer is barred from any relief under the doctrine of estoppel.

10. Opposer is barred from any relief under the doctrine of waiver.

11. Opposer is barred from any relief under the doctrine of laches.

12. Opposer is barred from any relief under the doctrine of acquiescence.

13. Opposer is barred from any relief under the doctrine of unclean hands.

#### **PRAYER FOR RELIEF**

WHEREFORE, Applicant respectfully prays that the Board dismiss the Opposition and grant registration of Applicant's TOMS Mark on the Principal Register in International Class 18.

Dated: September 30, 2014

Respectfully submitted,

ARNOLD & PORTER LLP

By: /Louis S. Ederer/

Louis S. Ederer  
399 Park Avenue  
New York, New York 10022  
Telephone: (212) 715-1000  
Facsimile: (212) 715-1399  
louis.ederer@aporter.com  
trademarkdocketing@aporter.com

*Attorneys for Applicant Mycoskie, LLC*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on September 30, 2014 a copy of the foregoing  
ANSWER TO NOTICE OF OPPOSITION was served by First Class Mail upon the following  
counsel of record for Opposer Tod's S.p.A.:

Richard S. Mandel, Esq.  
Lindsay M. Rodman, Esq.  
COWAN, LIEBOWITZ & LATMAN, P.C.  
1133 Avenue of the Americas  
New York, New York 10036-6799

*Attorneys for Opposer Tod's S.p.A.*

/Louis S. Ederer/  
Louis S. Ederer

# **EXHIBIT 6**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 85/240,714  
Filed: February 11, 2011  
For Mark: PODS  
Published in the Official Gazette: February 7, 2012

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TOD'S S.P.A,	:	
	Opposer,	: Opposition No.
v.	:	<b><u>NOTICE OF OPPOSITION</u></b>
ETICKET DOMAINS LLC,	:	
	Applicant.	:

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Opposer Tod's S.p.A., an Italian Società per Azioni located at Via Filippo Della Valle, 1, Sant'Elpidio A Mare, 63019, ITALY, believes that it would be damaged by registration of the mark shown in Serial No. 85/240,714 (for the goods in Classes 9 and 18) filed February 11, 2011 and having been granted an extension of time to oppose up to and including August 5, 2012, hereby opposes same.





As ground for opposition, it is alleged that:

1. For many years, Opposer, including its affiliated and related companies (collectively, "Opposer"), has been in the business of selling apparel, shoes, bags and other goods and accessories.

2. Since well prior to Applicant's filing its application for the mark at issue in this proceeding, Opposer has used the mark TOD'S in connection with a wide variety of goods and services, including various goods in Classes 9 and 18.

3. As a result of the extensive sales and promotion of its goods and services bearing or offered in connection with Opposer's TOD'S mark, Opposer has built up highly valuable goodwill in the TOD'S mark, and said goodwill has become closely and uniquely identified and associated with Opposer.

4. Opposer is the owner of several federal trademark registrations for marks containing the TOD'S mark together with other words and/or design elements, including the following registrations which were obtained prior to the filing date of the Application:

Mark	Reg. No.	Intl. Class	Reg. Date
	2,749,125	16, 18, 25, 35	Aug. 12, 2003
	1,459,226	18, 25	Sept. 29, 1987
	3,602,493	25	April 7, 2009
	3,831,949	3, 8, 9, 14, 16, 19, 20, 21, 24, 35	Aug. 10, 2010



5. Upon information and belief, on February 11, 2011, Applicant filed an intent-to-use application in the United States Patent and Trademark Office, Serial No. 85/240,714 (the “Application”), to register the mark PODS (“Applicant’s Mark”) for “Protective carrying cases for personal digital assistants (PDA's), cameras and cell phones “ in International Class 9, and “women's handbags” in International Class 18.

6. Upon information and belief, Applicant did not use the PODS mark in commerce in the United States prior to the filing of the Application and has made no use of the PODS mark in commerce in the United States as of the present time.

7. The goods offered by Applicant under Applicant’s Mark are closely related to the goods and services offered by Opposer under Opposer’s TOD’S mark.

8. Applicant’s Mark so resembles Opposer’s TOD’S mark as to be likely, when used in connection with the applied for goods in Classes 9 and 18, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant’s goods have their origin with Opposer and/or that such goods are approved, endorsed or sponsored by Opposer or associated in some way with Opposer.

9. Opposer’s TOD’S mark is distinctive and famous and has enjoyed such distinctiveness and fame since long prior to Applicant’s filing of the Application.

10. Applicant’s Mark is likely to dilute the distinctiveness of Opposer’s famous TOD’S Mark.

11. Opposer would be injured by the granting to Applicant of a registration for Applicant’s Mark for the goods recited in the Application in Classes 9 and 18 because such mark so resembles Opposer's TOD’S mark as to be likely, when used in connection with Applicant's goods, (a) to cause confusion, or to cause mistake, or to deceive; (b) to falsely suggest a

connection with Opposer and/or its TOD'S branded goods and services; (c) to damage Opposer's valuable goodwill in its TOD'S mark; (d) to interfere with Opposer's own use and exploitation of its TOD'S mark; and (e) to dilute the distinctiveness of Opposer's TOD'S mark.

WHEREFORE, Opposer, by its attorneys, respectfully requests that its opposition be sustained and the application for registration be denied.

Dated: New York, New York  
August 3, 2012

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.  
Attorneys for Opposer

By: /Richard S. Mandel/  
Richard S. Mandel  
1133 Avenue of the Americas  
New York, New York 10036-6799  
(212) 790-9200

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of this Notice of Opposition was served upon the correspondent for the opposed application by mailing a copy thereof by first class mail, postage prepaid, on August 3, 2012 addressed as follows:

PAUL D. SUPNIK, ESQ.  
LAW OFFICE OF PAUL D. SUPNIK  
9401 WILSHIRE BLVD STE 1250  
BEVERLY HILLS, CA 90212

/Richard S. Mandel/  
RICHARD S. MANDEL, ESQ.

# **EXHIBIT 7**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Tod's S.p.A.,

Opposer,

v.

Duhova Alla Vladimirovna ,

Applicant.

) I hereby certify that this correspondence and all marked  
) attachments are being electronically filed with the U.S.  
) Patent and Trademark Office via their website located at  
) <http://estta.uspto.gov/> on

August 28, 2012

(Date)



Stacey R. Halpern

**NOTICE OF OPPOSITION**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Dear Sir:

Opposer, Tod's S.p.A., an Italian joint-stock company, located and doing business at Via Filippo Della Valle 1, Sant'Elpidio A Mare, Ascoli Piceno, Italy 63019, believes that it will be damaged by registration of the mark shown in Application Serial No. 79/100,946 ("Applicant's Application"), filed February 24, 2011 by Duhova Alla Vladimirovna, an individual, located at kv. 72, dom No 8, korpus 1 Zvenigorodskaya ul.; RU-121433 Moskva, Russian Federation (hereinafter referred to as "Applicant") and hereby opposes the same for Classes 3 and 25.

A description of Applicant's Application is as follows:

Mark:	TODES
Serial No.:	79/100,946
Filed:	February 24, 2011
Published:	May 1, 2012
Classes:	3 and 25
Goods:	Perfumery; perfumes; toilet water; eau de Cologne; cosmetics; cosmetic preparations for skin care; cosmetic preparations for eyelashes; hair colorants; cosmetic preparations for slimming purposes; hair lotions; after-shave lotions; non-medicated sunscreen preparations; non-medicated toiletries; soaps for personal use;

shampoos; deodorants for personal use; hair spray; tissues impregnated with cosmetic lotions in Class 3 and clothing, namely, dance costumes, men's and women's shirts, shorts, pants, skirts, blouses, dresses, vests, T-shirts, jackets, sweaters; footwear; headgear, namely, hats, caps, fur hats, scarves in Class 25


As grounds for opposition, it is alleged:

1. For many years prior to the filing date of Applicant's Application, Tod's S.p.A., along with its affiliates and related companies (collectively, "Tod's") have designed, produced, offered for sale and sold various goods, including, but not limited to, personal care products, apparel items, footwear, bags, luggage, wallets and purses, leather goods and other related goods and services ("Tod's Goods and Services") in connection with various names and marks, including, including its famous and distinctive marks containing or consisting of the term TOD'S (collectively the "TOD's Marks").

2. Tod's is the owner of and relies on United States Trademark Registration No. 1,459,226 (the "226 Registration") for the mark TOD'S and Design for purses, handbags, briefcases, leather and/or heavy cloth handbags and suitcases in Class 18; and shoes, boots, and belts in Class 25. The '226 Registration is based on an application filed in the United States Patent and Trademark Office ("PTO") on May 29, 1986. The '226 Registration issued on July 7, 1987. Thus, the dates of filing and registration of the mark shown in the '226 Registration, are prior to the date Applicant filed Applicant's Application. By virtue of compliance with the provisions of 15 U.S.C. § 1065, the right to use the mark shown in the '226 Registration is incontestable. True and correct copies of the specifics of the '226 Registration obtained from the PTO's TARR, TESS and Assignment databases are attached hereto and made of record.

3. Tod's is the owner of and relies on United States Trademark Registration No. 2,749,125 (the "'125 Registration") for the mark TOD'S and Design for, among other goods,

covers for agendas, address books, and document holders in Class 16; and leather and imitation of leather and goods made of these materials, namely pocketbooks, handbags, duffel and tote bags, keycases, wallets in class 18; clothing, footwear and headgear for men and women, namely, shoes, outdoor shoes, flat shoes, overshoes and galoshes, rubber shoes, boots, jack boots, slippers, suits, dresses, jackets, leather jackets, outdoor jackets, trousers, skirts, overcoats, and coats, raincoats parkas, pullovers, shirts, tee-shirts, sport-coats, sweaters, underwear, pajamas, swimming suits, belts, scarves, gloves, hats, berets, sun visors in Class 25 and retail stores, featuring clothing, footwear, and headgear for men and women in Class 35. The '125 Registration is based on an application filed in the PTO on August 20, 1999 and has a priority filing date of January 4, 1999. The '125 Registration issued on August 12, 2003. Thus, the dates of filing and registration of the mark shown in the '125 Registration are both prior to the date Applicant filed Applicant's Application. By virtue of compliance with the provisions of 15 U.S.C. § 1065, the right to use the mark shown in the '125 Registration is incontestable. True and correct copies of the specifics of the '125 Registration obtained from the PTO's TARR, TESS and Assignment databases are attached hereto and made of record.

4. Tod's is the owner of and relies on United States Trademark Registration No. 3,602,493 (the "'493 Registration") for the mark  for clothing, namely, dress coats, men's suits, trousers, overcoats, jackets, blazers, jeans; shirts, namely, t-shirts, white shirts, aloha shirts, sweat shirts, undershirts, polo shirts, body shirts, pullovers, sport shirts; shorts; and hats; and footwear in Class 25. The '493 Registration is based on an application filed in the PTO on June 24, 2004. The '493 Registration issued on April 7, 2009. Thus, the dates of filing and registration of the mark shown in the '493 Registration are both prior to the date Applicant filed Applicant's Application. True and correct copies of the specifics of the '493 Registration obtained

from the PTO's TARR, TESS and Assignment databases are attached hereto and made of record.

5. Tod's is the owner of and relies on United States Trademark Registration No. 3,831,949 (the "949 Registration") for the mark TOD's and Design for, among other goods and services, perfumery and cosmetics, namely, perfume, cologne, after shave cream, after shave gel, after shave lotion, makeup, personal deodorants and antiperspirants, and essential oils for personal use; soaps; shaving soaps; hair care preparations; dentifrices; laundry preparations, namely, bleach and laundry detergents in Class 3; spectacles and sunglasses, and lenses and frames therefor, and parts and fittings therefor, namely, cases, chains and cords; contact lenses, optical lenses and magnifying glasses, and parts and fittings therefor, namely, cases for spectacles and sunglasses, chains and cords in Class 9; precious metals and their alloys; goods in precious metals or coated therewith, namely, jewelry cases, jewelry boxes, cigarette and tobacco cases, cigarette and tobacco pipes, ashtrays, napkins rings, serving platters, coffee and tea sets, candy dishes, plates, vases, statuettes, watch chains, belt buckles, bracelets, non-electric candelabras, candlesticks, candle holders, cuff links, ornamental pins, shoe ornaments, trinket articles, namely, trinket rings and jewel pendants, all of precious metal; jewelry and personal ornaments of precious metal, namely, hat and shoe ornaments, imitation jewelry, precious stones, watches, clocks, pendulum clocks, chronographs for use as watches and chronometers, statuettes of precious metal and their alloys in Class 14; paper; cardboard; goods made from paper and cardboard, namely, newspapers, journals, magazines, books, brochures, and catalogs concerning perfumery and cosmetics, glasses and sunglasses jewelry, horological and chronometric instruments, bags, clothing, footwear, fashion, technology and entertainment; albums for stickers, photograph albums, stamp albums, wedding albums, calendars, maps, picture postcards; stationery; paper covers for agendas; address books and document holders in Class 16; textiles and textile goods, namely, handkerchiefs; curtains; unfitted fabric furniture covers for upholstered chairs; draperies; linens; bed-linens;




household-linens; table-linens; bath linens; towels in Class 24; retail store services featuring clothing, headwear, footwear, handbags, purses and wallets; retail store services in the field of general consumer merchandise; on-line retail store services and electronic catalog services featuring footwear, handbags and purses; mail order catalog services featuring footwear, handbags and purses; retail stores services featuring luggage, bags, personal care products, perfumery and cosmetics; retail stores services featuring eyewear, spectacles and sunglasses, and lenses and frames therefor; retail stores services featuring contact lenses, optical lenses and magnifying glasses, and parts and fittings therefor; retail stores services featuring paper, cardboard and goods made from paper and cardboard, namely, newspapers, journals, magazines, books, brochures, catalogs, albums, calendars, maps, picture postcards, all made from paper and cardboard, stationery, writing materials, covers for agendas, address books and document holders, textiles and textile goods, curtains, coverings for upholstered chairs, draperies, linens, bed linens, household linens, table linens, bath linens and towels; on-line retail store services and electronic catalog services, all featuring clothing, headwear, wallets, luggage, bags, personal care products, perfumery and cosmetics, cutlery, eyewear, spectacles and sunglasses, and lenses and frames therefor, contact lenses, optical lenses and magnifying glasses, and parts and fittings therefor; on-line retail store services and electronic catalog services featuring paper, cardboard and goods made from paper and cardboard, namely, newspapers, journals, magazines, books, brochures, catalogs, albums, calendars, maps, picture postcards, stationery, writing materials, covers for agendas, address books and document holders, all made from paper and cardboard; mail order catalogue services featuring clothing, headwear, wallets, luggage, bags, personal care products, perfumery and cosmetics, eyewear, spectacles and sunglasses, and lenses and frames therefor, contact lenses, optical lenses and magnifying glasses, and parts and fittings therefor. mail order catalogue services featuring paper, cardboard and goods made from paper and cardboard, namely,

newspapers, journals, magazines, books, brochures, catalogs, albums, calendars, maps, picture postcards, stationery, writing materials, covers for agendas, address books and document holders, all made of paper and cardboard, and textile goods, curtains, coverings for upholstered chairs, draperies, linens, bed linens, household linens, table linens, bath linens and towels; retail store services featuring clothing, headwear, footwear, handbags, purses and wallets in Class 35. The '949 Registration is based on an application filed in the PTO on June 24, 2004. The '949 Registration issued on April 7, 2009. Thus, the dates of filing and registration of the mark shown in the '949 Registration are both prior to the date Applicant filed Applicant's Application. True and correct copies of the specifics of the '949 Registration obtained from the PTO's TARR, TESS and Assignment databases are attached hereto and made of record.

6. Tod's is the owner of and relies on United States Trademark Registration No.



4,036,992 (the "'992 Registration") for the mark  for spectacles, sunglasses and frames thereof; eyeglass lenses; contact lenses; optical lenses; magnifying glasses; chains, cases and cords for eye glasses and spectacle cases; and parts for all the aforesaid goods; leather protective covers for portable multimedia players, mobile phones, dvds, for cds, computer cables, sound reproduction apparatus, palm pilots, electronic agendas, photographic cameras and film cameras in Class 9; watches and clocks; pendulum clocks; chronographs for use as watches and chronometers; rough gemstones; precious stones; diamonds; coral jewelry; emerald; sapphire; ruby; opal; topaz; aquamarine jewelry, earrings; rings being jewelry; necklaces; bracelets; ornamental pins made of precious metal; shoe ornaments of precious metal; pearls; boxes of precious metal; jewels cases of precious metal; brooches; pins being jewelry; tie clips; cuff links; leather bracelets in Class 14; all purpose carrying bags; handbags; traveling bags; briefcases; leather briefcases; leather credit card holders; wallets; leather document briefcases; leather key

cases; purses; trunks; suit cases; cosmetic bags sold empty; sports bags; general purpose bags for athletic equipment; evening handbags; shoulder bags for ladies; leather shopping bags; school bags; garment bags for travel; suit carriers for travel; shoe bags for travel; beach bags; rucksacks; diaper bags; backpacks; Boston bags; traveling trunks; duffel bags; overnight bags; carry-on bags; bags for mountain-climbing; satchels; opera bags being purses; unfitted vanity cases; hides; cases and boxes made of leather; bags made of leather for packaging; leather straps; umbrellas; leather leashes for animals; leather covers for document holders in Class 18; and leather coats; leather jackets; leather trousers; leather skirts; leather tops; leather raincoats; leather long coats; leather overcoats; leather belts; leather braces for clothing; belts; suits; padded jackets; jackets; stuff jackets; jumpers; trousers; jeans; skirts; dresses; coats; overcoats; cloaks; raincoats; parkas' pullovers; shirts; t-shirts; blouses; sweaters; underwear; baby-dolls being nightwear; bathrobes; bathing costumes; negligees; swim suits; dressing gowns; nightgowns; one-piece dresses; two-piece dresses; evening dresses; shawls; scarves; ties; neckties; gentlemen suits; women's clothing, namely, tops and bottoms; dress shirts; button-front aloha shirts; sweat shirts; under shirts; polo shirts; body suits; blazers; shorts; sport shirts; shoes; athletic shoes; slippers; overshoes; low heel shoes; leather shoes; rubber shoes; galoshes; golf shoes; wooden clogs; angler's shoes; basketball shoes; dress shoes; heels; hiking shoes; rugby shoes; boxing shoes; base ball shoes; vinyl shoes; beach shoes; inner soles; soles for footwear; footwear uppers; heelpieces for shoes and boots; non-slipping heel pieces for shoes and boots; tips for footwear; rain shoes; track-racing shoes; work shoes; straw shoes; gymnastic shoes; boots; ski boots; half boots; arctic boots; football boots; laced boots; field hockey shoes; hand ball shoes; esparto shoes or sandals; sandals; bath sandals; gloves; gloves for protection against cold; leather gloves; mittens; hats and caps; visors being headgear; leather hats and caps; headgear, namely, headwear in Class 25. The '992 Registration is based on an application filed in the PTO on August 2, 2010 and has a priority date of

June 25, 2010. Thus, the date of filing of the mark shown in the '992 Registration is prior to the date Applicant filed Applicant's Application. True and correct copies of the specifics of the '992 Registration obtained from the PTO's TARR, TESS and Assignment databases are attached hereto and made of record.

7. Tod's is the owner of and relies upon its United States Registrations as specified above (collectively, "Tod's Registrations"). Tod's Registrations are valid, subsisting, unrevoked and uncanceled. As such, Tod's Registrations confer rights of priority, nationwide in effect, as of the filing dates pursuant to § 7(c), as well as prima facie evidence of the validity of the registered marks and of the Registrations thereof, of Tod's ownership of the marks shown therein and of Tod's exclusive right to use the marks in commerce in connection with the goods named therein, without condition or limitation as provided in Sections 7(b), 22 and 33 (a) of the Trademark Act of 1946 as amended.

8. The mark in Applicant's Application is likely to cause confusion with the marks shown in Tod's Registrations. Additionally, Applicant seeks registration for goods closely related to Tod's Goods and Services, as well as the goods and services identified in Tod's Registrations. As such, when the mark TODES is used on or in connection with the goods in Applicant's Application, it is likely to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Further, the mark in Applicant's Application and use thereof is likely to cause confusion in, or to cause mistake by, or to deceive the trade and purchasing public into believing that Applicant's goods originate with Tod's or are otherwise authorized, licensed or sponsored by Tod's.

9. If Applicant is permitted to register the mark shown in Applicant's Application, Applicant's corresponding prima facie exclusive right to use the TODES mark in nationwide commerce will conflict with Tod's lawful and prima facie exclusive right to use the marks shown in Tod's Registrations nationwide.

10. Tod's has invested substantial amounts of time, effort and money in the TOD'S Marks throughout the United States and the world. By reason of Tod's widespread and continuous use of the Tod's Marks, in addition to the protection afforded by virtue of Tod's Registrations, Opposer has extensive, non-registered statutory and common law rights in the TOD'S Marks. In view of Opposer's prior statutory and common law rights in the TOD'S Marks, Applicant is not entitled to registration of the TODES mark pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

11. Through extensive use, advertising, promotion and sales, the TOD'S Marks have acquired valuable goodwill and consumer recognition. Such use has been valid and continuous, and has not been abandoned. The TOD'S Marks, by virtue of Opposer's substantial use, have acquired great value as an identification of Tod's and Tod's Goods and Services and distinguish them from the goods and services of others. In fact, the Tod's name and TOD'S Marks are closely and uniquely associated with Tod's.

12. By virtue of Tod's substantial use and promotion of the TOD'S Marks, the marks have become famous in the minds of consumers since prior to the filing date of Applicant's Application. Prior to Applicant's filing date of Applicant's Application, the purchasing public has come to associate TOD'S Marks with Tod's as indicating that the goods are associated with Tod's.

13. In view of the substantial similarity of the TOD'S Marks and the mark shown in Applicant's Application, as well as the related nature of the goods and services of the respective parties, it is alleged that the mark TODES so resembles the TOD'S Marks as to be likely to cause confusion, or to cause mistake or deceive, or to dilute the TOD'S Marks.

14. In view of the substantial similarity of the marks shown in Applicant's Application and the marks shown in Tod's Registrations, as well as the related nature of the goods and services of the respective parties, it is alleged that the mark TODES so resembles the TOD'S Marks as to be likely to

cause confusion, or to cause mistake or deceive, or to dilute the marks shown in Tod's Registrations.

15. Through extensive use and advertising of the TOD'S Marks, the marks have become famous for Tod's Goods since a date well prior to the filing date of Applicant's Application.

16. Through extensive use and advertising of the marks in Tod's Registrations, the marks have become famous for Tod's Goods since a date prior to the filing date of Applicant's Application.

17. The TOD's Marks are distinctive and famous and have enjoyed such distinctiveness and fame since long prior to the filing date of Applicant's Application.

18. The marks in Tod's Registrations are distinctive and famous and have enjoyed such distinctiveness and fame since long prior to the filing date of Applicant's Application.

19. Through extensive use and advertising of the TOD'S Marks, the marks have become famous for Tod's Services since a date well prior to the filing date of Applicant's Application.

20. Through extensive use and advertising of the marks in Tod's Registrations, the marks have become famous for Tod's Services since a date prior to the filing date of Applicant's Application.

21. Applicant's use and registration of the mark in Applicant's Application is likely to cause dilution of the distinctive quality of the TOD'S Marks within the meaning of Section 43(c) of the Trademark Act, 15 U.S.C. 1125(c) to the damage and injury of Tod's.

22. Applicant's use and registration of the mark shown in Applicant's Application will dilute the distinctive quality of the TOD'S Marks within the meaning of Section 43(c) of the Trademark Act, 15 U.S.C. 1125(c), and will lessen the ability of the TOD's Marks to distinguish the products of Tod's, regardless of the category of products in connection with which Applicant uses the TODES mark.

23. Applicant's use and registration of the mark shown in Applicant's Application is likely to dilute the distinctive quality of the TOD'S Marks within the meaning of Section 43(c) of the Trademark Act, 15 U.S.C. 1125(c), and will lessen the ability of the TOD'S Marks to distinguish the products of Tod's, regardless of the category of products in connection with which Applicant uses the TODES mark.

24. Applicant has no license, consent or permission from Tod's to use or register the TODES mark.

25. The TODES mark is virtually identical to the TOD's portion of the TOD'S Marks.

26. The TODES mark is phonetically equivalent to the TOD'S portion of the TOD'S Marks.

27. The TODES mark is virtually identical to the literal portion of the mark shown in Tod's Registrations.

28. Tod's used the TOD'S Marks prior to Applicant's first use of the TODES mark.

29. On information and belief, Applicant has not yet used the TODES mark in U.S. commerce.

30. On information and belief, Applicant did not use the TODES mark in U.S. commerce prior to the filing date of Applicant's Application.

31. The goods identified in Applicant's Application are closely related to Tod's Goods and services.

32. The goods identified in Applicant's Application are closely related to the goods and services identified in Tod's Registrations.

33. Tod's used the marks shown in Tod's Registrations prior to Applicant's first use of the TODES mark.

34. Tod's used the term TOD'S prior to Applicant's first use of the TODES mark.

35. There are no limitations as to the channels of trade in Applicant's Application.

36. There are no limitations as to the channels of trade for the goods identified in Tod's Registrations.

37. In review of the foregoing, Tod's would be injured by registration of the mark shown in Applicant's Application for the goods in Classes 3 and 25 because such a mark so resembles the TOD's Marks as to be likely to cause confusion, mistake or deceive.

38. In review of the foregoing, Tod's would be injured by registration of the mark shown in Applicant's Application for the goods in Classes 3 and 25 because such a mark so resembles the marks shown in Tod's Registrations as to be likely to cause confusion, mistake or deceive.

39. In review of the foregoing, Tod's would be injured by registration of the mark shown in Applicant's Application for the goods in Classes 3 and 25 because such a mark so resembles the TOD's Marks as to falsely suggest a connection with Tod's.

40. In review of the foregoing, Tod's would be injured by registration of the mark shown in Applicant's Application for the goods in Classes 3 and 25 because such a mark so resembles the TOD's Marks as to falsely suggest a connection with the TOD's Marks.

41. In review of the foregoing, Tod's would be injured by registration of the mark shown in Applicant's Application for the goods in Classes 3 and 25 because such a mark damages the valuable goodwill and reputation Tod's has acquired in its TOD's Marks.

42. In review of the foregoing, Tod's would be injured by registration of the mark shown in Applicant's Application for goods in Classes 3 and 25 because the mark dilutes or is likely to dilute the distinctive nature of the TOD's Marks.

43. In review of the foregoing, Tod's would be injured by registration of the mark shown in Applicant's Application for goods in Classes 3 and 25 because the mark dilutes or is likely to dilute the distinctive nature of the marks shown in the Tod's Registration.



44. In view of foregoing, Applicant is not entitled to registration of the mark in Applicant's Application pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).


45. By reason of all the foregoing, Tod's will be gravely damaged by the registration of the mark shown in Applicant's Application, because registration of this mark would be in violation of Tod's rights.

WHEREFORE, Tod's prays that Applicant's Application be rejected and stricken, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Tod's.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 28, 2012

By:   
\_\_\_\_\_  
Stacey R. Halpern  
2040 Main Street, 14th Floor  
Irvine, CA 92614  
(949) 760-0404  
shalpern@kmob.com  
Attorney for Opposer, Tod's, S.p.A.

**CERTIFICATE OF SERVICE**

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant's counsel by depositing one copy thereof in the United States mail, first-class postage prepaid on August 28, 2012, addressed as follows:

Nicholas D. Wells  
Wells IP Law  
299 S. Main St., Suite 1300  
Salt Lake City UT 84111

A handwritten signature in black ink, appearing to read "Stacey R. Halpern", written over a horizontal line.

Stacey R. Halpern

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082812

# **EXHIBIT 8**

In re Application Serial No. 86/004,044  
Filed: July 8, 2013  
For Mark: TOMS  
Published in the Official Gazette: April 29, 2014

TOD'S S.P.A., :  
 :  
 Opposer, : Opposition No. 91218001  
 :  
 v. :  
 :  
 MYCOSKIE, LLC, :  
 :  
 Applicant. :

29103/010/1558940.1

## DEFINITIONS AND INSTRUCTIONS

A. The term “Applicant” means Applicant Mycoskie, LLC and all parent, subsidiary, related, predecessor and/or successor entities, licensees, divisions, employees, agents and/or representatives thereof.

B. The term “Opposer” means Opposer Tod’s S.p.A. and all parent, subsidiary, related, predecessor and/or successor entities, divisions, employees, agents and/or representatives thereof.

C. The term “Opposer’s TOD’S Marks” shall refer to the marks used, registered and/or applied to be registered by Opposer consisting of or incorporating the word TOD’S, alone or with other words and/or with stylized or design elements, including those shown in paragraph 4 of the Notice of Opposition in this proceeding.

D. The term “Application” shall refer to Application Serial No. 86/004,044 applied for by Applicant.

E. The term “Applicant’s Mark” shall refer to the standard character TOMS word mark that is the subject of the Application.

F. The term “Applicant’s TOMS Design Mark” shall refer to the mark depicted below in which the terms TOMS appears in the middle of three equally sized stripes, regardless of the particular color of any of the stripes:

TOMS

G. The term “commerce” means commerce subject to regulation by Congress, as defined in 15 U.S.C. §1127.

H. As used herein, the terms “entity” and “person” include natural persons, governmental entities, organizations, corporations, partnerships, associations, joint ventures and any other individual or group of individuals that has the purpose of conducting or, in fact, conducts business.

I. The term “document” shall be given the broadest possible scope under Fed. R. Civ. P. 34 and includes, but is not limited to, all writings, correspondence, memoranda, handwritten notes, drafts, invoices, contracts, purchase orders, letters, checks, receipts, books, pamphlets, flyers, advertisements, web pages, publications, stickers, posters, catalogs, labels, product packaging, product containers, displays, photographs, slides, videotapes, films, artwork, drawings, sketches, illustrative materials, layouts, tear sheets, magnetic recording tapes, microfilms, computer printouts, e-mail, work sheets, and files from any personal computer, notebook or laptop computer, file server, minicomputer, mainframe computer or any other storage means by which information is retained in retrievable form, including files that are still on any storage media, but that are identified as “erased but recoverable,” and all other materials, whether printed, typewritten, handwritten, recorded or reproduced by a mechanical or electronic process.

J. The term “identify” when used in connection with a natural person or persons requires Applicant to state the person’s full name and last known business and residential addresses, telephone number and e-mail address.

K. The term “identify” when used in connection with a document requires Applicant to:

- (i) Furnish the name or title, date and general description (e.g., letter, memorandum, etc.) of the document, the name and address of the person from whom the

document originated, the name and address of the persons to whom the document was addressed or delivered, and the names and addresses of all persons to whom copies of the document were sent; and

(ii) State whether Applicant is in possession of the original of the document or a copy thereof and, if Applicant is not in possession of the original or a copy, furnish the name and address of the custodian of the original or a copy; and

(iii) Furnish a general description of the subject matter to which the document(s) pertains.

L. The term “identify” when used in connection with a company, organization or other business entity requires Applicant to state the name, address, and phone number of the company, organization or other business entity.

M. The term “concerning” means referring to, relating to, embodying, connected with, commenting on, responding to, showing, describing, analyzing or constituting.

N. The singular and plural forms are used herein interchangeably, as are the masculine and feminine forms and the present and past tenses, and such terms should be construed as necessary to bring within the scope of the interrogatory/document request all documents and information which might otherwise be construed to be outside its scope.

O. The terms “and” and “or” shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the interrogatory/document request all documents and information which might otherwise be construed to be outside its scope.

P. If any information or document called for in any interrogatory or request is withheld in whole or in part by reason of a claim of attorney-client privilege or any other claim of immunity from discovery, then, at the time the information or document is to be produced, a

list is to be furnished identifying any such information or document withheld together with the following information: date and title of the document; name and job title of each author, writer or sender of the document; name and job title of each recipient, addressee or other person to whom the original or any copy of the document was sent or furnished; if Applicant contends that an author or recipient of the document is an attorney for purposes of claiming privilege or immunity from discovery, identify the State Bar of which he or she was a member at the time of the communication in question; the general subject matter of the information or document withheld; the basis for the claim of privilege or immunity from discovery; and the interrogatory or request to which the information or document is responsive.

Q. In the event that any document called for by this request has been destroyed, lost, discarded or otherwise disposed of, identify any such document as completely as possible, including, without limitation, the date of disposal, manner of disposal, reason for disposal, person authorizing the disposal and person disposing of the document.

R. Documents shall be produced as they are kept in the ordinary course of business or shall be organized and labeled to correspond to the document request to which they are responsive.

### **INTERROGATORIES**

#### **Interrogatory No. 1**

State the date when Applicant first selected Applicant's Mark for use as a trademark and identify all persons who participated in such selection.



Interrogatory No. 2

Describe in detail the reason(s) for the original selection of the designation “TOMS” as a mark by Applicant, including, without limitation, the intended meaning or connotation of the term “TOMS.”

Interrogatory No. 3

Identify any trademark searches or other searches, opinions, investigations, analyses or studies related to the selection, design, and/or adoption of Applicant’s Mark for use or intended use in the United States or in commerce, including, without limitation, the persons involved, the date(s), and the data or results of those searches, opinions, investigations, analyses or studies.

Interrogatory No. 4

State whether Applicant (or any person or entity authorized by Applicant) has made any use of Applicant’s Mark in the United States or in commerce as of the present date with respect to any of the goods listed in the Application, and if so, identify all such goods.

Interrogatory No. 5

For each of the goods identified in response to Interrogatory No. 4 above, identify:

- (a) The date of first use of Applicant’s Mark on or in connection with such goods;
- (b) The period of time during which such goods were or are being distributed, offered for sale, sold or rendered;
- (c) The geographic area(s) in which such goods were or are being distributed, offered for sale, sold or rendered;
- (d) The annual volume of sales for each year to the present, both by dollar amount and unit amount, for each of the goods sold;
- (e) The retail and wholesale price for each of the goods sold; and

(f) The channels of trade (e.g., types of retail stores, catalogs, mail order, on-line, promotional sales, private sales, etc.) through which each of the goods was or is being distributed or sold to the ultimate purchaser, consumer or user.

Interrogatory No. 6

(a) Describe each instance where any person has by word or deed or otherwise, including, without limitation, by misdirected mail, e-mail, telephone calls, orders or inquiries, suggested or reflected any confusion between Opposer and Applicant or their respective trademarks or goods or services; and

(b) Identify all persons knowledgeable about any such instances referred to in subparagraph (a) above and describe the nature of their knowledge.

Interrogatory No. 7

State whether Applicant was aware of Opposer's TOD'S Marks prior to:

(a) July 8, 2013, when Applicant filed the Application;

(b) any use by Applicant of Applicant's Mark in the United States or in commerce in connection with the goods identified in the Application; or

(c) any use by Applicant of Applicant's Mark in the United States or in commerce in connection with any goods or services.

Interrogatory No. 8

Identify all "identical and/or related products and services" that Applicant contends have co-existed under Opposer's TOD'S Marks and Applicant's Mark, as alleged in paragraph 5 of Applicant's "Facts Common To All Affirmative Defenses" in its Answer in this opposition, and with respect to all such products or services:

(a) Identify the period of time during which Applicant alleges such co-existence took place;

(b) Identify all retail locations in which Applicant contends such co-existence took place; and

(c) State whether use of the TOMS mark in connection with any such identified products or services was made in the form of Applicant's TOMS Design Mark.

Interrogatory No. 9

Identify all retail stores in the United States in which products bearing Applicant's Mark are sold.

Interrogatory No. 10

Identify each product or service on or in connection with which Applicant uses or has used Applicant's Mark in the United States or in commerce, and for each such product or service:

(a) Identify the date of first use of Applicant's Mark in connection with such product or service; and

(b) Identify the annual volume of sales (in dollars and units) made under Applicant's Mark by Applicant in the United States or commerce for each year from the date of first use to the present.

Interrogatory No. 11

Identify each different stylization and/or design format in which Applicant has used marks comprising or containing the word TOMS in the United States or in commerce, and with respect to each such stylization and/or design format, identify the period of time during which

such use has been made and the goods or services on or in connection with which such use has been made.

Interrogatory No. 12

Describe each context in which Applicant uses marks containing or comprising the word TOMS in the United States or in commerce in a form other than shown in Applicant's TOMS Design Mark.

Interrogatory No. 13

State whether Applicant has any documentation, including, without limitation, business plans, marketing plans, memos, correspondence or draft proposals of any kind, reflecting Applicant's bona fide intention prior to or as of July 8, 2013 to use Applicant's Mark in the United States or in commerce in connection with each of the goods identified in the Application, and if so, identify all such documentation.

Interrogatory No. 14

Describe in detail all steps taken by Applicant prior to July 8, 2013 in connection with the intended use of Applicant's Mark in the United States or in commerce in connection with each of the goods identified in the Application.

Interrogatory No. 15

Describe in detail all steps taken by Applicant on or after July 8, 2013 in connection with the intended use of Applicant's Mark in the United States or in commerce in connection with each of the goods identified in the Application.

Interrogatory No. 16

Describe with specificity the factual basis upon which Applicant alleges that the current opposition is barred by:

- (a) estoppel;
- (b) waiver;
- (c) laches;
- (d) acquiescence; and
- (e) unclean hands.

### **DOCUMENT REQUESTS**

#### **Request No. 1**

Specimens of each of the different goods sold by Applicant in the United States or in commerce in connection with Applicant's Mark, including, without limitation, each different color combination and each different design or stylization in which such mark is used by Applicant.

#### **Request No. 2**

Specimens of each label, hangtag, tag, product package, package insert, sticker, hologram, package material or other device which bears Applicant's Mark, and which has been used by Applicant in the United States or in commerce.

#### **Request No. 3**

Specimens of each point-of-sale material, circular, flyer, poster, sticker, sales sheet, leaflet, brochure, catalog, sign, price list, on-line or email advertisement, print advertisement, radio or television advertisement, service order list or other advertising material or promotional item which bears Applicant's Mark, and which has been used by Applicant in the United States or in commerce.

Request No. 4

All documents concerning Applicant's conception, creation, design, clearance and/or selection of Applicant's Mark, including, without limitation, all documents concerning the reasons for Applicant's original selection of the term "TOMS" as a trademark and the intended connotation of such designation.

Request No. 5

All documents concerning any trademark searches or other searches, opinions, investigations, analyses or studies conducted or reviewed by or on behalf of Applicant concerning Applicant's Mark.

Request No. 6

All documents concerning Applicant's adoption and first use of Applicant's Mark in the United States or in commerce.

Request No. 7

Documents sufficient to identify all retail stores in the United States in which products bearing Applicant's Mark are sold and the period of time during which such products have been sold in such stores.

Request No. 8

Documents sufficient to identify each product or service on or in connection with which Applicant uses or has used Applicant's Mark in the United States or in commerce and the date of first use of Applicant's Mark in connection with each such product or service.

Request No. 9

Documents sufficient to identify the annual volume of sales (in dollars and units) made under Applicant's Mark by Applicant in the United States or commerce for each year from the

date of first use to the present with respect to each different product or service sold under Applicant's Mark.

Request No. 10

Documents sufficient to identify (a) each different stylization and/or design format in which Applicant is using or has used marks comprising or containing the word TOMS in the United States or in commerce; (b) the period of time during which each such use has been made; and (c) the goods or services on or in connection with which such use has been made.

Request No. 11

All documents concerning the advertising, marketing or promotion of goods sold under Applicant's Mark in the United States or in commerce, including, without limitation, any media plans, public relations materials, press kits and correspondence with advertising agencies, public relations firms, media planners, graphic designers, web site designers or any other such entities in the advertising and promotional field.

Request No. 12

Documents sufficient to identify the amount of money expended by Applicant in advertising and promoting goods sold under Applicant's Mark in the United States or in commerce for each year from the date of first use to the present.

Request No. 13

All documents concerning each trade show, convention, exposition or conference at which goods sold under Applicant's Mark have been displayed, advertised, promoted, offered for sale or sold in the United States or in commerce.

Request No. 14

All documents concerning any actual or proposed authorization, license, assignment, grant, conveyance or other transfer of the right from or on behalf of Applicant to any third party to use Applicant's Mark in the United States or in commerce.

Request No. 15

Documents sufficient to identify each website, web auction, web hosting, web listing, web posting, web page or social media page (whether owned by Applicant or third parties), including its Internet address, on or through which goods sold under Applicant's Mark have been or are currently being promoted, advertised, displayed, offered for sale, sold or otherwise distributed.

Request No. 16

Apart from the current opposition, all documents concerning any objections, claims, demands or actions lodged or filed against the use or registration or proposed use or registration of Applicant's Mark, including, without limitation, cease and desist letters, complaints and/or Notices of Opposition.

Request No. 17

All documents concerning any objections, claims, demands or actions lodged or filed by Applicant against third parties concerning the use or registration or proposed use or registration of any marks alleged to violate Applicant's rights in Applicant's Mark, including, without limitation, cease and desist letters, complaints and/or Notices of Opposition.



Request No. 18

All documents concerning Opposer or Opposer's TOD'S Marks, and/or any goods or services marketed, manufactured, distributed, offered for sale, sold, licensed or rendered by Opposer in connection with Opposer's TODS Marks.

Request No. 19

All documents concerning Applicant's knowledge of Opposer, Opposer's TOD'S Marks, and/or any goods or services marketed, manufactured, distributed, offered for sale, sold, licensed or rendered by Opposer in connection with Opposer's TOD'S Marks prior to:

(a) July 8, 2013, when Applicant filed the Application.

(b) any use by Applicant of Applicant's Mark in the United States or in commerce in connection with the goods identified in the Application; or

(c) any use by Applicant of Applicant's Mark in the United States or in commerce in connection with any goods or services.

Request No. 20

All documents concerning any consumer studies, market research, focus groups, surveys, polls or other research, studies or data compiled or commissioned by or on behalf of Applicant concerning Applicant's Mark.

Request No. 21

All documents reflecting or indicating any confusion on the part of any member of the public between Opposer and Applicant or their respective trademarks or goods or services.

Request No. 22

All documents identified in Applicant's Initial Disclosures in this opposition.

Request No. 23

All documents concerning the actual or intended channels of trade for goods or services sold or rendered or intended to be sold or rendered in connection with Applicant's Mark in the United States or in commerce.

Request No. 24

All documents concerning the actual or intended target audience for goods or services sold or intended to be sold in connection with Applicant's Mark in the United States or in commerce, including, without limitation, documents concerning the age, gender and other demographics of such customers or potential customers.

Request No. 25

All documents, including, without limitation, business plans, marketing plans, memos, correspondence or draft proposals of any kind, reflecting Applicant's bona fide intention prior to or as of July 8, 2013 to use Applicant's Mark in the United States or in commerce in connection with each of the goods identified in the Application.

Request No. 26

All documents concerning any steps taken by Applicant prior to July 8, 2013 in connection with the intended use of Applicant's Mark in the United States or in commerce in connection with each of the goods identified in the Application.

Request No. 27

All documents concerning any steps taken by Applicant on or after July 8, 2013 in connection with the intended use of Applicant's Mark in the United States or in commerce in connection with each of the goods identified in the Application.

Request No. 28

All documents concerning each distributor, supplier, manufacturer, vendor, licensee or any other third party with whom Applicant had any discussions concerning the intended use of Applicant's Mark in the United States or in commerce in connection with the goods identified in the Application.

Request No. 29

All documents concerning any instructions on the manner in which Applicant's Mark or any other marks comprising or containing the word TOMS, including, without limitation, Applicant's TOMS Design Mark, is to be used, including, but not limited to, any style guides concerning the usage of such marks.

Request No. 30

All documents concerning the co-existence of "identical and/or related products and services" under Opposer's TOD'S Marks and Applicant's Mark, as alleged in paragraph 5 of Applicant's "Facts Common To All Affirmative Defenses" in its Answer in this opposition, including, without limitation, documents concerning the period of time during which such alleged co-existence took place, the retail locations in which such alleged co-existence took place and the format and/or stylization in which Applicant's Mark was used.

Request No. 31

All documents reflecting Applicant's use in the United States or in commerce of marks comprising or containing the word TOMS in a form other than shown in Applicant's TOMS Design Mark.

Request No. 32

All documents concerning the extent to which and/or contexts in which Applicant uses marks comprising or containing the word TOMS in a form other than shown in Applicant's TOMS Design Mark in the United States or in commerce.

Request No. 33

All documents concerning any decisions to register Applicant's Mark in standard character form as opposed to the form of Applicant's TOMS Design Mark.

Request No. 34

All documents concerning any decision to discontinue, phase out, limit or reduce use or registration of Applicant's TOMS Design Mark.

Request No. 35

All documents concerning any expansion plans with respect to Applicant's Mark.

Request No. 36

All documents concerning communications between Opposer and Applicant concerning the current opposition or any dispute concerning the use or registration of Opposer's TOD Marks and Applicant's Mark.

Request No. 37

All documents identified or otherwise referred to by Applicant in answering Opposer's

First Set of Interrogatories above.

Dated: New York, New York  
December 11, 2014

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.  
Attorneys for Opposer

By: 

Richard S. Mandel  
1133 Avenue of the Americas  
New York, New York 10036-6799  
(212) 790-9200

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the attached Opposer's First Set of Interrogatories and Request for Production of Documents and Things was served upon Applicant by mailing a copy thereof by first class mail, postage prepaid, on Applicant's counsel of record on December 11, 2014 addressed as follows:

Louis S. Ederer, Esq.  
Arnold & Porter LLP  
555 12<sup>th</sup> St NW, Suite 100  
Washington, D.C. 20004-1206

Louis S. Ederer, Esq.  
Arnold & Porter LLP  
399 Park Avenue  
New York, New York 10022

/Richard S. Mandel/  
RICHARD S. MANDEL, ESQ.

# **EXHIBIT 9**

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# ARNOLD & PORTER LLP

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Louis S. Ederer  
Louis.Ederer@aporter.com  
212.715.1000  
212.715.1399 Fax  
399 Park Avenue  
New York, NY 10022-4690

February 17, 2015

**VIA U.S. MAIL**

Richard S. Mandel, Esq.  
Cowan, Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, New York 10036

Re: Tod's S.p.A. v. Mycoskie, LLC, Opp. No. 91218001


Dear Richard:

Enclosed please find Applicant's Responses and Objections to Opposer Tod's S.p.A.'s First Set of Interrogatories and Applicant's Responses and Objections to Opposer Tod's S.p.A.'s First Request For Production of Documents and Things, as well as disks containing responsive documents bearing Bates numbers MYCOSKIE000001 – MYCOSKIE010317, and a book entitled *Start Something That Matters* (MYCOSKIE010318).

Our review of potentially responsive materials continues, and we anticipate making a supplemental production shortly.

Very truly yours,

ARNOLD & PORTER LLP

By   
Louis S. Ederer

Enclosures



# **EXHIBIT 10**

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# ARNOLD & PORTER LLP

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Louis S. Ederer  
Louis.Ederer@aporter.com

212.715.1000  
212.715.1399 Fax

399 Park Avenue  
New York, NY 10022-4690

February 19, 2015

**VIA FEDERAL EXPRESS**

Richard S. Mandel, Esq.  
Cowan, Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, New York 10036


Re: Tod's S.p.A. v. Mycoskie, LLC, Opp. No. 91218001

Dear Richard:

Enclosed please find a disk containing Applicant's first supplemental production of documents responsive to Opposer Tod's S.p.A.'s First Request For Production of Documents and Things (MYCOSKIE010319 – MYCOSKIE011064).

Very truly yours,

ARNOLD & PORTER LLP

By   
Louis S. Ederer

Enclosure

# **EXHIBIT 11**

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ARNOLD & PORTER LLP

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Louis S. Ederer  
Louis.Ederer@aporter.com  
212.715.1000  
212.715.1399 Fax  
399 Park Avenue  
New York, NY 10022-4690

February 25, 2015

**VIA HAND DELIVERY**

Richard S. Mandel, Esq.  
Cowan, Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, New York 10036

Re: Tod's S.p.A. v. Mycoskie, LLC, Opp. No. 91218001


Dear Richard:

Enclosed please find replacement disks containing Applicant's initial document production (MYCOSKIE000001 – MYCOSKIE010317), as well as a disk containing Applicant's second supplemental production of documents (MYCOSKIE011065 – MYCOSKIE011271).

Please let us know if you have any issues accessing the data contained on any of these disks.

Very truly yours,

ARNOLD & PORTER LLP

By   
Louis S. Ederer

Enclosures

# **EXHIBIT 12**



Cowan, Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, NY 10036

(212) 790-9200 Tel  
(212) 575-0671 Fax  
www.cll.com

**Richard S. Mandel**  
(212) 790-9291  
rsm@cll.com

March 13, 2015

**VIA EMAIL**

Louis S. Ederer, Esq.  
Arnold & Porter LLP  
399 Park Avenue  
New York, New York 10022

Re: Tod's S.p.A. v. Mycoskie, LLC

Dear Lou:

Following up on our recent conversation regarding next steps in discovery, I wanted to raise some issues concerning Applicant's responses to Opposer's first set of discovery requests. Applicant's interrogatory responses in almost all instances indicate that Applicant will produce documents pursuant to Fed. R. Civ. P. 33(d) from which the answers can be derived. However, based on our initial review of the documents, it is not clear in many instances whether the documents actually do provide the requested information. Accordingly, as set forth below, we would request that Applicant supplement its responses in those instances where the information has not been provided or point us to specific responsive documents that you believe do provide the requested information.

With respect to interrogatory 3, we do not believe that any documents have been produced that would answer this interrogatory. Moreover, the response itself only states that responsive documents, "if any," will be produced from which the answer to this interrogatory can be derived. However, if there are in fact no such documents, then the use of Fed. R. Civ. P. 33(d) to answer the interrogatory is improper. Accordingly, we would request a clear response that indicates whether or not there were in fact any trademark searches, etc. conducted, and if so, please identify and produce such documents.

With respect to interrogatories 4 and 5, there do not appear to be any documents reflecting any use to date of any of the products covered by the opposed application (as opposed to plans for intended use this year). Please confirm that there are no such documents, or if there are, please identify by Bates number documents reflecting such use and the date of first use.

With respect to interrogatory 8, please advise whether there are any documents other than MYCOSKIE 001331-001349 that are being referenced as providing the requested information

**Cowan, Liebowitz & Latman, P.C.**

Louis S. Ederer, Esq.

March 13, 2015

Page 2

regarding the products/services, retail locations and time periods in which the parties' marks have co-existed.

With respect to interrogatory 13, it does not appear that any documents dated on or before July 8, 2013, the date of the opposed application, have been produced. If there are any such documents which Applicant is pointing to as providing the answer to interrogatory no. 13, please identify them by Bates number.

Finally, with respect to interrogatory no. 16, we do not understand your contention that such discovery is "premature." Applicant would have been required to have a good faith basis for asserting the various defenses alleged in the answer, and accordingly should be able to articulate the factual basis on which it believes such defenses are applicable in this case. Accordingly, we request that you reconsider your objection and provide a supplemental response to this interrogatory.

Feel free to call me if you wish to discuss these issues in further detail. I look forward to your response.

Sincerely,

A handwritten signature in cursive script, appearing to read "Richard S. Mandel".

Richard S. Mandel

# **EXHIBIT 13**



Louis S. Ederer  
Louis.Ederer@aporter.com  
+1 212.715.1102  
+1 212.715.1399 Fax  
399 Park Avenue  
New York, NY 10022-4690

March 20, 2015

**BY EMAIL & U.S. MAIL**

Richard S. Mandel, Esq.  
Cowan Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, NY 10036

Re: Tod's S.p.A. v. Mycoskie, LLC, USPTO TTAB Opposition No. 91218001

Dear Richard:

On behalf of Mycoskie, LLC ("Applicant"), we write in response to your March 13, 2015 letter concerning certain of Applicant's responses to Tod's S.p.A. ("Opposer")'s First Set of Interrogatories (the "Interrogatories"), as follows:

***Interrogatory No. 3***

Although Applicant's investigation is ongoing, and subject to and without waiving Applicant's previously lodged objections to Interrogatory No. 3, Applicant has not identified any responsive searches, opinions, investigations analyses or studies. Applicant will promptly supplement its response to Interrogatory No. 3, if and when responsive information is located.

***Interrogatory Nos. 4 and 5***

Applicant directs your attention to MYCOSKIE001360-1362, MYCOSKIE003555-3556, MYCOSKIE003593-3600, MYCOSKIE003730-3732, MYCOSKIE005437-5524, MYCOSKIE005703-5712, MYCOSKIE005727-5733, MYCOSKIE005741-5743 and MYCOSKIE010319-10364, as well as MYCOSKIE011283-11354, which are being produced herewith.

***Interrogatory No. 8***

In addition to MYCOSKIE001331-1349, Applicant directs your attention to MYCOSKIE010278-10313, as well as MYCOSKIE011272-11282, which are being produced herewith.

Richard S. Mandel, Esq.  
March 20, 2015  
Page 2

***Interrogatory No. 13***

Applicant directs your attention to MYCOSKIE001360–1362, MYCOSKIE003555–3556, MYCOSKIE003593–3600, MYCOSKIE003730–3732, and MYCOSKIE010356–10361.

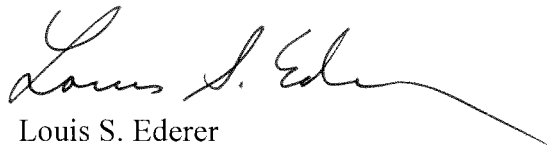
***Interrogatory No. 16***

Rest assured that Applicant possessed the requisite good faith basis for asserting each of the Affirmative Defenses set forth in its September 30, 2014 Answer to Notice of Opposition (the “Answer”). Indeed, the underlying factual basis for each of Applicant’s Affirmative Defenses is set forth in the section of Applicant’s Answer entitled Facts Common To All Affirmative Defenses. Applicant’s Affirmative Defenses are further supported by the following documents produced by Applicant: MYCOSKIE000001–919, MYCOSKIE001249–1349, MYCOSKIE001379–1762, MYCOSKIE002135–2377, MYCOSKIE002383–2389, MYCOSKIE003334–4194, MYCOSKIE004297–4361, MYCOSKIE004444–4620, MYCOSKIE005756–9973, MYCOSKIE010185–10194, MYCOSKIE010278–10314, and MYCOSKIE011065–11271.

As referred to above, enclosed please find a disk containing Applicant’s third supplemental production of documents (MYCOSKIE011272–11354).

Very truly yours,

ARNOLD & PORTER LLP

  
Louis S. Ederer

Enclosure

# **EXHIBIT 14**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 86/004,044  
Filed: July 8, 2013  
For Mark: TOMS  
Published in the Official Gazette: April 29, 2014

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TOD'S S.P.A,	:	
	:	Opposition No. 91218001
	:	<b>OPPOSER'S INITIAL</b>
v.	:	<b><u>DISCLOSURES</u></b>
MYCOSKIE, LLC,	:	
	:	Applicant.

-----X

Pursuant to Federal Rule of Civil Procedure 26(a)(1) and 37 C.F.R. § 2.120, Opposer Tod's S.p.A. ("Opposer") hereby serves its Initial Disclosures in the above-captioned proceeding. Opposer's investigation is ongoing and these initial disclosures are based upon the information reasonably available to Opposer at this time. Opposer reserves the right to remove from these disclosures any individual if Opposer learns that the information known by such individual is not discoverable, and Opposer also reserves the right to modify or supplement the information provided in these Initial Disclosures based upon continuing investigation and discovery in this proceeding.

**I. IDENTIFICATION OF INDIVIDUALS PURSUANT TO FED. R. CIV. P.  
26(a)(1)(A)(i)**

Opposer identifies the persons listed below as individuals who may have discoverable information that Opposer may use to support its claims. Opposer has provided contact information solely to comply with Rule 26(a)(1)(A), and does not consent to or authorize any communications with any of its current or former employees or any communications which are otherwise prohibited by applicable rules of professional conduct. All such individuals may only be contacted through counsel.

1. Claudio Castiglioni  
General Brand Manager (Tod's)  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

Subjects – History and background of Tod's; adoption and use of Opposer's TOD'S marks, including advertising and sales in connection with such marks; fame, strength and consumer recognition of Opposer's TOD'S marks; similarity of the parties' goods and marks; likelihood of confusion and dilution and injury to Opposer from registration of Applicant's TOMS mark.

2. Stephanie Rothfeld  
Director of Retail (Tod's)  
Deva Inc.  
650 Madison Ave.  
New York, New York 10601

Subjects – Role of Deva with respect to distribution of TOD'S products in the United States; use of Opposer's TOD'S marks, including advertising and sales in connection with such marks; fame, strength and consumer recognition of Opposer's TOD'S marks; similarity of the

parties' goods and marks; likelihood of confusion and dilution and injury to Opposer from registration of Applicant's TOMS mark.

3. Representatives of Applicant – identities presently unknown

Subjects – Applicant's adoption and use of Applicant's TOMS mark; similarity of the parties' goods and marks; likelihood of confusion and dilution and injury to Opposer from registration of Applicant's TOMS mark.

**II. DESCRIPTION OF DOCUMENTS PURSUANT TO FED. R. CIV. P.  
26(a)(1)(A)(ii)**

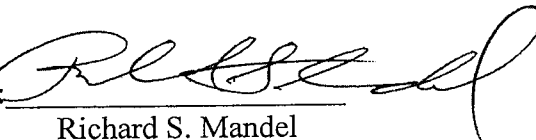
Opposer identifies the following categories of documents in its possession, custody or control that it may use to support its claims. All of these documents are located at Opposer's offices in Italy:

1. Certificates of registration for Opposer's TOD'S marks.
2. Documents concerning the use of Opposer's TODS marks in the United States, including advertising and sales in connection with such marks.
3. Documents concerning the fame, strength and recognition of Opposer's TODS marks, including sales and advertising information.

Dated: New York, New York  
December 3, 2014

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.  
Attorneys for Opposer

By:   
Richard S. Mandel

1133 Avenue of the Americas  
New York, New York 10036-6799  
(212) 790-9200

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the attached Opposer's Initial Disclosures was served upon Applicant by mailing a copy thereof by first class mail, postage prepaid, on Applicant's counsel of record on December 3, 2014 addressed as follows:

Louis S. Ederer, Esq.  
Arnold & Porter LLP  
555 12<sup>th</sup> St NW, Suite 100  
Washington, D.C. 20004-1206

Louis S. Ederer, Esq.  
Arnold & Porter LLP  
399 Park Avenue  
New York, New York 10022

/Richard S. Mandel/  
RICHARD S. MANDEL, ESQ.

# **EXHIBIT 15**



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**From:** Mandel, Richard <RSM@cll.com>  
**Sent:** Wednesday, April 08, 2015 12:49 PM  
**To:** Ederer, Louis S.  
**Subject:** Toms  
**Attachments:** Cancellation Petition\_Toms.pdf

Lou,

For your information, I am enclosing a copy of a cancellation petition we have served and filed today on behalf of Tod's concerning various TOMS registrations. Because of the obvious overlapping issues, we think it will ultimately make sense to consolidate this proceeding with the existing opposition and have the combined proceeding operate in accordance with the discovery schedule ultimately set in the new proceeding.

Assuming you agree, perhaps it would make sense in the interim for us to extend the current discovery schedule in the opposition by 60 days to allow sufficient time for an answer to be filed in the cancellation, as the Board generally requires an answer before it will allow consolidation.

Let me know your thoughts on this and if you would like to discuss any of these issues further, please feel free to call me.

**Richard S. Mandel, Esq.**  
Cowan, Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, New York 10036-6799  
t: (212) 790-9291 | f: (212) 575-0671  
[www.cll.com](http://www.cll.com) | [rsm@cll.com](mailto:rsm@cll.com) | [My Profile](#)



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# **EXHIBIT 16**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344

Registered: Feb. 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013

For Mark: TOMS

-----X

TOD'S S.P.A.,

:

Petitioner,

:

Cancellation No.

v.

:

**CONSOLIDATED  
CANCELLATION PETITION**

MYCOSKIE, LLC,

:

Respondent.

:

-----X

Opposer Tod's S.p.A., an Italian joint stock company located at Via Filippo Della Valle, 1, Sant'Elpidio A Mare, Ascoli Piceno, 63019, ITALY, believes that it is being damaged by registration of the TOMS mark ("Respondent's Mark") shown in Registration Nos. 4,097,948; 4,192,925; 4,313,981 and 4,410,344 (the "Registrations") and hereby petitions to cancel the same.

As ground for cancellation, it is alleged that:





1. For many years, Petitioner, including its affiliated and related companies (collectively, "Opposer"), has been in the business of selling apparel, including shoes and children's shoes, bags, eyewear and other goods and accessories and providing retail stores services and online retail store services.


2. Since well prior to Respondent's filing of the applications that matured into the Registrations at issue in this proceeding or any use by Respondent of Respondent's Mark in

connection with the goods and services covered by the Registrations, Petitioner has used the mark TOD'S in connection with a wide variety of goods and services, including in Classes 9, 25 and 35.

3. As a result of the extensive sales and promotion of its goods and services bearing or offered in connection with Petitioner's TOD'S mark, Petitioner has built up highly valuable goodwill in the TOD'S mark, and said goodwill has become closely and uniquely identified and associated with Petitioner.

4. Petitioner is the owner of several federal trademark registrations for marks containing the TOD'S mark together with other words and/or design elements, including the following registrations:

Mark	Reg. No.	Intl. Class	Reg. Date
	2,749,125	16, 18, 25, 35	Aug. 12, 2003
	1,459,226	18, 25	Sept. 29, 1987
	3,602,493	25	April 7, 2009
	3,831,949	3, 8, 9, 14, 16, 19, 20, 21, 24, 35	Aug. 10, 2010

	4,036,992	9, 14, 18, 25	Oct. 11, 2011
TOD'S SIGNATURE	4,333,244	3, 9, 14, 18, 25	May 14, 2013

5. On February 14, 2012, the USPTO issued Respondent Registration No. 4,097,948 for Respondent's Mark for "clothing, namely, one piece garments for infants and babies" in International Class 25. Respondent filed the application that matured into such registration on December 2, 2010 and claims a date of first use of November 15, 2008.

6. On August 21, 2012, the USPTO issued Respondent Registration No. 4,192,925 for Respondent's Mark for "sunglasses and cases for sunglasses" in International Class 9. Respondent filed the application that matured into such registration on June 6, 2011 and claims a date of first use of June 7, 2011.

7. On April 2, 2013, the USPTO issued Respondent Registration No. 4,313,981 for Respondent's Mark for "eyewear, namely, sunglasses, eyeglasses and ophthalmic frames and cases therefore" in International Class 9. Respondent filed the application that matured into such registration on October 13, 2011 and claims a date of first use of June 6, 2011.

8. On October 1, 2013, the USPTO issued Respondent Registration No. 4,410,344 for Respondent's Mark for "on-line retail store services featuring footwear, apparel, eyewear, jewelry, books, journals, and gift packs consisting of DVDs and posters; retail stores services featuring footwear, apparel, eyewear, jewelry, books, journals, and gift packs consisting of

DVDs and posters” in International Class 35. Respondent filed the application that matured into the registration on January 23, 2013 and claims a date of first use of May 15, 2006.

9. The goods and services offered by Respondent under Respondent’s Mark are identical and/or closely related to the goods and services previously offered by Petitioner under Petitioner’s TOD’S mark.

10. Respondent’s Mark so resembles Petitioner’s TOD’S mark as to be likely, when used in connection with the applied for goods and services, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Respondent’s goods and services have their origin with Petitioner and/or that such goods and services are approved, endorsed or sponsored by Petitioner or associated in some way with Petitioner.

11. Petitioner’s TOD’S mark is distinctive and famous and has enjoyed such distinctiveness and fame since long prior to Respondent’s filing of the applications that matured into the Registrations.

12. Respondent’s Mark is likely to dilute the distinctiveness of Petitioner’s famous TOD’S Mark by blurring.

13. Petitioner is being injured by the Registrations because Respondent’s Mark so resembles Opposer’s TOD’S mark as to be likely, when used in connection with Respondent’s goods and services, (a) to cause confusion, or to cause mistake, or to deceive; (b) to falsely suggest a connection with Petitioner and/or its TOD’S branded goods and services; (c) to damage Petitioner’s valuable goodwill in its TOD’S mark; (d) to interfere with Petitioner’s own use and exploitation of its TOD’S mark; and (e) to dilute the distinctiveness of Petitioner’s TOD’S mark.

WHEREFORE, Petitioner, by its attorneys, respectfully requests that its cancellation petition be sustained and the Registrations be cancelled.

Dated: New York, New York  
April 8, 2015

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.  
Attorneys for Opposer

By: /Richard S. Mandel/  
Richard S. Mandel  
Aryn M. Emert  
1133 Avenue of the Americas  
New York, New York 10036-6799  
(212) 790-9200

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of this Cancellation Petition was served upon Respondent on April 8, 2015 by mailing a copy thereof by first class mail, postage prepaid, addressed as follows:

Mycoskie, LLC  
5404 Jandy Place  
Los Angeles, California 90066

\_\_\_\_\_  
/Aryn M. Emert/  
Aryn M. Emert



# **EXHIBIT 17**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

-----	:	
	:	
TOD'S S.P.A.,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91218001
MYCOSKIE, LLC,	:	
	:	
Applicant.	:	
	:	
-----	:	
	:	
TOD'S S.P.A.,	:	
	:	
Petitioner,	:	
	:	
v.	:	
	:	Cancellation No. 92061234
MYCOSKIE, LLC,	:	
	:	
Respondent.	:	
	:	
	:	
	:	
-----	:	X

**MOTION ON CONSENT TO CONSOLIDATE OPPOSITION AND CANCELLATION  
PROCEEDINGS AND TO CONFORM OPPOSITION  
AND CANCELLATION SCHEDULES**

Pursuant to Rule 511 of the Trademark Trial and Appeal Board Manual of Procedure and

Fed. R. Civ. P. 42(a), Tod's S.p.A. ("Opposer/Petitioner"), by and through counsel, hereby moves for an order consolidating Opposition No. 91218001 and Cancellation No. 92061234.

Opposer/Petitioner further requests that the schedule for the opposition and cancellation proceedings be conformed by adopting the dates as set in the most recently instituted of the cases being consolidated, *i.e.*, the schedule set for Cancellation No. 92061234. Counsel for Applicant/Respondent Mycoskie, LLC ("Applicant/Respondent") consents to this motion.

### **MEMORANDUM OF LAW**

#### **A. The Opposition and Cancellation Actions Should Be Consolidated Because They Contain Common Issues of Law and Fact**

On August 25, 2014, Opposer/Petitioner filed an opposition against Applicant/Respondent's application to register the mark TOMS for goods in International Class 18, as shown in Application Serial No. 86/004,044 (Opposition No. 91218001).

Applicant/Respondent filed an answer thereto on September 30, 2014. The parties thereafter held their discovery conference, served their respective Initial Disclosures and conducted written discovery.

On April 8, 2015, Opposer/Petitioner filed a consolidated cancellation action against Applicant/Respondent's registrations for the mark TOMS for goods and services in International Classes 9, 25 and 35 as shown in Registration Nos. 4,097,948, 4,192,925, 4,313,981, and 4,410,344 (Cancellation No. 92061234). On May 18, 2015, Applicant/Respondent filed its Answer to the cancellation action.

The opposition and cancellation proceedings both involve identical parties. Both proceedings also involve common questions of fact and law for the Board to resolve, including Applicant/Respondent's right to register the mark TOMS. Opposer/Petitioner owns TOD'S-formative marks, and Opposer/Petitioner's grounds for opposition and cancellation in both

proceedings relate to those marks. Rule 511 of the Trademark Trial and Appeal Board Manual of Procedure provides that “[w]hen cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases.” See also Fed. R. Civ. P. 42(a); World Hockey Ass’n v. Tudor Metal Prods. Corp., 185 U.S.P.Q. 246, 248 (T.T.A.B. 1975) (ordering consolidation of two opposition proceedings because it was “equally advantageous to both parties in the avoidance of the duplication of effort, loss of time, and extra expense involved in conducting the proceedings alternately”).

In addition, counsel for Applicant/Respondent, Louis S. Ederer, Esq., consented to the consolidation in an e-mail to Opposer/Petitioner’s counsel on May 22, 2015.

**B. Discovery And Trial Periods Should Be Conformed**

Opposer/Petitioner, with Applicant/Respondent’s consent, further requests that the schedule for the opposition and cancellation proceedings be conformed by adopting the dates as set in the most recently instituted of the cases being consolidated, *i.e.*, the schedule set for Cancellation No. 92061234, as set forth below:

Deadline for Discovery Conference<sup>1</sup>: 6/18/2015  
Discovery Opens 6/18/2015  
Initial Disclosures Due 7/18/2015  
Expert Disclosures Due 11/15/2015  
Discovery Closes 12/15/2015  
Plaintiff's Pretrial Disclosures 1/29/2016  
Plaintiff's 30-day Trial Period Ends 3/14/2016  
Defendant's Pretrial Disclosures 3/29/2016  
Defendant's 30-day Trial Period Ends 5/13/2016  
Plaintiff's Rebuttal Disclosures 5/28/2016  
Plaintiff's 15-day Rebuttal Period Ends 6/27/2016

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<sup>1</sup> Discovery conference and initial disclosure deadlines apply to Cancellation No. 92061234. (In Opposition No. 91218001, the parties have held their discovery conference and served Initial Disclosures.)

**CONCLUSION**

For the foregoing reasons, Opposition No. 91218001 and Cancellation No. 92061234 should be consolidated, and the schedule for the newly consolidated opposition and cancellation proceeding should be conformed to the schedule set by the Board in Cancellation No. 92061234.

Dated: New York, New York  
May 27, 2015

Respectfully submitted,  
COWAN, LIEBOWITZ & LATMAN, P.C.  
*Attorneys for Opposer/Petitioner*

By: /Aryn M. Emert/  
Richard S. Mandel  
Aryn M. Emert  
1133 Avenue of the Americas  
New York, New York 10036  
(212) 790-9200

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the attached *Motion on Consent To Consolidate Opposition And Cancellation Proceedings And To Conform Opposition And Cancellation Schedules* was served upon Applicant/Respondent by mailing a copy thereof by first class mail, postage prepaid, on Applicant/Respondent's counsel of record on May 27, 2015 addressed as follows:

Louis S. Ederer, Esq.  
Arnold & Porter LLP  
399 Park Avenue  
New York, NY 10022

Louis S. Ederer, Esq.  
Arnold & Porter LLP  
399 Park Ave  
New York, NY 90066

/Aryn M. Emert/  
Aryn M. Emert

# **EXHIBIT 18**

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Mailed: May 28, 2015

**Opposition No. 91218001 (parent)**  
Cancellation No. 92061234

Tod's S.p.A.

v.

Mycoskie, LLC

**Ellen M. Yowell, Paralegal Specialist:**

On May 27, 2015, Opposer/Petitioner filed a consented motion to consolidate Opposition No. 91218001 and Cancellation No. 92061234. The Board notes initially that Applicant/Respondent has filed its answer in each proceeding for which consolidation is sought.

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby.

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or



upon the Board's own initiative. *See, e.g., Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).

It is noted that the parties to these proceedings are identical, and the issues are similar or related. Accordingly, the motion to consolidate is granted. Opposition No. 91218001 and Cancellation No. 92061234 are hereby consolidated and may be presented on the same record and briefs. *See Hilson Research Inc. v. Society for Human Resource Management, supra*; and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Board file will be maintained in Opposition No. 91218001 as the “parent case.” From this point on, only a single copy of all motions and papers should be filed, and each such motion or paper should be filed in the parent case only, but caption all consolidated proceeding numbers, listing the “parent case” first.<sup>1</sup>

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

Upon consolidation, the Board will reset dates for the consolidated proceeding, usually by adopting the dates as set in the most recently instituted of the cases being consolidated. Trial dates remain as set forth below.<sup>2</sup>

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<sup>1</sup> The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

<sup>2</sup> The Board notes that in its motion, Opposer/Petitioner indicates that the parties have held their discovery conference and served initial disclosures with respect to Opposition No. 91218001.

Deadline for Discovery Conference in Cancellation No. 92061234	<b>6/18/2015</b>
Discovery Opens	<b>6/18/2015</b>
Initial Disclosures Due in Cancellation No. 92061234	<b>7/18/2015</b>
Expert Disclosures Due	<b>11/15/2015</b>
Discovery Closes	<b>12/15/2015</b>
Plaintiff's Pretrial Disclosures	<b>1/29/2016</b>
Plaintiff's 30-day Trial Period Ends	<b>3/14/2016</b>
Defendant's Pretrial Disclosures	<b>3/29/2016</b>
Defendant's 30-day Trial Period Ends	<b>5/13/2016</b>
Plaintiff's Rebuttal Disclosures	<b>5/28/2016</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>6/27/2016</b>

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

# **EXHIBIT 19**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 86/004,044  
Filed: July 8, 2013  
For Mark: TOMS  
Published in the Official Gazette: April 29, 2014

In re Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344  
Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013  
For Mark: TOMS

-----X

TOD'S S.P.A.,	:	
	:	
Opposer/Petitioner,	:	Opposition No. 91218001 (parent)
	:	Cancellation No. 92061234
v.	:	
	:	
MYCOSKIE, LLC,	:	<b>OPPOSER/PETITIONER'S</b>
	:	<b><u>INITIAL DISCLOSURES</u></b>
Applicant/Respondent.	:	

-----X

Pursuant to Federal Rule of Civil Procedure 26(a)(1) and 37 C.F.R. § 2.120,  
Opposer/Petitioner Tod's S.p.A. ("Opposer/Petitioner") hereby serves its Initial Disclosures in  
the above-captioned consolidated proceeding. Opposer/Petitioner's investigation is ongoing and  
these initial disclosures are based upon the information reasonably available to  
Opposer/Petitioner at this time. Opposer/Petitioner reserves the right to remove from these  
disclosures any individual if Opposer/Petitioner learns that the information known by such  
individual is not discoverable, and Opposer/Petitioner also reserves the right to modify or  
supplement the information provided in these Initial Disclosures based upon continuing  
investigation and discovery in this proceeding.

**I. IDENTIFICATION OF INDIVIDUALS PURSUANT TO FED. R. CIV. P. 26(a)(1)(A)(i)**

Opposer/Petitioner identifies the persons listed below as individuals who may have discoverable information that Opposer/Petitioner may use to support its claims.

Opposer/Petitioner has provided contact information solely to comply with Rule 26(a)(1)(A), and does not consent to or authorize any communications with any of its current or former employees or any communications which are otherwise prohibited by applicable rules of professional conduct. All such individuals may only be contacted through counsel.

1. Claudio Castiglioni  
General Brand Manager (Tod's)  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

Subjects – History and background of Tod's; adoption and use of Opposer/Petitioner's TOD'S marks, including advertising and sales in connection with such marks; fame, strength and consumer recognition of Opposer/Petitioner's TOD'S marks; similarity of the parties' goods and marks; likelihood of confusion and dilution and injury to Opposer/Petitioner from registration of Applicant/Registrant's TOMS mark.

2. Stephanie Rothfeld  
Director of Retail (Tod's)  
Deva Inc.  
650 Madison Ave.  
New York, New York 10601

Subjects – Role of Deva with respect to distribution of TOD'S products in the United States; use of Opposer/Petitioner's TOD'S marks, including advertising and sales in connection with such marks; fame, strength and consumer recognition of Opposer/Petitioner's TOD'S

marks; similarity of the parties' goods and marks; likelihood of confusion and dilution and injury to Opposer/Petitioner from registration of Applicant/Registrant's TOMS mark.

3. Silvia Pinotti  
Advertising Planner Associate for Online Commerce  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

Subjects – Actual confusion between Opposer/Petitioner and Applicant/Registrant.

4. Representatives of Applicant/Registrant – identities presently unknown

Subjects – Applicant/Registrant's adoption and use of Applicant/Registrant's TOMS mark; similarity of the parties' goods and marks; likelihood of confusion and dilution and injury to Opposer/Petitioner from registration of Applicant/Registrant's TOMS mark.

## **II. DESCRIPTION OF DOCUMENTS PURSUANT TO FED. R. CIV. P. 26(a)(1)(A)(ii)**

Opposer/Petitioner identifies the following categories of documents in its possession, custody or control that it may use to support its claims. All of these documents are located at Opposer/Petitioner's offices in Italy:

1. Certificates of registration for Opposer/Petitioner's TOD'S marks.
2. Documents concerning the use of Opposer/Petitioner's TODS marks in the United States, including advertising and sales in connection with such marks.

3. Documents concerning the fame, strength and recognition of Opposer/Petitioner's  
TODS marks, including sales and advertising information.

Dated: New York, New York  
July 20, 2015

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.  
Attorneys for Opposer

By: 

Richard S. Mandel  
1133 Avenue of the Americas  
New York, New York 10036-6799  
(212) 790-9200

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the attached Opposer/Petitioner's Initial Disclosures was served upon Applicant by mailing a copy thereof by first class mail, postage prepaid, on Applicant's counsel of record on July 20, 2015 addressed as follows:

Louis S. Ederer, Esq.  
Arnold & Porter LLP  
555 12<sup>th</sup> St NW, Suite 100  
Washington, D.C. 20004-1206

Louis S. Ederer, Esq.  
Arnold & Porter LLP  
399 Park Avenue  
New York, New York 10022

/Richard S. Mandel/  
RICHARD S. MANDEL, ESQ.



# **EXHIBIT 20**



4. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 4, and accordingly denies such allegations..

5. Respondent admits the allegations in Paragraph 5.

6. Respondent admits the allegations in Paragraph 6.

7. Respondent admits the allegations in Paragraph 7.

8. Respondent admits the allegations in Paragraph 8.

9. Respondent denies the allegations in Paragraph 9.

10. Respondent denies the allegations in Paragraph 10.

11. Respondent denies the allegations in Paragraph 11.

12. Respondent denies the allegations in Paragraph 12.

13. Respondent denies the allegations in Paragraph 13.

**FACTS COMMON TO ALL AFFIRMATIVE DEFENSES**

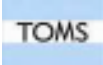
1. Respondent is the proprietor of the well-known TOMS brand for footwear, eyewear, apparel, and other related products and services. Respondent's TOMS mark has been continuously in use in the United States since May 2006.

2. Respondent owns the following federal trademark registrations and/or pending applications for the TOMS word mark for various related goods and services (collectively, the "TOMS Marks"), in addition to Respondent's TOMS Marks:


Mark	International Class and Goods/Services	Reg. No./ Serial No.
TOMS	25 (Canvas shoes, Shoes)	Reg. No. 3,353,902 Reg. Date: 12/11/07 Status: Incontestable as of

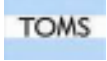
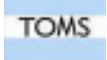
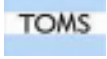
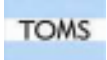


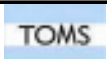
Mark	International Class and Goods/Services	Reg. No./ Serial No.
		11/30/13
TOMS	25 (Clothing, namely, canvas shoes, shoes, caps, shirts, t-shirts and hats)	Reg. No. 3,566,093 Reg. Date: 1/20/2009 Status: Incontestable as of 4/1/14
TOMS	25 (Clothing, namely, hoods, jerseys, tops and jackets)	Reg. No. 3,662,112 Reg. Date: 7/28/09 Status: Incontestable as of 9/30/2014
TOMS	30 (Coffee and coffee-based beverages; and artificial coffee)	Reg. No. 4,602,798 Reg. Date: 9/9/14
TOMS	30 (Tea; cocoa)	Ser. No. 85/965,239 App. Date: 1/20/13 Status: Notice of Allowance issued on 7/24/2014



3. Respondent also owns the following applications and registrations for the mark

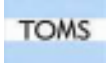
TOMS and Design (  ) (the “TOMS and Design Marks”), including applications and registrations in Classes 9, 25 and 35, in certain instances for the same or similar goods as

Respondent’s TOMS Marks:

Mark	International Class and Goods/Services	Reg. No./ Serial No.
	25 (Baseball caps; Caps; Hat; Canvas shoes; Footwear for men and women;	Reg. No. 3,765,503 Reg. Date: 3/23/2010

Mark	International Class and Goods/Services	Reg. No./ Serial No.
	Shoes; and shirts)	
	35 (Retail store services and on-line retail store services in the field of footwear, apparel, eyewear, jewelry, books, journals, and gift packs consisting of DVDs and posters)	Reg. No. 4,274,178 Reg. Date: 1/15/2013
	9 (Eyewear, namely, sunglasses, eyeglasses and ophthalmic frames and cases therefore)	Reg. No. 4,517,359 Reg. Date: 4/22/2014
	43 (Charitable services, namely, providing safe drinking water to those in developing countries)	Reg. No. 4,403,205 Reg. Date: 9/17/2013
	30 (Coffee and coffee-based beverages; and artificial coffee)	Reg. No. 4,602,814 Reg. Date: 9/9/14
	25 (Clothing, namely, hats, caps, sweatshirts, sweatpants, and shirts; and footwear)	Ser. No. 86/764,429 App. Date: 12/10/2014 Status: Pending
	18 (Goods made of leather or imitations of leather, namely, card wallets, clutch bags, clutch purses, cosmetic bags sold empty, cosmetic cases sold empty, key bags, key cases, key wallets, and luggage; bags, namely, all-purpose carrying bags, all-purpose athletic bags, and backpacks; trunks; valises; suitcases; tote bags; travelling bags; garment bags for travel; rucksacks; satchels; holdalls; handbags; shoulder bags; canvas shopping bags; wheeled shopping bags and purses; jewelry pouches; wallets; credit card holders of leather and imitations of leather; pochettes; luggage label holders and tags; collars for pets; and leashes for animals)	Ser. No. 86/004,053 App. Date: 4/29/2014 Status: Notice of Allowance issued 6/24/2014
	30 (Tea; cocoa)	Ser. No. 85/247 App. Date: 12/3/13 Status: Notice of Allowance issued on 7/25/2014

Mark	International Class and Goods/Services	Reg. No./ Serial No.
	32 (Drinking water)	Ser. No. 85/844,914 App. Date: 2/8/2013 Status: Notice of Allowance issued on 8/27/2013
	<p>9 (Eyewear, namely, sunglasses, eyeglasses and ophthalmic frames and cases therefor)</p> <p>18 (Goods made of leather or imitations of leather, namely, card wallets, clutch bags, clutch purses, cosmetic bags sold empty, cosmetic cases sold empty, key bags, key cases, key wallets, and luggage; bags, namely, all-purpose carrying bags, all-purpose athletic bags, and backpacks; trunks; valises; suitcases; tote bags; travelling bags; garment bags for travel; rucksacks; satchels; holdalls; handbags; shoulder bags; canvas shopping bags; wheeled shopping bags and purses; jewelry pouches; wallets; credit card holders of leather and imitations of leather; pochettes; luggage label holders and tags; collars for pets; and leashes for animalsations of leather, namely, card wallets, clutch bags, clutch purses, cosmetic bags sold empty, cosmetic cases sold empty, key bags, key cases, key wallets, and luggage; bags, namely, all-purpose carrying bags, all-purpose athletic bags, and backpacks; trunks; valises; suitcases; tote bags; travelling bags; garment bags for travel; rucksacks; satchels; holdalls; handbags; shoulder bags; canvas shopping bags; wheeled shopping bags and purses; jewelry pouches; wallets; credit card holders of leather and imitations of leather; pochettes; luggage label holders and tags; collars for pets; and leashes for animals)</p> <p>25 (Clothing, namely, hats, baseball caps, caps, sweatshirts, jackets, jerseys, and</p>	<p>Ser. No. 86/242,690 App. Date: 7/29/2014 Status: Notice of Allowance issued 9/23/2014</p>

Mark	International Class and Goods/Services	Reg. No./ Serial No.
	shirts; and footwear)  30 (Coffee, tea, cocoa, and coffee-based beverages; and artificial coffee)  32 (Drinking water)  35 (Retail store services and on-line retail store services in the field of footwear, apparel, eyewear, jewelry, books, journals, and gift packs consisting of DVDs and posters)  43 (Charitable services, namely, providing safe drinking water to those in developing countries)	
	21 (Cups, Mugs, insulated coffee and beverage cups, and beverage glassware; thermal insulated bottles; portable bottles sold empty; insulating sleeves for beverage cups; paper and plastic cups)  43 (Café services, coffee bar services and coffee house services)	Ser. No. 86/582,778 App. Date: 3/31/2015

4. Petitioner has never filed any opposition or cancellation proceedings against any of the TOMS Marks or TOMS and Design Marks referenced in Paragraphs 2 and 3 above, and all such marks have either registered, or are awaiting registration.

5. Since at least as early as May 2006, identical and/or related goods and services bearing the TOMS Marks and Petitioner's TOD'S mark have coexisted in the United States marketplace — frequently being sold in the same retail locations, including, without limitation, the Nordstrom and Neiman Marcus department store chains — without any known instances of actual confusion, or any indication whatsoever that confusion is likely.

6. On August 25, 2014, Petitioner filed a Notice of Opposition against Respondent's application to register the word mark TOMS in Class 18 (Ser. No. 86/004,044). At that time, all of the TOMS word mark registrations that are the subject of Petitioner's Consolidated Cancellation Petition were subsisting. Yet, without explanation, Petitioner did not file the current proceeding until nearly eight months later.

### **AFFIRMATIVE DEFENSES**

7. The Consolidated Cancellation Petition fails to state a claim upon which relief can be granted.

8. Petitioner is barred from any relief because there is no likelihood of confusion between Respondent's TOMS Marks and Petitioner's TOD'S mark.

9. Petitioner is barred from any relief because Respondent owns prior incontestable and other registrations for the same mark in connection with essentially the same goods and/or services as Respondent's TOMS Marks.

10. Petitioner is barred from any relief under the doctrine of estoppel.

11. Petitioner is barred from any relief under the doctrine of waiver.

12. Petitioner is barred from any relief under the doctrine of laches.

13. Petitioner is barred from any relief under the doctrine of acquiescence.

14. Petitioner is barred from any relief under the doctrine of unclean hands.

### **PRAYER FOR RELIEF**

WHEREFORE, Respondent respectfully prays that the Board dismiss the Consolidated Cancellation Proceeding in its entirety.



Dated: May 18, 2015

Respectfully submitted,

ARNOLD & PORTER LLP

By: /Louis S. Ederer/

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*Attorneys for Respondent Mycoskie, LLC*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on May 18, 2015, a copy of the foregoing  
ANSWER TO CONSOLIDATED CANCELLATION PROCEEDING was served by First Class  
Mail upon the following counsel of record for Petitioner Tod's S.p.A.:

Richard S. Mandel, Esq.  
Lindsay M. Rodman, Esq.  
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*Attorneys for Petitioner Tod's S.p.A.*

/Louis S. Ederer/  
Louis S. Ederer

# **EXHIBIT 21**

## USPTO TRADEMARK TRIAL AND APPEAL BOARD

-----x

TOD'S S.P.A.,

Plaintiff,

vs.

Case No. 91218001-OPP

MYCOSKIE, LLC,

Defendant.

-----x

## DEPOSITION OF CLAUDIO CASTIGLIONI

New York, New York

October 9, 2015

9:43 a.m.

Reported by:  
ERICA L. RUGGIERI, RPR  
JOB NO. 41197

1 A. No, I don't think so.

2 Q. Who replaced you as CEO of Deva  
3 in 2007?

4 A. Giacommetti.

5 Q. Marco Giacommetti?

6 A. Yes.

7 Q. Do you know how long he was with  
8 the company?

9 A. Did he stay in America?

10 Q. Yes.

11 A. Four years.

12 Q. And then he was replaced as CEO  
13 by Mr. Lorenzini?

14 A. Yes.

15 Q. Who is the current CEO, correct?

16 A. Exactly.

17 Q. And as general brand manager,  
18 have you worked with Mr. Giacommetti and  
19 Mr. Lorenzini about the development of the  
20 Tod's brand in the United States?

21 A. Absolutely.

22 Q. I'd like to mark as an exhibit,  
23 I think we are up to D-18. This is a  
24 series of documents that we put together.  
25 These are corporate filing documents in

1 various states in the United States  
2 relating to the company Deva, Inc.?

3 (Exhibit D-18, Corporate filing  
4 documents, marked for identification,  
5 as of this date.)

6 Q. Now, Mr. Castiglioni, I'm  
7 showing you a document that consists of  
8 various pages that we compiled and put  
9 together and just so you understand what  
10 these are, these are publicly filed  
11 documents in various states in the United  
12 States where Deva, Inc. has filed  
13 documents in states where it wishes to do  
14 business. Okay?

15 And I'd like to call your  
16 attention, in particular, to the sixth  
17 page of the document. As you can see, on  
18 the sixth page of the document at the top  
19 of the page it says "Application by  
20 Foreign Corporation for Authorization to  
21 Transact Business in Florida."

22 Do you see that?

23 A. What page? Yes.

24 Q. Do you see that?

25 A. Yes, I do.

1           Q.     And then just to put a date on  
2     this document, there's a stamp on the  
3     right-hand side which is a stamp by the  
4     Florida Division of Corporations that  
5     appears to have a date of July 10th, 2012.

6                     Do you see that?

7           A.     Yes.

8           Q.     Okay. And so this appears to be  
9     an application filed by Deva, Inc. with  
10    the state of Florida to be able to conduct  
11    or transact business in that state.

12                    And if you look at the next page  
13    of the document it lists the directors of  
14    the company and it says, "Chairman,  
15    Stefano Sincini" and "Vice Chairman,  
16    Claudio Castiglioni."

17                    Do you see that?

18          A.     Yes, I do.

19          Q.     Did you understand that you held  
20    the title of vice chairman of Deva, Inc.  
21    in July of 2012?

22          A.     Now that I see the document I  
23    remember.

24          Q.     And is it the case that Mr.  
25    Sincini was the chairman of the board of

1 directors of Deva, Inc. at that time?

2 A. Yes.

3 Q. And do you know whether you  
4 still continue to hold a position on the  
5 board of directors of Deva, Inc.?

6 A. No.

7 Q. You don't know?

8 A. No, I don't. I don't know.

9 Q. Do you know whether  
10 Mr. Sincini -- well, first of all, who is  
11 Mr. Sincini?

12 A. He's the CEO of Tod's SpA.

13 Q. In Italy?

14 A. Exactly.

15 Q. And do you report to him?

16 A. Yes, I do.

17 Q. Does he report to anyone within  
18 the company?

19 A. To the owner of the group.

20 Q. Is that Mr. Della Valle?

21 A. Exactly.

22 Q. Is it Diego Della Valle?

23 A. Yes.

24 Q. So he's the owner of the group.

25 Is he considered the chairman of Tod's



1 SpA, if you will?

2 A. He doesn't have a title but,  
3 yes.

4 Q. He's the boss?

5 A. Exactly.

6 Q. And Mr. Sincini reports to him  
7 but in turn Mr. Sincini is the chief  
8 executive officer of the company, right?

9 A. Yes.

10 Q. Now, if you turn the page and go  
11 two pages further, this is a document that  
12 states that it was filed on January 8th,  
13 2013, and I can indicate to you that this  
14 is a document that we downloaded from the  
15 Internet from the state of Florida and it  
16 appears to be an annual report filed by  
17 Deva, Inc. with the state of Florida in  
18 2013. And as you can see, Mr. Sincini is  
19 still listed as a director and you are  
20 still listed as a director.

21 Do you see that?

22 A. Yes, I do.

23 Q. So as of the beginning of 2013,  
24 do you recall that you were still  
25 considered a director of Deva, Inc.?

1 A. No.

2 Q. You don't recall?

3 A. No, I mean because I'm not so I  
4 don't know. I see this document but.

5 Q. Do you know whether Mr. Sincini  
6 continued to be a member of the board or  
7 the chairman of the board of directors of  
8 Deva, Inc. in 2013?

9 A. Yes. In 2013, yes, because he's  
10 the chairman still today.

11 Q. And also in 2014 if you turn the  
12 page you see Mr. Sincini's name still  
13 appears?

14 A. Yes.

15 Q. Although your name no longer  
16 appears. So sometime between 2013 and  
17 2014 you went off the board of directors  
18 of Deva; is that right?

19 A. Yes. Because according to what  
20 you show me, yes.

21 MR. MANDEL: Well, that's what  
22 the documents say. I mean if you have  
23 a different understanding, you can  
24 testify to it.

25 Q. Yeah. I'm asking you based upon

1       your own recollection whether from 2013 to  
2       2014 you went off the board of directors  
3       of Deva?

4           A.     Yes.

5           Q.     Was there a reason why you went  
6       off the board of directors of Deva?

7           A.     Just because I have other duties  
8       to accomplish.

9           Q.     And then if you turn the page  
10      once more, there's a filing in January of  
11      2015 with the Florida Secretary of State  
12      and it continues to show Mr. Sincini as a  
13      director of the company, correct?

14          A.     Yes.

15          Q.     And is that your understanding  
16      is that he continues to be the chairman of  
17      the board of the company?

18          A.     It's my understanding, correct.

19          Q.     Did you ever participate in any  
20      board of directors meetings for Deva,  
21      Inc.?

22          A.     Yes.

23          Q.     And do you recall when last time  
24      was that you did so?

25          A.     The year exact no, but we used

1 to handle periodically annually because  
2 that was the way to fill up the minutes  
3 book and sign documents.

4 Q. Do you recall any discussions  
5 that took place at any board of directors  
6 meeting of Deva, Inc. that you attended?

7 A. Any discussion?

8 Q. Any subject that was discussed?

9 A. We used to review the minutes  
10 book and we used to like talk about, you  
11 know, the business in general.

12 Q. Did the name TOMS Shoes come up  
13 at a board of directors meeting of Deva,  
14 Inc. that you recall?

15 A. No.

16 Q. Where did those meetings take  
17 place?

18 A. In New York.

19 Q. At the office?

20 A. At the office.

21 Q. On 15th Street?

22 A. Well, we move the office so in  
23 certain periods, certain years it was like  
24 in 57th Street, some others was in 15th  
25 Street and 450 West 15th Street. So the

1 two office we have there.

2 Q. Do you continue to maintain an  
3 office at 15th Street?

4 A. No.

5 Q. Did Mr. Sincini attend these  
6 board of directors meetings that you were  
7 testifying about?

8 A. Yes. Yes.

9 Q. Now earlier you mentioned some  
10 answers to interrogatories that you recall  
11 signing in this proceeding. Do you recall  
12 that?

13 A. Excuse me?

14 Q. You were looking at the document  
15 that I showed you and you thought at first  
16 that these were documents that you had  
17 signed.

18 A. The first one, yes. D-17.

19 Q. D-17. So do you recall actually  
20 signing some documents in this case?

21 A. Yes.

22 Q. And as your counsel may have  
23 mentioned before, these documents were  
24 called interrogatories?

25 A. Yes.

1           Q.     Before that was there another  
2     counsel who worked in your home office in  
3     Italy?

4           A.     There's several according to the  
5     topic.

6                     MR. MANDEL:   Are you asking  
7                     specifically about trademark  
8                     responsibility?

9                     MR. EDERER:   Well, that's my  
10                    next question.

11          Q.     Was there another counsel prior  
12     to Mr. Varsavia who was in Italy and who  
13     was responsible for monitoring trademarks?

14          A.     You know, it's not a field that  
15     I'm in charge with.   Dr. Sincini is the  
16     person that is related to all this  
17     trademark.   So probably there is one but  
18     he was not somebody that deal directly  
19     with me.

20          Q.     Did you say Dr. Sincini?

21          A.     Stefano Sincini.

22          Q.     So Mr. Sincini has overall  
23     responsibility for the trademarks area?

24          A.     Exactly.

25                     MR. MANDEL:   Objection.   You can

1 answer.

2 A. I believe, yes.

3 Q. Mr. Sincini is not a lawyer,  
4 though, is he?

5 A. He's not.

6 Q. He's a business person?

7 A. Yeah.

8 Q. So if I wanted to find out who  
9 was responsible as an in-house lawyer for  
10 trademarks prior to Mr. Varsavia, I should  
11 ask Mr. Sincini, correct?

12 A. Yes.

13 Q. Now, if you turn to  
14 Interrogatory 15 on page 4. Interrogatory  
15 15 says, "Identify the persons who decided  
16 to file and/or approve the filing of the  
17 Notice of Opposition."

18 Do you see that?

19 A. Yes, I do.

20 Q. Do you know what the Notice of  
21 Opposition is?

22 A. Yes.

23 Q. Why don't we just make sure that  
24 we are talking about the same document.  
25 So if you look at that pile of exhibits

1 over there, I believe it's D-2.

2 Do you have D-2 in front of you?

3 A. Yes, I do.

4 Q. D-2 is a document that was filed  
5 on August 25th, 2014 by your company,  
6 Tod's SpA, in the U.S. Trademark Office  
7 and do you understand what that document  
8 is?

9 A. Yes, I do.

10 Q. What is your understanding?

11 A. Is that our company is opposing  
12 this against the applicant Mycoskie, the  
13 fact of the trademark.

14 Q. So just to be clear, if we go to  
15 page 3 of the Notice of Opposition -- do  
16 you have page 3?

17 A. Yes, I do.

18 Q. And if we look at paragraph 5,  
19 would you agree or is it your  
20 understanding that in this document Tod's  
21 is opposing Mycoskie's application to  
22 register the trademark TOMS for the goods  
23 that are specified in paragraph 5?

24 A. Yes.

25 Q. And do you understand that in



1       this document Tod's is opposing any other  
2       application of registration of Mycoskie?

3               MR. MANDEL:  Objection.  The  
4       document speaks for itself.

5       Q.     I'm asking what his  
6       understanding is?

7       A.     It's against all these category,  
8       clutch bag, purse, cosmetic bags, key  
9       bags, key case, wallets, luggage.

10      Q.     So just to be clear, is it your  
11     understanding that there's only one  
12     trademark application that your company  
13     was opposing in this Notice of Opposition  
14     for all these goods?

15      A.     Yes.

16      Q.     Okay.  Going back to the  
17     interrogatories that we were looking at,  
18     Exhibit D-20, Interrogatory 15 on page 4.  
19     It indicates that the person who approved  
20     the filing of Notice of Opposition, which  
21     is the document we were just looking at,  
22     is Mr. Sincini, correct?

23      A.     Correct.

24      Q.     How did you -- how did you  
25     verify the accuracy of that answer?

1           A.     What.

2           Q.     On your verification on the last  
3 page of the document you indicate that the  
4 answers are true to your knowledge based  
5 upon your review of company records and  
6 discussions with individuals and so forth?

7           A.     Yes.

8           Q.     So how did you learn that  
9 Mr. Sincini was the person who approved  
10 the filing of the Notice of Opposition?

11          A.     Because I talk with Dr. Sincini.

12          Q.     So you spoke to Mr. Sincini and  
13 you said who approved the filing of the  
14 opposition. He said I did. Is that  
15 right?

16                 MR. MANDEL: Objection. Assumes  
17 facts not in evidence.

18          Q.     Is that right?

19                 MR. MANDEL: You can answer.

20          Q.     More or less?

21          A.     Well, if you say more or less,  
22 but he was the one that did it, no. I  
23 write it and it match.

24          Q.     And he confirmed that to you in  
25 a conversation that you had with him,

1 correct?

2 A. Yes.

3 Q. And then if we go on to  
4 Interrogatory 16, it says, "Identify the  
5 persons who decided to file and/or approve  
6 the filing of the Petition for  
7 Cancellation."

8 Do you see that?

9 A. Yes.

10 Q. Now, you understand that there's  
11 a second proceeding that your company  
12 started in this case. Do you understand  
13 that?

14 A. Yes.

15 Q. And that's called a cancellation  
16 proceeding?

17 A. Yes.

18 Q. And are you familiar with the  
19 Petition for Cancellation that was filed  
20 by Tod's SpA?

21 A. Yes.

22 Q. And if you take a look at  
23 Exhibit D-3, I believe, is that to your  
24 understanding the Petition for  
25 Cancellation?

1 but you can answer to the best of your  
2 knowledge.

3 A. He was working for the company.

4 Q. For the Hong Kong company or for  
5 the Italian company?

6 A. That I don't know.

7 Q. If you look at Interrogatory 20,  
8 "State the date upon which the persons  
9 identified in response to Interrogatory 15  
10 first became aware of the TOMS brand  
11 and/or the TOMS marks." And the response  
12 indicates that Mr. or Dr. Sincini first  
13 became aware of the TOMS brand and/or the  
14 TOMS marks in or around July 2011.

15 Do you see that?

16 A. Yes.

17 Q. And did you do anything to  
18 verify the accuracy of that answer?

19 A. Yes. We talked to him.

20 Q. You talked to?

21 A. To Dr. Sincini.

22 Q. To Dr. Sincini?

23 A. Yes.

24 Q. Can you tell me what you asked  
25 him and what he said to you?

1           A.     Well, we talk about, you know,  
2     if I recall that around the period of  
3     July 2011 we were talking, you know, about  
4     the trademark.

5           Q.     When you saw we, you mean you  
6     and him?

7           A.     Exactly.

8           Q.     So that was my next question.  
9     Because if you look at Interrogatory 25 it  
10    says, "State the date upon which Claudio  
11    Castiglioni first became aware of the TOMS  
12    brand and/or the TOMS marks."

13                   Do you see that?

14          A.     Yes.

15          Q.     And I would imagine you didn't  
16    have to ask anybody to verify this because  
17    that's you, right?

18          A.     Yes.

19          Q.     Okay. And if you look at the  
20    answer on the next page it says that you  
21    became aware, first became aware of the  
22    TOMS brand and/or the TOMS marks in or  
23    around July 2011?

24          A.     Yes.

25          Q.     And that's the same date that

1 was indicated for Dr. Sincini?

2 A. Exactly.

3 Q. So did you both become aware of  
4 the TOMS brand around the same time?

5 A. That was our conversation. I  
6 remember we talked about it.

7 Q. So tell me about your  
8 conversation. What do you recall about  
9 your conversation in July 2011 with  
10 Dr. Sincini about the TOMS brand?

11 A. There was not much to be said.  
12 It was just a confrontation between the  
13 party and it was just a moment that  
14 Dr. Sincini told me about, you know, the  
15 TOMS and we just, you know, briefly  
16 probably just said we have to monitor.  
17 But we didn't really went more than that.

18 Q. Do you recall a conversation  
19 with Dr. Sincini where one of you said we  
20 have to monitor TOMS?

21 A. He told me.

22 Q. He said we have to monitor TOMS?

23 A. He point to the brand TOMS and  
24 say, you know, what is your feeling about  
25 this brand. We need to monitor.

1 Q. And how did you respond to him?

2 A. Well, I don't recall exactly the  
3 words but, you know, since the name is so  
4 close I probably, you know, say you're  
5 right.

6 Q. Well, were you concerned at the  
7 time?

8 A. But it's happen that this  
9 conversation take place to have feedback  
10 about somebody but he's in charge of that  
11 so he's the one to take care.

12 Q. Well, do you know whether your  
13 company did anything to try and challenge  
14 the use of the TOMS name in July 2011?

15 A. That I'm not aware.

16 Q. Do you know when was the first  
17 time are your company did anything to try  
18 and challenge the use of the TOMS name in  
19 the United States after July 2011?

20 A. For this petition 2014.

21 Q. So what happened between  
22 July 2011 and July -- and August 2014?

23 MR. MANDEL: What happened with  
24 respect to what?

25 Q. With respect to your company's

1 monitoring of the TOMS brand?

2 MR. MANDEL: If you know.

3 A. Because as I mention to you,  
4 Dr. Sincini in charge of that so I don't  
5 know what he did.

6 Q. So you don't know whether he  
7 spoke to attorneys, whether he did any  
8 monitoring himself, anything like that?

9 A. Exactly.

10 Q. You don't know?

11 A. I don't know.

12 Q. Did you have any follow-up  
13 discussion with him about this issue after  
14 July 2011?

15 A. No.

16 Q. When was the first time after  
17 July 2011 that you found out that your  
18 company was challenging the TOMS brand's  
19 application to register the name?

20 MR. MANDEL: Anywhere in the  
21 world or in the U.S.?

22 Q. U.S.

23 A. Probably recently.

24 Q. Meaning in the last year?

25 A. Yes.



# **EXHIBIT 22**

## USPTO TRADEMARK TRIAL AND APPEAL BOARD

-----X

TOD'S S.P.A.,

Plaintiff,

vs.

Case No. 91218001-OPP

MYCOSKIE, LLC,

Defendant.

-----X

## DEPOSITION OF STEPHANIE ROTHFELD

New York, New York

October 8, 2015

9:34 a.m.

Reported by:

ERICA L. RUGGIERI, RPR, CSR, CLR

JOB NO. 41196

1 A. Yes.

2 Q. And how long has Mr. Lorenzini  
3 been with the company?

4 A. Four years.

5 Q. Approximately 2011?

6 A. Yes.

7 Q. And before -- and was he the CEO  
8 for that -- or has he been the CEO for  
9 that entire period?

10 A. Yes, he has.

11 Q. And prior to that time was there  
12 another person in the position of the CEO?

13 A. Yes, there was.

14 Q. Who was that?

15 A. Marco Giacommetti.

16 Q. And is Mr. Giacommetti still  
17 with Tod's or with Deva?

18 A. No, he is not.

19 Q. So he left the company  
20 approximately 2011?

21 A. Approximately, yes.

22 Q. Do you know a Stefano Sincini?

23 A. I do.

24 Q. Have you ever met Mr. Sincini?

25 A. Yes, I have.

1 Q. Who did you understand him to  
2 be?

3 A. He is the CEO of the entire  
4 company globally.

5 Q. Global CEO meaning of Tod's SpA,  
6 correct?

7 A. Yes, correct.

8 Q. And does he have a position or a  
9 title at Deva?

10 A. Meaning the company in the U.S.?

11 Q. The company in the U.S.

12 A. No.

13 Q. Do you know that for a fact or  
14 you are just not aware?

15 A. Maybe I'm not understanding the  
16 question.

17 MR. MANDEL: Well, just answer  
18 to the best of your knowledge.

19 A. No, I don't believe he does.

20 Q. Does he ever come to the office  
21 on 15th Street?

22 A. Yes.

23 Q. How frequently?

24 A. Several times a year. Maybe two  
25 or three.

1 Q. For what purpose?

2 A. For business purposes.

3 Q. Meetings?

4 A. Meetings, yeah.

5 Q. Planning?

6 A. Yes.

7 Q. Things of that nature?

8 A. Yes.

9 Q. Does he maintain an office at  
10 Deva on 15th Street?

11 A. No.

12 Q. Do any individuals who --  
13 typically, who you understand to be  
14 employees of the global Tod's company,  
15 maintain an office at the 15th Street  
16 location?

17 A. No.

18 Q. Do you know Mr. Castiglioni, who  
19 is sitting two chairs to your right?

20 A. Yes.

21 Q. And has he, to your  
22 understanding held any position at the  
23 North American or the Deva operation?

24 MR. MANDEL: At any time you are  
25 asking?

# **EXHIBIT 23**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. 86/004,044  
Filed: July 8, 2013  
For Mark: TOMS  
Published in the Official Gazette: April 29, 2014

In re Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344  
Registered: February 14 ,2012; August 21, 2012; April 2, 2013; October 1, 2013  
For Mark: TOMS

TOD'S S.P.A.,

Opposer,

v.

:

Opposition No. 91218001

MYCOSKIE, LLC,

Applicant.

:

TOD'S S.P.A.,

Petitioner,

:

v.

.

MYCOSKIE, LLC,

:

Cancellation No. 92061234

Respondent.

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X

**OPPOSER/PETITIONER'S SUPPLEMENTAL INITIAL DISCLOSURES  
PURSUANT TO FED. R. CIV. P. 26(a)(1)**

Pursuant to Federal Rule of Civil Procedure 26(a)(1) and 37 C.F.R. § 2.120,

Opposer/Petitioner Tod's S.p.A. ("Opposer/Petitioner") hereby supplements its Initial Disclosures in the above-captioned proceeding, which were served upon Applicant/Respondent Mycoskie, LLC on December 3, 2014. Opposer/Petitioner's investigation is ongoing and these

initial disclosures are based upon the information reasonably available to Opposer/Petitioner at this time. Opposer/Petitioner reserves the right to remove from these disclosures any individual if Opposer/Petitioner learns that the information known by such individual is not discoverable, and Opposer/Petitioner also reserves the right to modify or supplement the information provided in these Supplemental Initial Disclosures based upon continuing investigation and discovery in this proceeding.

**I. IDENTIFICATION OF INDIVIDUALS PURSUANT TO FED. R. CIV. P.  
26(a)(1)(A)(i)**

Opposer/Petitioner identifies the persons listed below as individuals who may have discoverable information that Opposer/Petitioner may use to support its claims.

Opposer/Petitioner has provided contact information solely to comply with Rule 26(a)(1)(A), and does not consent to or authorize any communications with any of its current or former employees or any communications which are otherwise prohibited by applicable rules of professional conduct. All such individuals may only be contacted through counsel.

1. Claudio Castiglioni  
General Brand Manager (Tod's)  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

Subjects – History and background of Tod's; adoption and use of Opposer/Petitioner's TOD'S marks, including advertising and sales in connection with such marks; strength and consumer recognition of Opposer/Petitioner's TOD'S marks; similarity of the parties' goods and marks; likelihood of confusion and injury to Opposer/Petitioner from registration of Applicant/Respondent's TOMS mark.



2. Stephanie Rothfeld  
Director of Retail (Tod's)  
Deva Inc.  
650 Madison Ave.  
New York, New York 10601

Subjects – Role of Deva with respect to distribution of TOD'S products in the United States; use of Opposer/Petitioner's TOD'S marks, including advertising and sales in connection with such marks; strength and consumer recognition of Opposer/Petitioner's TOD'S marks; similarity of the parties' goods and marks; likelihood of confusion and injury to Opposer/Petitioner from registration of Applicant/Respondent's TOMS mark.

3. Silvia Pinotti  
Advertising Planner Associate for Online Commerce  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

Subjects – Actual confusion between Opposer/Petitioner and Applicant/Registrant.

4. Stefano Sincini  
Co-Chief Executive Officer, Executive Director, General Manager  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

Subjects – History and background of Tod's; adoption and use of Opposer/Petitioner's TOD'S marks, including advertising and sales in connection with such marks; strength and consumer recognition of Opposer/Petitioner's TOD'S marks; similarity of the parties' goods and marks; registration of Opposer/Petitioner's TOD'S marks; enforcement of Opposer/Petitioner's TOD'S marks; likelihood of confusion and injury to Opposer /Petitioner from registration of Applicant/Respondent's TOMS mark.

5. Andrea Varsavia  
General Counsel (Tod's)  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

Subjects – Registration of Opposer/Petitioner's TOD'S marks; enforcement of

Opposer/Petitioner's TOD'S marks; similarity of the parties' goods and marks; likelihood of confusion and injury to Opposer/Petitioner from registration of Applicant/Respondent's TOMS mark.

6. Representatives of Applicant/Respondent – identities presently unknown

Subjects – Applicant/Respondent's adoption and use of Applicant/Respondent's TOMS

mark; similarity of the parties' goods and marks; likelihood of confusion and injury to Opposer/Petitioner from registration of Applicant/Respondent's TOMS mark.

## **II. DESCRIPTION OF DOCUMENTS PURSUANT TO FED. R. CIV. P. 26(a)(1)(A)(ii)**

Opposer/Petitioner identifies the following categories of documents in its possession, custody or control that it may use to support its claims. All of these documents are located at Opposer/Petitioner's offices in Italy:


1. Certificates of registration for Opposer/Petitioner's TOD'S marks.
2. Documents concerning the use of Opposer/Petitioner's TODS marks in the United States, including advertising and sales in connection with such marks.
3. Documents concerning the strength and recognition of Opposer/Petitioner's

TODS marks, including sales and advertising information.

Dated: New York, New York  
December 10, 2015

Respectfully submitted,

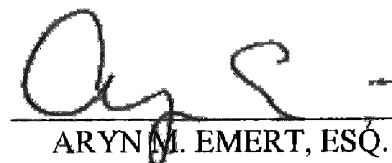
COWAN, LIEBOWITZ & LATMAN, P.C.  
Attorneys for Opposer/Petitioner

By: \_\_\_\_\_  
Richard S. Mandel  
Aryn M. Emert  
1133 Avenue of the Americas  
New York, New York 10036-6799  
(212) 790-9200

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the attached Opposer/Petitioner's Supplemental Initial Disclosures was served upon Applicant/Respondent by mailing a copy thereof by first class mail, postage prepaid, on Applicant/Respondent's counsel of record on December 10, 2015 addressed as follows:

Louis S. Ederer, Esq.  
Arnold & Porter LLP  
399 Park Avenue  
New York, New York 10022

  
ARYN M. EMERT, ESQ.

# **EXHIBIT 24**

# **TOMS Survey Report**

**November 2015**

**FIELD  
RESEARCH  
CORPORATION**

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## Report of E. Deborah Jay, Ph.D.

### I. Introduction and Summary

I am President and Chief Executive Officer of Field Research Corporation ("Field Research"), a San Francisco-based research firm specializing in marketing and public opinion surveys. Field Research was retained on behalf of Mycoskie, LLC and TOMS Shoes, LLC to conduct two likelihood-of-confusion surveys regarding goods with the TOMS name (Field Survey I and Field Survey II).<sup>1,2</sup>

**Field Survey I** was conducted with a nationwide representative sample of potential buyers of the Class 18 goods listed in TOMS Application Serial No. 86/004,044. The purpose of Field Survey I was to determine whether relevant consumers are likely to mistakenly believe that TOD's S.p.A. or TOD'S is the source, the sponsor of, or affiliated with the Class 18 goods with the TOMS name.

**Field Survey II** was conducted with a nationwide representative sample of potential buyers of the Class 9 goods listed in two of the TOMS trademark registrations (No. 4,192,925 and No. 4,313,981). The purpose of Field Survey II was to determine whether relevant consumers are likely to mistakenly believe that TOD's S.p.A. or TOD'S is the source, the sponsor of, or affiliated with the Class 9 goods with the TOMS name.

Field Survey I and Field Survey II are "Eveready"-style surveys, designed in accordance with the methods and format for likelihood-of-confusion surveys endorsed in the seminal case of

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- 1 Field Research is performing this study on a time and materials basis. Because work in connection with this project is ongoing, I do not yet know the total project costs. The hourly rate that Field Research is charging for my time on this project in 2015 is \$650. Field Research's compensation is not dependent on the outcome of this dispute.
  - 2 The Field Surveys measured the potential for forward confusion, that is, the likelihood that relevant consumers will be confused as to the source, the sponsor of, or the affiliation of the Class 18 and Class 9 goods with the TOMS name at the point of purchase.
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*Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 385-388 (7th Cir. 1976) and repeatedly reaffirmed by courts and the U.S. Trademark Trial and Appeal Board (the "Board").<sup>3</sup>

### **A. Summary of Methodology**

Under the direction and supervision of Field Research, the GfK Group ("GfK") collected the data for the Field Surveys using its online panel, which consists of over 55,000 randomly recruited persons age 18 and older in the United States. Unlike most other online panels, GfK's KnowledgePanel does not consist of volunteers. Instead, GfK recruits members of the panel by using a statistically valid sampling method with a published sample frame of residential addresses that covers approximately 97% of U.S. households, including persons living in cell phone-only households. When recruited, GfK provides persons in sampled non-Internet households with a Windows-based laptop computer or another Web-enabled computer and/or free Internet service so they also may participate as online panel members.

Based on Field Research's instruction, GfK randomly selected two nationwide samples of adults age 18 and older from its online panel who were representative of all adults in the U.S. demographically (one for Field Survey I and one for Field Survey II). The randomly-selected adults were sent an initial email request, and two email reminders requesting their participation in either Field Survey I or Field Survey II. Over half of the randomly-selected adults responded to the email requests and were screened for eligibility.

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3 See *Miles Labs. v. Naturally Vitamin Supplements, Inc.*, Opp. No. 62820, 1 U.S.P.Q.2d 1445, 1455-62 (T.T.A.B. 1986). Since *Miles Labs.*, the Eveready format has become the most utilized and accepted survey format for assessing likelihood-of-confusion in Board proceedings. Moreover, in its Notice of Opposition and Petition for Cancellation, TOD's S.p.A. asserted that the TOD'S mark is "distinctive and famous," and the Board has criticized likelihood-of-confusion surveys that have not followed the Eveready format when an opposer has characterized its mark as "famous." See *Clear Choice Holdings LLC v. Implant Direct Int'l*, Opp. No. 91190485, 2013 WL 5402082, at \*10 (T.T.A.B. Aug. 26, 2013). Because TOMS and TOD'S goods frequently are not sold in the same retail locations, and even when they are sold in the same retail locations they usually are not displayed side-by-side or in close proximity, a Squirt-style format was inappropriate.

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### Eligibility Criteria

**Field Survey I** respondents were asked questions to determine whether they were a potential buyer of the Class 18 goods in TOMS Application Serial No. 86/004,044. To be eligible for Field Survey I, an adult had to indicate that he/she would buy one or more of the following items during the next 12 months: (a) a backpack, gym bag, or shopping bag; (b) a handbag, clutch, or purse; (c) a jewelry bag or cosmetic case; (d) a pet collar or leash; (e) a suitcase, piece of luggage or luggage tag; or (f) a wallet, credit card holder, or key case.<sup>4</sup>

**Field Survey II** respondents were asked questions to determine whether they were a potential buyer of the Class 9 goods in two of the TOMS trademark registrations (No. 4,192,925 and No. 4,313,981). To be eligible for Field Survey II, an adult had to indicate that he/she would buy one or more of the following items during the next 12 months: (a) sunglasses or sunglass frames; (b) eyeglasses or eyeglass frames; or (c) a case for sunglasses or eyeglasses.

### Survey Stimuli

**Field Survey I** respondents were asked to look at a box (pictured below) with the name TOMS printed in block letters above the list of Class 18 goods identified in TOMS Application Serial No. 86/004,044.

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4 At the beginning of the Field Surveys, respondents were asked for their age and gender. To be eligible, a respondent had to be age 18 and older and their gender and age had to be consistent with the information in GfK's KnowledgePanel database. Respondents also had to agree to answer the survey questions on their own (without help or referring to reference materials or the Internet). Because they might have special knowledge, persons who lived in a household in which someone worked for a leather goods company, a shoe company, or an advertising or marketing research firm were not eligible to participate in Field Survey I. For the same reason, persons who lived in a household in which someone worked for an eyewear company, a shoe company, or an advertising or marketing research firm were not eligible to participate in Field Survey II.

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# TOMS

- GOODS MADE OF LEATHER OR IMITATIONS OF LEATHER, NAMELY, CARD WALLETS, CLUTCH BAGS, CLUTCH PURSES, COSMETIC BAGS SOLD EMPTY, COSMETIC CASES SOLD EMPTY, KEY BAGS, KEY CASES, KEY WALLETS, AND LUGGAGE;
- BAGS, NAMELY, ALL-PURPOSE CARRYING BAGS, ALL-PURPOSE ATHLETIC BAGS, AND BACKPACKS; TRUNKS; VALISES; SUITCASES; TOTE BAGS; TRAVELLING BAGS; GARMENT BAGS FOR TRAVEL; RUCKSACKS; SATCHELS; HOLDALLS; HANDBAGS; SHOULDER BAGS; CANVAS SHOPPING BAGS; WHEELED SHOPPING BAGS AND PURSES;
- JEWELRY POUCHES; WALLETS; CREDIT CARD HOLDERS OF LEATHER AND IMITATIONS OF LEATHER; POCHETTES;
- LUGGAGE LABEL HOLDERS AND TAGS;
- COLLARS FOR PETS; AND LEASHES FOR ANIMALS.

**Field Survey II** respondents were asked to look at a box (pictured below) with the name TOMS printed in block letters above the list of Class 9 goods identified in two of the TOMS trademark registrations (No. 4,192,925 and No. 4,313, 981).

# TOMS

EYEWEAR, NAMELY, SUNGLASSES, EYEGLASSES AND  
OPHTHALMIC FRAMES AND CASES

## Survey Questions

The Field Surveys then posed four basic sets of questions.<sup>5</sup> The first set of questions concerned the likelihood of "source confusion." Field Survey respondents were asked who or

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5 In its Notice of Opposition, TOD's S.p.A. alleged that "Applicant's Mark so resembles Opposer's TOD'S mark as to be likely, when used in connection with the applied for goods, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant's goods have their origin with Opposer and/or that such goods are approved, endorsed, or sponsored by or associated in some way with Opposer." In its Petition for Cancellation, TOD's S.p.A. alleged the same types of potential confusion. The four sets of questions posed in the Field Surveys addressed each of the types of confusion alleged by TOD's S.p.A. in its Notice of Opposition and Petition for Cancellation. The first two sets of questions in the Field Surveys (the "source confusion" and "anonymous source confusion" questions) measured the potential for confusion as to the origin of the goods with the TOMS name. The third set of questions (the "sponsorship confusion" questions) measured whether relevant consumers are likely to mistakenly believe the goods with the TOMS name were "approved, endorsed, or sponsored by" TOD's S.p.A. or TOD'S, and the fourth set of questions (the "affiliation confusion" questions) measured whether relevant consumers are likely to mistakenly believe the goods with the TOMS name are "associated in some way" with TOD's S.p.A. or TOD'S.

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what company they thought makes or puts out the products with the name they were shown.<sup>6,7</sup> The second set of questions measured the potential for "anonymous source confusion." Field Survey respondents were asked whether the makers of the products with the name they were shown make or put out products under another brand name, and if so, what other brand names they use on their products.<sup>8</sup> The third set of questions assessed the likelihood of "sponsorship confusion." Survey respondents were asked whether the products with the name they were shown were made or put out with the authorization or approval of another company, and if so, what other company or companies gave their authorization or approval for the products with this name to be made or put out. The fourth set of questions assessed the potential for "affiliation confusion." Survey respondents were asked whether the makers of the products with the name they were shown have a business affiliation or business connection with another company, and if

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- 6 Before the first set of confusion questions was posed, the Field Survey questionnaires advised respondents that we were only interested in their opinions and beliefs and instructed the respondents to indicate if they did not have an opinion or belief.
- 7 The exact wording of the questions is included in Appendix D (for Field Survey I) and in Appendix E (for Field Survey II). The Field Survey I interviews were conducted in two phases, and the questions in Field Survey I either referred to "*these products*" or "*the products with this name*." For example, for approximately half of the Field Survey I respondents the source confusion question was worded, as follows: "Who or what company do you think makes or puts out *these products*?" For the other half of Field Survey I respondents the source confusion question was worded, as follows: "Who or what company do you think makes or puts out *the products with this name*?" For Field Survey II, the questionnaire also referred to "*the products with this name*." The wording for the first phase of the Field Survey I questions was based on the Eveready survey credited by the Board in *Miles Labs. v. Naturally Vitamin Supplements, Inc.*, Opp. No. 62820, 1 U.S.P.Q.2d 1445, 1455-62 (T.T.A.B. 1986). For example, the *Miles Labs.* survey posed the following question to measure the potential for source confusion: "Who do you think puts out this product?" The wording for the second phase of the Field Survey I questions and the wording of the Field Survey II questions conforms to the wording of the questions in the Eveready survey recently credited by the Board in *Facebook, Inc. v. Think Computer Corp.*, Opp. No. 91198355, 2013 WL 4397052, at \*14 (T.T.A.B. July 23, 2013). For example, the *Facebook* survey posed the following question to measure the potential for source confusion: "Who, or what company, do you believe is offering these services with this name?" In other words, the wording of the questions in both phases of Field Survey I and in Field Survey II has been approved by the Board. The results for the two phases of the Field Survey I questionnaire support the same conclusion and for this reason, they were combined in this report. However, for comparison purposes, the results are shown separately for each phase in the underlying data tables in Appendix R.
- 8 The first two sets of questions in the Field Survey were based on the surveys credited in *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 385-88 (7th Cir. 1976).
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so, with what other company or companies there is a business affiliation or business connection.<sup>9</sup> Survey respondents also were asked the reasons for their answers.

### Data Collection

Field Survey I was administered between October 8 and October 30, 2015, and Field Survey II was administered between October 15 and October 30, 2015. The Field Surveys were double-blind (neither the persons responsible for administering the surveys nor the survey respondents were told the names of the sponsors of the surveys or that the surveys were being conducted in connection with a trademark dispute).

The Field Surveys were performed according to accepted survey standards and in conformity with the guidelines discussed in the Federal Manual for Complex Litigation, 4<sup>th</sup> Ed. §11.493 (2004).<sup>10</sup> In all, 280 adults qualified for Field Survey I, and 321 adults qualified for Field Survey II. The maximum sampling error at the 95% confidence level is  $\pm 6$  percentage points for analyses based on the overall sample of 280 Field Survey I respondents, and it is  $\pm 5$  percentage points for analyses based on the overall sample of 321 Field Survey II respondents.<sup>11</sup>

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9 Modern Eveready surveys often include questions similar to the third and fourth sets of questions in the Field Surveys. See E. Deborah Jay, *He Who Steals My Good Name: Likelihood of Confusion Surveys in TTAB Proceedings*, 104 TMR 1141, 1156-1157 (2014).

10 The survey populations were properly defined as potential buyers of Class 18 goods (Field Survey I) or Class 9 goods (Field Survey II), and the samples for the Field Surveys were chosen to be representative of these populations. The questions asked in the Field Surveys are clear and not leading. The data gathered for the Field Surveys were accurately reported, and the data were analyzed in accordance with accepted statistical principles. The Field Surveys were conducted, under my direction, by survey research professionals following proper survey procedures, and the entire process was conducted so as to ensure objectivity.

11 Percentages at either end of the sampling distribution (percentages around 10% or 90%) have a slightly smaller margin-of-error. Because sampling error is inversely correlated with sample size, analyses based on subgroups will have a larger margin-of-error than those based on the overall sample. While there are other potential sources of error in surveys besides sampling error, the overall design and execution of the Field Surveys minimized the potential for other sources of error.

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## B. Summary of Findings

As described in more detail in this report, the Field Surveys found:

- None of the 280 Field Survey I respondents said that TOD's S.p.A or TOD'S is the source, the sponsor of, or affiliated with the Class 18 goods with the TOMS name.<sup>12</sup>
- None of the 321 Field Survey II respondents said that TOD's S.p.A. or TOD'S is the source, the sponsor of, or affiliated with the Class 9 goods with the TOMS name.<sup>13</sup>

Based on the overall design and execution of the Field Surveys, they provide representative and reliable information regarding potential buyers of Class 18 and Class 9 goods. In my opinion, the Field Surveys strongly support the conclusion that relevant consumers are not likely to mistakenly believe that TOD's S.p.A. or TOD'S is the source, the sponsor of, or affiliated with the Class 18 or Class 9 goods with the TOMS name (*i.e.*, there is not a likelihood of forward confusion).

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12 If Field Survey I respondents had mentioned TOD's S.p.A. or TOD'S ("TOD'S") in connection with the Class 18 goods with the TOMS name, Field Research would have conducted a second set of interviews for Field Survey I concerning another stimulus with a control group to determine whether mentions of TOD'S were due to legally irrelevant factors, such as guessing. However, none of the Field Survey I respondents mentioned TOD'S in connection with the Class 18 goods with the TOMS name. Therefore, it was not necessary to determine whether mentions of TOD'S were due to legally relevant factors, and a control group was unwarranted.

If a control group had been used for Field Survey I, control group respondents would have been shown the list of Class 18 goods with a name other than TOMS. After viewing the control stimulus, control group respondents would have been asked the same questions as respondents shown the stimulus with the TOMS name (the test group). The percentage of respondents in the control group who mentioned TOD'S in connection with the control stimulus would have been subtracted from the percentage in the test group who mentioned TOD'S in connection with the Class 18 goods with the TOMS name. In other words, the results for the control group could only have reduced the level of confusion expressed by respondents shown the list of Class 18 goods with the TOMS name, had there been any.

13 If Field Survey II respondents had mentioned TOD's S.p.A. or TOD'S ("TOD'S") in connection with the Class 9 goods with the TOMS name, Field Research would have conducted a second set of interviews for Field Survey II concerning another stimulus with a control group to determine whether mentions of TOD'S were due to legally irrelevant factors, such as guessing. However, none of the Field Survey II respondents mentioned TOD'S in connection with the Class 9 goods with the TOMS name. Therefore, it was not necessary to determine whether mentions of TOD'S were due to legally relevant factors, and a control group was unwarranted.

If a control group had been used for Field Survey II, control group respondents would have been shown the list of Class 9 goods with a name other than TOMS. After viewing the control stimulus, control group respondents would have been asked the same questions as respondents shown the stimulus with the TOMS name (the test group). The percentage of respondents in the control group who mentioned TOD'S in connection with the control stimulus would have been subtracted from the percentage in the test group who mentioned TOD'S in connection with the Class 9 goods with the TOMS name. In other words, the results for the control group could only have reduced the level of confusion expressed by respondents shown the list of Class 9 goods with the TOMS name, had there been any.

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The findings of the Field Surveys and my conclusions are described in more detail in the remainder of this report, which is based on information that I have been provided and analyses that I have performed thus far.<sup>14</sup> I understand that I may be provided with additional information or asked to perform further analyses. If so, this report may be amended or revised.

In connection with my anticipated trial testimony in this action I may use as exhibits various documents produced in this litigation that refer to or relate to the matters discussed in this report. In addition, I may create or assist in the creation of certain demonstrative exhibits to assist me in testimony. I have not yet selected or created such exhibits.

## **II. Credentials**

I am President and CEO of Field Research Corporation, one of the oldest and most respected marketing and public opinion research firms in the United States.<sup>15</sup> I have more than 40 years of experience conducting large-scale surveys of all types (*e.g.*, mail, Internet, telephone and in-person), including surveys for public agencies, nonprofit organizations, private companies and law firms.

During my career I have designed and directed well over 700 surveys and more than 300 surveys in intellectual property disputes. I have testified on behalf of plaintiffs and defendants in numerous state and federal courts and other tribunals (such as the U.S. Patent and Trademark Office and the U.S. International Trade Commission), and routinely have been qualified as an

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14 Screenshots showing how the questionnaire appeared on the Internet for Field Survey I and Field Survey II are in Appendix D and Appendix E, respectively. Detailed descriptions of the design and execution of Field Survey I and Field Survey II are in Appendix F and Appendix G, respectively. Background information on GfK's KnowledgePanel is in Appendix H, and copies of the email invitation and reminder emails used for the Field Surveys are in Appendix I. (The email invitations were the same for both surveys.)

15 Founded in 1945 by Mervin Field, Field Research currently conducts thousands of interviews each year with representative samples of the public, consumers, employees, corporate executives, and other populations. Field Research has conducted the nationally-quoted *Field Poll* since 1947, and has tracked voter preferences in all major statewide elections in California since 1948. Since 1948, the average deviation between *The Field Poll's* final pre-election poll in California and the actual percentage vote in California for the winning candidate in elections for President, Governor and U.S. Senate has been approximately two percentage points. *The Field Poll* is well-known throughout California for the surveys it regularly takes and publishes on issues of public importance.



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expert in survey methodology by courts.<sup>16</sup> I also have lectured on litigation surveys and survey methods before bar associations, trade associations, and business and law schools and been on the faculties of numerous continuing legal education programs.

I am past chair of the Council of American Survey Research Organizations (CASRO), a not-for-profit trade association representing over 300 survey research companies engaged in professional research, and I chaired the Standards Committee for the American Association for Public Opinion Research, a professional society of over 2,000 individuals engaged in opinion research, market research, and social research. I have served on the editorial board of several journals, and my publications include articles in the *Trademark Reporter*, the *Encyclopedia of Survey Research Methods*, *Polling America: An Encyclopedia of Public Opinion*, and *Trademark and Deceptive Advertising Surveys: Law, Science and Design*.<sup>17</sup>

I hold a bachelor's degree in psychology and political science from the University of California at Los Angeles (*magna cum laude*) and a master's degree and doctorate in political science from the University of California at Berkeley. Before joining Field Research in 1991, I was a program director at SRI International (formerly Stanford Research Institute). I also was a manager with KPMG Peat Marwick in San Francisco, and a research associate at the Survey Research Center at the University of California at Berkeley.

### **III. Findings**

This section describes the findings from the Field Surveys. The verbatim responses to the open-ended questions are included in Appendices J through M for Field Survey I and in Appendices N through Q for Field Survey II. The underlying data tables for the analyses in this report are included in Appendix R for Field Survey I and in Appendix T for Field Survey II.

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<sup>16</sup> Appendix A includes a list of cases in which I have testified in deposition and/or at trial during the past four years.

<sup>17</sup> Appendix B includes my resume and a list of publications and presentations I have authored (or coauthored) during the past 10 years. Appendix C provides a list of documents I considered in forming my opinions.

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## **A. Who Makes or Puts Out the Class 18 and Class 9 Goods with the TOMS Name**

The first question in the Field Surveys concerned the source of the Class 18 goods (Field Survey I) and the Class 9 goods (Field Survey II) with the TOMS name. Field Survey respondents were asked who or what company makes or puts out the products with the name they were shown. Table 1 summarizes the responses to this question.<sup>18</sup> As shown in Table 1, none of the Field Survey respondents said that TOD's S.p.A. or TOD'S is the source of the Class 18 or Class 9 goods with the TOMS name.

<b>Table 1</b> <b>Who Makes or Puts Out the Class 18 and Class 9 Goods with the TOMS Name*</b>		
	<b>Field Survey I</b> <b>(Class 18)</b> <i>(n = 280)</i>	<b>Field Survey II</b> <b>(Class 9)</b> <i>(n = 321)</i>
TOD's S.p.A. or TOD'S	0%	0%
TOMS	35	33
Tom's	2	3
Tom's of Maine (Tom's natural products or Tom's, the toothpaste company)	<1	2
Other "Tom" names (Thoms, Tommy Hilfiger)	1	3
Misc. other brand names	11	3
Misc. other responses	5	5
Don't know/No opinion	47	55

\* Based on Question C1. Note: some survey respondents gave more than one answer in response to this question.

## **B. What Other Brand Names Are Used by the Makers of the Class 18 and Class 9 Goods with the TOMS Name**

The second set of questions in the Field Surveys measured the potential for "anonymous source confusion." Field Survey respondents were asked whether they thought the makers of the Class 18 goods (Field Survey I) or Class 9 goods (Field Survey II) with the name they were shown also make or put out products under another brand name, and if so, what other brand

---

<sup>18</sup> The verbatim responses to this question and the reasons survey respondents gave for their answers are in Appendix J for Field Survey I and Appendix N for Field Survey II.

names they use on the other products they make or put out. Table 2 summarizes the responses to these questions.<sup>19</sup> As shown in Table 2, none of the Field Survey respondents said that the makers of the Class 18 or Class 9 goods with the TOMS name also use the TOD's S.p.A. or TOD'S names on their products.

<b>Table 2</b> <b>What Other Brand Names Are Used by The Makers</b> <b>Of the Class 18 and Class 9 Products with the TOMS Name*</b>		
	<b>Field Survey I</b> <b>(Class 18)</b> <i>(n = 280)</i>	<b>Field Survey II</b> <b>(Class 9)</b> <i>(n = 321)</i>
TOD's S.p.A. or TOD'S	0%	0%
TOMS	<1	1
Tom's	0	<1
Tom's of Maine (Tom's natural products or Tom's, the toothpaste company)	<1	<1
Other "Tom" names (Thoms, Tommy Hilfiger)	<1	<1
Misc. other brand names	6	<1
Misc. other responses	4	3
Don't know/No opinion	31	22
<i>Not applicable – Did <u>not</u> say the makers of the Class 18 or Class 9 goods with the TOMS name use another brand name on their products</i>	59	74

\* Based on Questions D1 and D2. Note: some survey respondents gave more than one answer in response to Question D2.

### **C. Who Gave Their Authorization or Approval for the Class 18 and Class 9 Products with the TOMS Name To Be Made or Put Out**

The third set of questions in the Field Surveys assessed the likelihood of "sponsorship confusion." Field Survey respondents were asked whether the Class 18 goods (Field Survey I) and the Class 9 goods (Field Survey II) with the name they were shown were made or put out with the authorization or approval of another company, and if so, what other company or companies gave their authorization or approval for these products to be made or put out. Table 3

<sup>19</sup> The verbatim responses to these questions and the reasons survey respondents gave for their answers are in Appendix K for Field Survey I and Appendix O for Field Survey II.

summarizes the responses to these questions.<sup>20</sup> As shown in Table 3, none of the Field Survey respondents said that TOD's S.p.A. or TOD'S gave its authorization or approval for the Class 18 or Class 9 goods with the TOMS name to be made or put out.

<b>Table 3</b> <b>Who Gave Their Authorization or Approval for the Class 18</b> <b>And Class 9 Goods with the TOMS Name To Be Made or Put Out*</b>		
	<b>Field Survey I</b> <b>(Class 18)</b> <i>(n = 280)</i>	<b>Field Survey II</b> <b>(Class 9)</b> <i>(n = 321)</i>
TOD's S.p.A. or TOD'S	0%	0%
TOMS	<1	1
Tom's	0	0
Tom's of Maine (Tom's natural products or Tom's, the toothpaste company)	0	0
Other "Tom" names (Thoms, Tommy Hilfiger)	0	<1
Misc. other brand names	1	1
Misc. other responses	2	3
Don't know/No opinion	25	17
<i>Not applicable – Did <u>not</u> say the Class 18 or Class 9 goods were made or put out with the authorization or approval of another company</i>	71	79

\* Based on Questions E1 and E2. Note: some survey respondents gave more than one answer in response to Question E2.

#### **D. Who Has a Business Affiliation or Business Connection with the Makers of the Class 18 and Class 9 Goods with the TOMS Name**

The fourth set of questions in the Field Surveys assessed the potential for "affiliation confusion." Field Survey respondents were asked whether the makers of the Class 18 goods (Field Survey I) or the Class 9 goods (Field Survey II) with the name they were shown had a business affiliation or business connection with another company, and if so, with what other company or companies there was a business affiliation or business connection. Table 4

20 The verbatim responses to these questions and the reasons respondents gave for their answers are in Appendix L for Field Survey I and Appendix P for Field Survey II.

summarizes the responses to these questions.<sup>21</sup> As shown in Table 4, none of the Field Survey respondents said that TOD's S.p.A. or TOD'S has a business affiliation or business connection with the makers of the Class 18 or Class 9 goods with the TOMS name.

<b>Table 4</b> <b>Who Has a Business Affiliation or Business Connection with the Makers of the Class 18 and Class 9 Goods with the TOMS Name*</b>		
	<b>Field Survey I</b> <b>(Class 18)</b> <i>(n = 280)</i>	<b>Field Survey II</b> <b>(Class 9)</b> <i>(n = 321)</i>
TOD's S.p.A. or TOD'S	0%	0%
TOMS	0	4
Tom's	0	0
Tom's of Maine (Tom's natural products or Tom's, the toothpaste company)	0	0
Other "Tom" names (Thoms, Tommy Hilfiger)	<1	0
Misc. other brands	3	1
Misc. other responses	6	4
Don't know/No opinion	33	21
<i>Not applicable – Did <u>not</u> say the makers of the Class 18 or Class 9 goods have a business affiliation or business connection with another company</i>	59	70

\* Based on Questions F1 and F2. Note: some survey respondents gave more than one answer in response to Question F2.

## E. Overall Findings

Table 5 describes the overall percentage of survey respondents who mentioned TOD's S.p.A. or TOD'S in connection with the Class 18 or Class 9 goods with the TOMS name. As shown in Table 5, none of the Field Survey respondents said that TOD's S.p.A. or TOD'S is the source, the sponsor of, or affiliated with the Class 18 or Class 9 goods with the TOMS name.

21 The verbatim responses to these questions and the reasons survey respondents gave for their answers are in Appendix M for Field Survey I and Appendix Q for Field Survey II.

<b>Table 5</b> <b>Overall Percentage Who Mentioned TOD's S.p.A. or TOD'S in Connection with the Class 18 and Class 9 Goods with the TOMS Name</b>		
	<b>Field Survey I</b> <b>(Class 18)</b> <i>(n = 280)</i>	<b>Field Survey II</b> <b>(Class 9)</b> <i>(n = 321)</i>
Mentioned TOD's S.p.A. or TOD'S	0%	0%
Did <u>not</u> mention TOD's S.p.A. or TOD'S	100	100

\* Based on Questions C1, D2, E2 and F2.

#### IV. Conclusions

The Field Survey was performed according to accepted survey standards and in conformity with the guidelines discussed in the Federal Manual for Complex Litigation, 4<sup>th</sup> Ed. §11.493 (2004). Based on the overall design and execution of the Field Surveys, they provide representative and reliable information regarding potential buyers of Class 18 and Class 9 goods. In my opinion, the Field Surveys strongly support the conclusion that relevant consumers are not likely to mistakenly believe that TOD's S.p.A. or TOD'S is the source, the sponsor of, or affiliated with the Class 18 and Class 9 goods with the TOMS name (*i.e.*, there is not a likelihood of forward confusion).

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Executed this 9th day of November, 2015 at San Francisco, California.

---

E. Deborah Jay, Ph.D.

# **EXHIBIT 25**

**CONTAINS CONFIDENTIAL  
INFORMATION**

**FILED UNDER SEAL**

# **EXHIBIT 26**

**CONTAINS CONFIDENTIAL  
INFORMATION**

**FILED UNDER SEAL**



# **EXHIBIT 27**

---

**From:** Mandel, Richard <RSM@cll.com>  
**Sent:** Thursday, December 10, 2015 6:17 PM  
**To:** Ederer, Louis S.  
**Cc:** Emert, Aryn M.  
**Subject:** Tod's/Toms  
**Attachments:** TOD 16641- TOD 16642.pdf; TOD 16643.pdf; TOD 16644.pdf; TOD 16644.xlsx; 12102015175435.pdf; REDLINE \_ NOO \_ TOMS - REDLINE \_ NOO \_ TOMS.pdf; REDLINE \_ PETITION TO CANCEL \_ TOMS - REDLINE \_ PETITION TO CANCEL \_ TOM....pdf; Amended Combined NOO and Petition to Cancel - TOMS.DOCX

Lou,

Enclosed please find our supplemental production of documents TOD 16641-16644. TOD 16644 contains the information you requested during depositions regarding Marcolin's distribution of eyewear, while the other documents contain updated sales information.

I am also enclosing supplemental initial disclosures, which add Stefano Sincini and Andrea Varsavi as additional knowledgeable individuals under Fed. R. Civ. P. 26(a)(1)(A). They were both obviously disclosed in interrogatory responses and deposition testimony, so the supplementation is not really required under the rules. See Fed. R. Civ. P. 26(e)(1)(A) (only requiring supplementation when the additional information has not otherwise been made known during the discovery process). Nevertheless, in an abundance of caution, we have supplemented our disclosures to avoid any potential issues.

Finally, we enclose a proposed amended combined notice of opposition/cancellation petition for which we seek your consent to file. The amendment would drop the dilution claim we have asserted and add a claim based on lack of a bona fide intent to use with respect to certain Class 18 products based on the recent deposition testimony of Mycoskie's designated 30(b)(6) witness. We have enclosed a clean copy as well as redlines showing changes from the previously filed cancellation petition and notice of opposition, which have now also been combined into a single pleading in light of the consolidation of both proceedings. We do not seek any additional discovery as a result of the amendment and are prepared to proceed on the current schedule, as it may be modified by the Board to allow for expert discovery – a topic we can address in more detail after the rebuttal expert period expires.

Let us know your position on the amendment so we can see whether it is necessary to file a motion seeking leave to amend.

**Richard S. Mandel, Esq.**  
Cowan, Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, New York 10036-6799  
t: (212) 790-9291 | f: (212) 575-0671  
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# **EXHIBIT 28**

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**From:** Ederer, Louis S.  
**Sent:** Monday, December 14, 2015 6:17 PM  
**To:** 'Mandel, Richard'  
**Cc:** 'Emert, Aryn M.'; Salzmänn, Matthew T.; Wolverton, Benjamin  
**Subject:** RE: Tod's/Toms  
**Attachments:** Notice of Deposition of Stefano Sincini.pdf

Richard:

We are prepared to consent to the amendment under the following conditions:

- 1) That Mycoskie be given a total of 30 days within which to answer the amended pleading, amend its initial disclosures if it sees fit, and produce any additional documents relating to the issues raised by the amendment.
- 2) That Mr. Sincini be produced in the New York for an oral deposition within 30 days. A notice of deposition is attached hereto. Given the evidence elicited at the Castiglioni deposition as to Sincini's role at Deva Inc., as well as the fact that you waited until three business days before the close of fact discovery to add him to your initial disclosures, you have no basis whatsoever for refusing to produce him.
- 3) That fact discovery be extended by 30 days for the sole and exclusive purpose of allowing the foregoing to proceed, and for no other purpose.

To be clear, if you are not prepared to agree to all of the foregoing, Mycoskie does not consent to the amendment of the pleadings, since you have waited a year and a half to introduce a completely new issue into the proceedings, having nothing to do with the likelihood of confusion dispute between the parties.

If you wish to discuss this matter, please contact me.

Sincerely,

---

Louis S. Ederer  
Partner  
**Arnold & Porter LLP**  
399 Park Avenue  
New York, NY 10022-4690  
Office: +1 212.715.1102  
[louis.ederer@aporter.com](mailto:louis.ederer@aporter.com)  
[www.arnoldporter.com](http://www.arnoldporter.com)

---

**From:** Ederer, Louis S.  
**Sent:** Friday, December 11, 2015 4:01 PM  
**To:** Mandel, Richard  
**Cc:** Emert, Aryn M.; Salzmänn, Matthew T.; Wolverton, Benjamin  
**Subject:** RE: Tod's/Toms

Richard:

I will be discussing the matter with my client, and will get back to you by Monday.

Thanks,

---

Louis S. Ederer  
Partner  
**Arnold & Porter LLP**  
399 Park Avenue  
New York, NY 10022-4690  
Office: +1 212.715.1102  
[louis.ederer@aporter.com](mailto:louis.ederer@aporter.com)  
[www.arnoldporter.com](http://www.arnoldporter.com)

---

**From:** Mandel, Richard [<mailto:RSM@cll.com>]  
**Sent:** Thursday, December 10, 2015 6:17 PM  
**To:** Ederer, Louis S.  
**Cc:** Emert, Aryn M.  
**Subject:** Tod's/Toms

Lou,

Enclosed please find our supplemental production of documents TOD 16641-16644. TOD 16644 contains the information you requested during depositions regarding Marcolin's distribution of eyewear, while the other documents contain updated sales information.

I am also enclosing supplemental initial disclosures, which add Stefano Sincini and Andrea Varsavi as additional knowledgeable individuals under Fed. R. Civ. P. 26(a)(1)(A). They were both obviously disclosed in interrogatory responses and deposition testimony, so the supplementation is not really required under the rules. See Fed. R. Civ. P. 26(e)(1)(A) (only requiring supplementation when the additional information has not otherwise been made known during the discovery process). Nevertheless, in an abundance of caution, we have supplemented our disclosures to avoid any potential issues.

Finally, we enclose a proposed amended combined notice of opposition/cancellation petition for which we seek your consent to file. The amendment would drop the dilution claim we have asserted and add a claim based on lack of a bona fide intent to use with respect to certain Class 18 products based on the recent deposition testimony of Mycoskie's designated 30(b)(6) witness. We have enclosed a clean copy as well as redlines showing changes from the previously filed cancellation petition and notice of opposition, which have now also been combined into a single pleading in light of the consolidation of both proceedings. We do not seek any additional discovery as a result of the amendment and are prepared to proceed on the current schedule, as it may be modified by the Board to allow for expert discovery – a topic we can address in more detail after the rebuttal expert period expires.

Let us know your position on the amendment so we can see whether it is necessary to file a motion seeking leave to amend.

**Richard S. Mandel, Esq.**  
Cowan, Liebowitz & Latman, P.C.  
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# **EXHIBIT 29**



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**From:** Mandel, Richard <RSM@cll.com>  
**Sent:** Tuesday, December 15, 2015 2:40 PM  
**To:** Ederer, Louis S.  
**Cc:** Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin  
**Subject:** RE: Tod's/Toms

Lou,

We think you are connecting two separate issues that bear no relation to each other. The new claim, which is based on information that is solely within Toms' knowledge, has nothing to do with Mr. Sincini or any other Tod's witness and does not require any additional discovery from Tod's. Mr. Sincini would not be offering any testimony in the case that bears on the new claim we seek to add. Moreover, we do not accept that we have delayed in asserting this claim, as it was only as a result of the recently concluded deposition of Toms' designated 30(b)(6) witness that we had sufficient grounds to assert such a claim. Under these circumstances, and given the liberal standards of Rule 15, we feel confident that the Board will permit the amendment, whether or not we have your consent. Forcing us to file a motion will only serve to delay matters further and we would ask you to reconsider your position on this issue. However, if you do not consent, we will file a motion seeking leave to amend.

As far as Mr. Sincini is concerned, the issue comes down to the same one we have previously discussed with respect to Tod's' designated 30(b)(6) witness, Mr. Varsavi. Mr. Sincini does not reside in the United States. Nor is he scheduled to be in the United States during the next thirty days. Accordingly, we do not believe you are entitled to an oral deposition of him in New York, and you would be required to proceed by way of a deposition upon written questions. We assumed based on your decision not to take Mr. Varsavi's deposition on written questions that you would not be interested in pursuing such a deposition for Mr. Sincini either. After all, he was repeatedly identified in Mr. Castiglioni's deposition as having knowledge regarding certain information on the enforcement decisions Tod's made, and you did not indicate any interest in pursuing his deposition following Mr. Castiglioni's testimony. He also was identified in interrogatory responses concerning the decision to file the notice of opposition. In view of his clear disclosure through other discovery, we did not even need to supplement our initial disclosures, but did so anyway in order to avoid any misunderstanding. We have no objection to extending the discovery period if you wish to take Mr. Sincini's deposition on written questions, but do not see any reason why the inclusion of his name in our supplemental initial disclosures should now somehow entitle you to an oral deposition. The circumstances are the same as they have always been – he does not reside in the United States and thus we are not required to produce him for an oral discovery deposition.

If you are interested in taking Mr. Sincini's deposition on written questions, please let us know and as indicated we will adjust the discovery schedule as necessary to accommodate that request. Also, let us know if you insist on having us file a motion seeking leave to amend.

**Richard S. Mandel, Esq.**  
Cowan, Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, New York 10036-6799  
t: (212) 790-9291 | f: (212) 575-0671  
[www.cll.com](http://www.cll.com) | [rsm@cll.com](mailto:rsm@cll.com) | [My Profile](#)



---

**From:** Ederer, Louis S. [mailto:Louis.Ederer@APORTER.COM]  
**Sent:** Monday, December 14, 2015 6:17 PM  
**To:** Mandel, Richard  
**Cc:** Emert, Aryn M.; Salzmman, Matthew T.; Wolverton, Benjamin  
**Subject:** RE: Tod's/Toms

Richard:

We are prepared to consent to the amendment under the following conditions:

- 1) That Mycoskie be given a total of 30 days within which to answer the amended pleading, amend its initial disclosures if it sees fit, and produce any additional documents relating to the issues raised by the amendment.
- 2) That Mr. Sincini be produced in the New York for an oral deposition within 30 days. A notice of deposition is attached hereto. Given the evidence elicited at the Castiglioni deposition as to Sincini's role at Deva Inc., as well as the fact that you waited until three business days before the close of fact discovery to add him to your initial disclosures, you have no basis whatsoever for refusing to produce him.
- 3) That fact discovery be extended by 30 days for the sole and exclusive purpose of allowing the foregoing to proceed, and for no other purpose.

To be clear, if you are not prepared to agree to all of the foregoing, Mycoskie does not consent to the amendment of the pleadings, since you have waited a year and a half to introduce a completely new issue into the proceedings, having nothing to do with the likelihood of confusion dispute between the parties.

If you wish to discuss this matter, please contact me.

Sincerely,

---

Louis S. Ederer  
Partner  
**Arnold & Porter LLP**  
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New York, NY 10022-4690  
Office: +1 212.715.1102  
[louis.ederer@aporter.com](mailto:louis.ederer@aporter.com)  
[www.arnoldporter.com](http://www.arnoldporter.com)

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**From:** Ederer, Louis S.  
**Sent:** Friday, December 11, 2015 4:01 PM  
**To:** Mandel, Richard  
**Cc:** Emert, Aryn M.; Salzmman, Matthew T.; Wolverton, Benjamin  
**Subject:** RE: Tod's/Toms

Richard:

I will be discussing the matter with my client, and will get back to you by Monday.

Thanks,

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Louis S. Ederer  
Partner  
**Arnold & Porter LLP**  
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New York, NY 10022-4690  
Office: +1 212.715.1102  
[louis.ederer@aporter.com](mailto:louis.ederer@aporter.com)  
[www.arnoldporter.com](http://www.arnoldporter.com)

---

**From:** Mandel, Richard [<mailto:RSM@cll.com>]  
**Sent:** Thursday, December 10, 2015 6:17 PM  
**To:** Ederer, Louis S.  
**Cc:** Emert, Aryn M.  
**Subject:** Tod's/Toms

Lou,

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I am also enclosing supplemental initial disclosures, which add Stefano Sincini and Andrea Varsavi as additional knowledgeable individuals under Fed. R. Civ. P. 26(a)(1)(A). They were both obviously disclosed in interrogatory responses and deposition testimony, so the supplementation is not really required under the rules. See Fed. R. Civ. P. 26(e)(1)(A) (only requiring supplementation when the additional information has not otherwise been made known during the discovery process). Nevertheless, in an abundance of caution, we have supplemented our disclosures to avoid any potential issues.

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Let us know your position on the amendment so we can see whether it is necessary to file a motion seeking leave to amend.

**Richard S. Mandel, Esq.**  
Cowan, Liebowitz & Latman, P.C.  
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New York, New York 10036-6799  
t: (212) 790-9291 | f: (212) 575-0671  
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# **EXHIBIT 30**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 86/004,044  
Filed: July 8, 2013  
For Mark: TOMS  
Published in the Official Gazette: April 29, 2014

In re Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344  
Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013  
For Mark: TOMS

-----  
Tod's S.p.A.,

Opposer,

Opposition No. 91218001

v.  
Mycoskie, LLC,

Applicant.

-----  
TOD'S S.P.A.,

Petitioner,

Cancellation No. 92061234

v.  
Mycoskie, LLC,  
Respondent.

-----

**EXPERT REPORT OF SARAH BUTLER**

# **EXPERT REPORT OF SARAH BUTLER**

In connection with

TOD'S S.P.A. *Petitioner* v. MYCOSKIE, LLC *Respondent*

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## I. QUALIFICATIONS

1. I am a Vice President at NERA Economic Consulting (“NERA”), where I participate in the Survey and Sampling, Intellectual Property, Product Liability, Antitrust, and Labor Practices. My business address is 4 Embarcadero Center, San Francisco, CA 94111. NERA is a firm providing expert statistical, survey, economic, and financial research analysis.

2. NERA is being compensated for my services in this matter at my standard rate of \$575 per hour. Members of the staff at NERA have worked at my direction to assist me in this engagement. No part of my compensation or NERA’s compensation depends on the outcome of this litigation. Throughout this report, I have used the terms “I” and “my” to refer to work performed by me and/or others under my direction. My current CV is attached as Exhibit A.

## II. DOCUMENTS REVIEWED

3. As part of my work, I reviewed TOD’s S.p.A.’s notice of opposition and cancellation petitions, as well as Mycoskie’s answers to such pleadings. I also reviewed the report submitted by E. Deborah Jay titled, “TOMS Survey Report”.<sup>1</sup> A list of the specific materials I reviewed can be found in Exhibit B.

## III. ASSIGNMENT AND SUMMARY OF OPINIONS

4. I was asked by counsel to review the survey and report submitted by Dr. E. Deborah Jay. I was also asked to conduct my own survey to evaluate the potential for

---

<sup>1</sup> *TOMS Survey Report: Report of E. Deborah Jay, PhD*, dated November 15, 2015.



consumer confusion between the marks TOD'S and TOMS. From my review of the Jay survey and my own work, I conclude the following:

- The Field Surveys as designed and conducted by Dr. Jay cannot be used to evaluate all possible forms of confusion relevant in this matter.
- The Field Survey results are limited to the potential confusion which would occur in populations who know TOD'S as a "famous" brand.
- The Field Surveys as designed may encourage respondents to simply read the name TOMS. A reflexive reading of just the name presented in the survey does not address the potential for respondents to associate TOMS with TOD'S.
- Moreover, the Field Survey results cannot be used to address confusion which may occur when the brand names are exposed to consumers in proximity. According to the Applicant/Respondent's own pleadings, both TOD'S and TOMS are "frequently being sold in the same retail locations."
- Finally, data from the Field Surveys demonstrate that the studies as designed are limited in scope. Open-ended answers indicate that many respondents simply read the large name (TOMS) shown when answering questions. Responses based on simply reading the brand do not reflect the actual potential for confusion which may occur.
- An alternative survey format can evaluate confusion which may occur when the brand names are seen in proximity.
- I designed and conducted a survey which demonstrates that a net 14 percent of consumers believe that TOMS is a brand from the same company, is associated with, or received authorization from the owner of the TOD'S brand.

5. The remainder of this report discusses both my general understanding of the background in this matter and my review of the Field Surveys, as well as describes in detail the methodology of and results for the survey I conducted.

## IV. BACKGROUND

6. I understand Tod's S.p.A ("Tod's") is a company located in Italy specializing in high quality leather goods.<sup>2</sup> Tod's owns a number of trademark registrations for goods in various categories, including goods in Class 18 and Class 9.<sup>3</sup>

7. On August 25, 2014, Tod's filed a notice of opposition against an application filed by Mycoskie, LLC ("Mycoskie") to register the TOMS mark for Class 18 goods.

Specifically, TOD's asserts:

Applicant's Mark so resembles Opposer's TOD'S mark as to be likely, when used in connection with the applied for goods, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant's goods have their origin with Opposer and/or that such goods are approved, endorsed or sponsored by Opposer or associated in some way with Opposer.<sup>4</sup>

8. On April 8, 2015 Tod's filed a petition to cancel registrations owned by TOMS.

Specifically, Tod's asserts:

Respondent's Mark so resembles Petitioner's TOD's mark as to be likely, when used in connection with the applied for goods and services, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Respondent's goods and services have their origin with Petitioner and/or that such goods and services are approved, endorsed or sponsored by Petitioner or associated in some way with Petitioner.<sup>5</sup>

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<sup>2</sup> <https://en.wikipedia.org/wiki/Tod's> , <http://www.todsgroup.com/> accessed December 14, 2015.

<sup>3</sup> *Consolidated Cancellation Petition* : In re Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344 Registered: Feb. 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013 for Mark: TOMS (hereafter "*Cancellation Petition*"). pp. 2-3.

<sup>4</sup> *Tod's S.p.A. v. Mycoskie, Notice of Opposition*: In re Application Serial No. 86/0104,044, Filed July 8, 2013, For Mark: TOMS, ¶7.

<sup>5</sup> *Cancellation Petition*, ¶10.

9. To address the concerns expressed by Tod's in its notice of opposition and cancellation petition, Mycoskie and TOMS Shoes, LLC commissioned Dr. E. Deborah Jay and Field Research to conduct a likelihood of confusion survey.

## V. THE FIELD SURVEYS

10. Dr. Jay conducted two online surveys of purchasers of Class 18 and Class 9 goods. In her report, Dr. Jay classifies her survey of purchasers of goods in Class 18 as "Field Survey I" and her study of purchasers of goods in Class 9 as "Field Survey II".<sup>6</sup> For both surveys, Dr. Jay used an Eveready format and tests forward confusion.<sup>7</sup>

11. Qualified respondents in Field Survey I were adults age 18 years and older who indicated that they intended to purchase any of the following items in the next twelve months: a backpack, gym bag, or shopping bag; a handbag, clutch or purse; a jewelry bag or cosmetic case; a pet collar or leash; a suitcase, piece of luggage, or luggage tag; a wallet, credit card holder, or key case. Qualified respondents in Field Survey II were adults 18 years or older who indicated that in the next twelve months they intended to purchase: sunglasses or sunglass frames; eyeglasses or eyeglass frames; or a case for sun or eyeglasses.<sup>8</sup>

12. After a series of qualifying questions, respondents in the Field Surveys were instructed to "Please look at the information in the box below. Take as much time as you like to look at this information before moving on to the survey questions".<sup>9</sup> Respondents in both surveys were shown the name TOMS in bold letters with a description of the category of goods

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<sup>6</sup> Jay Report, p. 3.

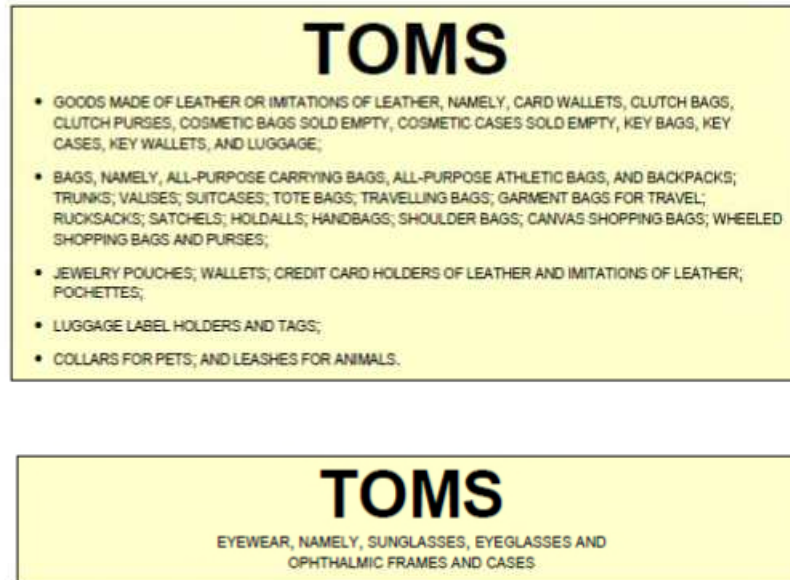
<sup>7</sup> Jay Report, p. 1. The study I conducted was also a forward confusion study. I have not been asked at this time to opine on the possibility of reverse confusion.

<sup>8</sup> Jay Report, p. 3.

<sup>9</sup> Jay Report, p. 3.

in smaller letters below. Examples of each of the stimuli in the Field Surveys are shown below in Figure 1.

**Figure 1: Stimuli Used in Field Surveys**



13. After reviewing the stimuli, respondents were asked a series of questions. First respondents were asked to name the company that makes or puts out the products described.<sup>10</sup> Next, respondents were asked to indicate whether they thought the maker of the products shown makes or puts out products under another brand name.<sup>11</sup> Respondents who said yes were asked to identify which other brand names they believed were made or put out by TOMS and provide a reason for their opinion. Respondents were then asked if the class of products described with the name TOMS were put out with the authorization or approval of any other company and those indicating “yes” were asked to name the company or companies. Finally,

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<sup>10</sup> The exact question wording was “Who or what company do you think makes or puts out these products?”. The Jay study also included an alternative format of this question as follows, “Who or what company do you think makes or puts out the products with this name?” *Jay Report*, Appendix D, pp. D12-13.

<sup>11</sup> *Jay Report*, Appendix D, pp. D17-18.

respondents were asked if the class of products described with the name TOMS has a business affiliation or connection with another company. Respondents who indicated there was a business connection were asked to identify the company and provide a reason for their opinion.<sup>12</sup>

14. In both Field I Survey and Field II Survey, none of the survey participants named “TOD’S” in response to any of the questions asked. Based on these results, Dr. Jay concludes, “[t]he Field Surveys strongly support the conclusion that relevant consumers are not likely to believe that TOD’s S.p.A. or TOD’S is the source, the sponsor of, or affiliated with the Class 18 and Class 9 goods with the TOMS name (*i.e.*, there is not a likelihood of forward confusion).”<sup>13</sup>

## VI. ANALYSIS OF THE FIELD SURVEYS

15. Dr. Jay explains that she selected an Eveready survey design in this matter for three reasons. First, she asserts that, “the Eveready format has become the most utilized and accepted survey format for assessing likelihood-of-confusion in board proceedings”.<sup>14</sup> Second, she notes that the U.S. Trademark Trial and Appeal Board (“TTAB”) has in the past criticized surveys not following the Eveready format when an opposer has characterized its mark as famous. Dr. Jay cites to Tod’s’ assertion of fame in these proceedings.<sup>15</sup> Finally, Dr. Jay argues that TOMS and TOD’S goods frequently are “not sold in the same retail locations” and

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<sup>12</sup> *Jay Report, Appendix D and Appendix E.*

<sup>13</sup> *Jay Report*, p. 14.

<sup>14</sup> *Jay Report*, p. 2.

<sup>15</sup> *Jay Report*, p. 2.

even when sold at the same stores “usually are not displayed side-by-side or in close proximity.”<sup>16</sup> I will discuss each of these assertions below.

### **1.1. Board Acceptance of Different Survey Formats**

16. While Dr. Jay is correct that generally the TTAB favors surveys conducted using an Eveready format, she also acknowledges that alternative approaches, including a line-up or Squirt type survey have been accepted. In her article reviewing likelihood of confusion surveys used in TTAB proceedings, Dr. Jay notes that in *Ava Enterprises v. Audio Boss* the TTAB found the results from a Squirt type survey compelling and evidence of a likelihood of confusion. In fact, in this particular matter, the TTAB relied on the *gross* rate of confusion found in the test group to support its findings of likely confusion.<sup>17</sup>

17. Of course, the Board’s acceptance of a particular survey design is not simply a general preference for one approach over another, but rather is based on an interpretation of the facts at issue and an evaluation of whether or not the survey, as designed, assesses confusion in a meaningful and scientifically rigorous manner.

18. As a case in point, the Board has also rejected Eveready designs which were poorly implemented or were designed in ways which created biased or otherwise unreliable results. Perhaps more important, the Board has rejected Eveready style surveys because the survey was judged not to have measured appropriately all possible and relevant types of confusion. In fact, Dr. Jay notes in her article reviewing surveys before the TTAB, that the Board is particularly critical of surveys conducted by defendants when they do not measure the full range of likely confusion. She explains, “[a] plaintiff’s survey may be probative even if it

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<sup>16</sup> *Jay Report*, p. 2.

<sup>17</sup> E. Deborah Jay, 2014. “He Who Steals My Good Name: Likelihood-of-Confusion Surveys in TTAB Proceedings.” *Trademark Reporter*. Volume 104. No. 5. pp. 1160-1162.

demonstrates that only one form of forward confusion is likely (such as source confusion), whereas a defendant's survey will be faulted if it does not measure the full potential for confusion."<sup>18</sup>

19. In this matter, there are a number of factors which require a careful evaluation of the potential for confusion and which further suggest that an Eveready design is not the correct approach.

## **1.2. Eveready Design Dependent on "Fame" of TOD'S Brand**

20. Dr. Jay asserts that an Eveready design is appropriate approach because Tod's has claimed its marks are "famous". Yet, such an approach may not represent the potential for confusion accurately. First, the level of brand awareness or fame required to demonstrate confusion using an Eveready approach is substantial.<sup>19</sup> While TOD'S is likely a well-known brand name within a luxury or high end market,<sup>20</sup> it is unlikely to be a "household name".<sup>21</sup> Thus, the Eveready approach used by Dr. Jay would not reflect the true potential for confusion, as such a method requires the brand to be top of mind for the majority of a broad population of consumers. As explained by one author, "As befits current conditions of marketplace clutter, almost two million marks are federally registered. Comparatively few have (or can hope to

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<sup>18</sup> *ibid*, p.1181.

<sup>19</sup> It is my understanding that Tod's is in the process of amending its pleading and will no longer be pursuing a dilution claim requiring proof of fame.

<sup>20</sup> <http://www.businessinsider.com/pyramid-of-luxury-brands-2015-3>, accessed December 14, 2015.

<sup>21</sup> In *McCarthy on Trademarks and Unfair Competition*, J. Thomas McCarthy describes famous marks in similar terms ("The Restatement proposed that a mark must be strong enough that its trademark significance is apparent even when encountered outside of its own market segment" *McCarthy on Trademarks and Unfair Competition*, Fourth Edition Database updated February 2012, Chapter 24: Infringement by Use of Mark on Noncompetitive Goods or Services, 24:87; in an earlier edition, he quotes the Ninth Circuit as stating, "In short, for purposes of [ Lanham Act § 43(c)] , a mark usually will achieve broad-based fame only if a large portion of the general consuming public recognizes that mark. Put another way,... the mark must be a household name." *McCarthy on Trademarks and Unfair Competition*, Fourth Edition Database updated November 2006, Chapter 24: Infringement by Use of Mark on Noncompetitive Goods or Services, 24:92).

develop) sufficiently strong memory traces so as to be cued by pattern matching engendered by a monadic exposure to a similar junior use.”<sup>22</sup>

### **1.3. “Reading” the TOMS Brand.**

21. The Field Surveys asked consumers to “look at the name” TOMS, written in large letters with a list of products below in smaller print. Looking at this box of goods with a “title” TOMS, respondents were then asked what company makes the products. It is unsurprising that the majority of respondents who named any company named TOMS.

22. Given the design of the Field surveys, it is likely that many respondents simply defaulted to reading the large name presented at the top of the page and repeating this name as the maker of the goods. Field Survey I presented with a very long list of goods, and with the long list and the prominent placement of the name at the top in bold, we would expect a number of respondents to read “TOMS”, provide this name as an answer, and never consider or report other possible brands in the marketplace. Satisficing - the tendency for survey respondents to offer only as much of an answer as necessary without undergoing extensive cognitive work to think of all possible answers - is a well-known phenomenon in the survey research literature.<sup>23</sup>

23. In fact, a number of answers from the Field Surveys indicate that respondents were simply reading the name listed above the description of the class of products. Other responses indicate that it is the placement of the name TOMS or its depiction in large, bold, letters above the list of goods which causes them to believe that TOMS is the source of the

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<sup>22</sup> Jerre B. Swann, 2012 “Likelihood of Confusion” in *Trademark and Deceptive Advertising Surveys: Law Science and Design*. American Bar Association. p.64.

<sup>23</sup> Krosnick, Jon A. 1991. “Response Strategies for Coping with the Cognitive Demands of Attitude Measures in Surveys.” *Applied Cognitive Psychology* 5: 213-236.



goods. Such respondents are taking cues from the visual display of the name and goods listed used in the Field Study and are not necessarily making an association between TOMS (or any other brands) and the list of goods. See Tables 1a and 1b below.

**Table 1a. Top of Page Examples for Class 18 Goods**

<b><u>ID</u></b>	<b><u>C1.</u></b>	<b><u>C2.</u></b>
000004	TOMS.	Just the word that was in the biggest print at the top of the page.
000022	Toms.	It said Toms at the top of the ad.
000028	TOMS.	It is on the top of the ad.
000035	Toms.	It says Toms on the top of the description, and I know they make the shoes.
000047	Tom's	It is at the top of the page.
000050	Toms.	The title of Toms.
000057	Toms.	Because it was indicated at the top of the ad.
000059	TOMS.	The fact that it was in all capital letters at the top of the page.
000068	Toms.	Bold print name above the description of products.
000092	TOMS.	It is stated in large block letters.
000102	Toms.	The big name at the top.
000126	TOMS.	Largest print, likely meant to grab the eye and be remembered.
000127	Toms.	In the title; don't know what else Toms might refer to.
000131	Toms.	The name at the top of the ad.
000148	TOMS.	TOMS is listed at the top of the page.
000181	Toms.	The title on the top.
000193	TOMS.	Because of the title.
000207	Toms.	Heading on the info.
000212	Toms.	Because it says Toms on top of the ad.
000213	Toms, the canvas shoe company.	The title TOMS was at the top.
000226	Toms.	It says Toms on the top of the page of the ad!
000232	Toms.	The word Toms is in large print and centered as the heading.
000344	TOMS.	The fact that the word TOMS was situated above the statements made regarding these products.
000352	Toms.	Big, bold letters on the top of list.
000357	Toms.	Title.
000369	TOMS?	It was written in bold letters above the items.
000379	Toms.	It says Toms at the top of the description.
000380	Toms.	It says Toms at the top of the description.
000393	TOMS.	It has the name at the top.
000416	Toms.	Toms was in bold lettering at the very top.
000423	TOMS.	Name in capital letters at top of explanations.
000425	Toms.	It was written at the top.

000431	Toms.	Because it said it at the top.
000432	TOMS.	It says TOMS at the top of the screen.
000439	Toms.	It says Toms on the top.
000445	Toms.	The name at the top of the page.
000456	Toms.	The title.
000485	Toms.	Headline.
000499	Toms.	It says Toms right on the top.
000523	TOMS.	Name at the top of the page.
000544	Toms?	The title of the description.
000545	Toms.	It says Toms at the top of the ad.
001092	TOMS.	Because it was listed at the top of the page.
001109	Toms.	Heading on the ad.
001134	Tom's shoe company.	It says Toms at the top .
001144	Toms.	Because the name was at the top of the explanation.
001145	Toms.	It said on the top of the page.
001160	Toms.	The top of the ad.
001226	TOMs brand company	Name on the top of the page.
001245	Toms.	The name was on top.
001299	Toms.	It's the word at the top and there is no other indication of another company.
001322	Toms.	It says "TOMS" across the top.
001333	Toms.	Larger font at the top of description.
001340	Toms.	The title says TOMS.
001344	Toms.	The header says Toms.
001351	Toms.	Because at the top of the paragraph, there's a big text-size TOMS.
001378	Toms.	Because you had Toms listed at the top of both pages?!
001417	Toms.	It's written at the top of the box.
001419	Toms.	I assumed the name at the top of the page was the business name.
001537	Toms.	Toms in big letters across top of items.
001572	Toms.	The heading written at the beginning of the selection.
001576	TOMS.	It's written in bold letters on the letterhead.

Source: Jay Report, Appendix J, Who Makes or Puts Out the Class 18 Goods with the TOMS Name (Questions C1 and C2)

**Table 1b. Top of Page Examples for Class 9 Goods**

<b><u>ID</u></b>	<b><u>C1.</u></b>	<b><u>C2.</u></b>
000615	Toms.	The name is prominently displayed at the top center, before the description of goods.
000663	Toms.	It is the first name listed.
000712	Toms.	Because that's what it says, moron.
000715	Tom's	The name is above the list of products they sell.
000716	Toms.	Larger font used.
000720	Toms.	The name at the top of the ad.
000783	TOMS.	The name is in bold, at the top of the box.
000807	Toms.	Because it is the name at the top of the ad, and it is not a part of the description.
000843	Toms.	Large, capital lettering.
000864	Toms.	I have seen eyeglasses and sunglasses with the brand name of Toms on the tag before. Also, TOMS is in bold letters on top of the description of the products.
000878	Eyeglass company named Toms.	Toms, in bold and capital letters on top.
000885	Tom's	Because that's the letterhead and only name, whereas everything else listed is a product.
000908	Toms.	Because the name is in bold type, larger than rest of the type.
000909	Toms.	Name at the top.
000938	Toms.	It's listed most prominently in the description. Also, Toms is a name brand of shoes.
000992	Toms.	It's in bold letters.
001007	TOMS.	Bold, one line title with a larger font. I think I have heard of this brand.
001058	Toms.	First word looks like the name and is in larger text.
001086	Toms.	Largest print.
001087	Tom's	Large print name.
001701	Toms.	The bold letters.

001711	According to the advertisement, TOMS makes these products. I am aware of a company called TOMS that sells mainly shoes and makes charitable contributions of shoes to people in third world countries.	I assumed from the ad that TOMS was the manufacturer of these products, since their name is at the very top of the ad. I realize that they could possibly be manufactured by another company that TOMS may be a subsidiary of.
001712	Toms.	It says Toms bigger than anything else.
001729	Toms.	The title of the ad is Toms. It is also in the largest font.
001730	Toms.	The banner box listing.
001735	TOMS.	Only word that looks like a name on the ad. Also, largest word in the ad.
001782	TOMS.	Large bold letters, and it is set up like a heading
001794	Toms.	Big print, first line.
001848	Toms.	Because the word comes first and has no meaning in the context of the information below, leading me to believe that it's a company name.
001862	Toms.	Because it is in large type at the top of the ad.
001878	Toms.	Large-letter header.
001887	Possibly Tom.	Name at the top.
001975	Toms.	It's at the top of the description of the products.
001995	Toms.	That is what the huge header says.
002027	Toms.	Toms is displayed in large/bold type.
002089	Toms.	Because that's the first name I see and I have no other clue than that.
002092	Toms.	That is what it says at the top.
002100	Well, I guess TOMS.	TOMS is at the top of the ad.
002123	Toms.	That is the bold word at the top.
002160	Toms.	It is the first thing that catches your eye at the top of the billing.
002164	Toms.	It is the lead word.
002169	Toms.	It's in big, bold letters.
002175	Toms.	Because it's listed in bold letters.
002177	Toms.	Bold name.
002194	Toms.	The giant title that says Toms.
002231	Toms.	The first word. Also, it is the largest font and bolded.
002244	Toms.	Big font.

002249	TOMS.	The name TOMS appears at the top of a list of what appear to be optical components. It, in itself, is not an optical component of which I am aware. The name appears in bold, capital letters. Therefore, I conclude that TOMS is a supplier of these products.
002277	Toms.	Bold letters.
002298	Who would be Toms.	Toms name is on the top of the ad.
002306	Toms.	Uppercase letters, bigger font, first word listed.
002378	TOMS.	Their name is in bold at the top of the image.
002452	TOMS.	Up on top.
002453	Toms.	Headline, bold print.

Source: Jay Report, Appendix N, Who Makes or Puts Out the Class 9 Goods with the TOMS Name (Questions C1 and C2)

#### 1.4. Anonymous Source Confusion

24. Another aspect of this matter renders the Eveready approach as designed by Dr. Jay inappropriate for measuring all possible relevant confusion. Many standard Eveready designs account for the possibility that a consumer may be confused even if he or she cannot name the source or manufacturer. These questions are typically known as “anonymous source” questions and establish confusion by evaluating responses which name other products or goods made by the senior user.<sup>24</sup>

25. In this case, Dr. Jay does not ask respondents the standard anonymous source question deriving from the Eveready case - “what other products or goods are made” by

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<sup>24</sup> In the seminal *Union Carbide* case, respondents were asked to identify other products made by the alleged infringer and the court found strong evidence of confusion based on the percent of respondents who mistakenly thought that the infringer also made batteries. “In each of the surveys an insignificant number of persons named Carbide as the maker of defendants' products, but in excess of 50% of those interviewed associated Carbide products, such as batteries and flashlights, with defendants' mark. The only conclusion that can be drawn from these results is that an extremely significant portion of the population associates Carbide's products with a single anonymous source.” *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F. 2d 366 - Court of Appeals, 7th Circuit 1976  
[https://scholar.google.com/scholar\\_case?case=12957955437922520229&q=union+carbide+v.+ever-ready&hl=en&as\\_sdt=2006&as\\_vis=1](https://scholar.google.com/scholar_case?case=12957955437922520229&q=union+carbide+v.+ever-ready&hl=en&as_sdt=2006&as_vis=1)

TOMS. And in fact, a question such as this would not yield useful data because the survey design has already supplied a list of goods made by and associated with the senior user as part of the stimuli. Rather than a standard anonymous source question, Dr. Jay instead suggests that her question, “Do you think the maker(s) of the products with this name a) do make or put out products under another brand name, or b) do not make or put out products under another brand name made” addresses potential anonymous source confusion. But asking respondents to identify whether another brand name is used by TOMS (even if they do not have to identify the brand) is not truly getting at the issue of anonymous source. It is merely asking respondents to generate another name.

### **1.5. Proximity of Goods**

26. Finally, Dr. Jay argues that a Squirt or line-up style survey would be inappropriate here because TOMS and TOD’S goods are not usually sold in close proximity. Dr. Jay provides no evidence or citation to support this assertion. Moreover, there is evidence that the goods are in fact sold in proximity. In fact, Mycoskie alleges in its answers to both the notice of opposition and cancellation petition that the parties’ goods are frequently sold in the same retail locations.<sup>25</sup>

27. My own research demonstrates that the department store Nordstrom carries both brands and has bags from both brand names. Additionally, the massive online retailer, Amazon.com, carries sunglasses from both companies.<sup>26</sup> Thus, contrary to Dr. Jay’s conclusion that the brands are not sold in proximity, evidence from the pleadings and the real world indicates that both TOMS and TOD’S can easily be found in the same retail locations.

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<sup>25</sup> See Answers to Notice of Opposition, Cancellation Petition, Facts Common To All Affirmative Defenses ¶ 5.

<sup>26</sup> See Exhibit C.

28. As discussed in detail above, there are a number of reasons that the Eveready surveys as designed by Dr. Jay cannot appropriately measure the potential for confusion at issue in this matter. The Eveready design does not account for the fact that many respondents are simply reading the name “TOMS” and are not reviewing or considering the list of goods. Additionally, Dr. Jay incorrectly relies on irrelevant assertions of fame and unsupported claims that TOMS and TOD’S are not found in the same retail locations.

29. In response to Dr. Jay’s work and to address the likelihood that the Field Surveys do not measure all possible confusion,<sup>27</sup> I conducted a survey of relevant consumers.

## VII. BUTLER SURVEY METHODOLOGY

30. I conducted a study of the relevant consumers of Class 18 goods at issue in this matter. The design of this research follows generally accepted principles for the design of a survey to be used as evidence in a legal proceeding.<sup>28</sup> In general, the design of a reliable study requires careful attention to the following key areas:

- The definition of the relevant population;
- The procedures for sampling from the relevant population;
- The survey questions used;
- The nature of the specific stimuli shown to respondents; and
- The protocol for calculating the results from the survey.

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<sup>27</sup> “In several controversies, the Board commented that the defendant’s Eveready survey was ‘proper in form’ or followed an ‘accepted format,’ but then faulted the survey for not measuring the ‘full potential for confusion’.” E. Deborah Jay, 2014. “He Who Steals My Good Name: Likelihood-of-Confusion Surveys in TTAB Proceedings.” *Trademark Reporter*. Volume 104. No. 5. pp. 1159.

<sup>28</sup> Diamond, S. (2011) “Reference Guide on Survey Research” in the *Reference Manual on Scientific Evidence Third Edition*, Federal Judicial Center at: [http://www.fjc.gov/public/pdf.nsf/lookup/SciMan3D09.pdf/\\$file/SciMan3D09.pdf](http://www.fjc.gov/public/pdf.nsf/lookup/SciMan3D09.pdf/$file/SciMan3D09.pdf); Federal Judicial Center (2004) *Manual for Complex Litigation, Fourth*. Section 11.493, p. 102.

The following discussion is organized around these key areas.

## **1.6. Definition of the Relevant Population**

31. The population of interest for this study is consumers who are likely to purchase bags in the next six months. Specifically, I define the relevant population as consumers 18 years of age or older who indicate that they are likely to purchase bags (including handbags, tote bags, backpacks, and athletic bags), and wallets in the next six months.

## **1.7. Sampling of the Relevant Population**

32. Potential survey respondents were contacted using an internet panel hosted by Survey Sampling International (“SSI”).<sup>29</sup> SSI complies with the standards for online survey data panels set forth by ESOMAR (The World Association for Marketing and Opinion Research).<sup>30</sup> SSI also holds industry memberships with AAPOR (The American Association of Public Opinion Research), The American Marketing Association, CASRO (Council of American Survey Research Organizations), The Advertising Research Foundation, and The Marketing Research Association.

33. SSI uses a variety of quality control measures to ensure the reliability and integrity of the responses it provides. For example, SSI uses digital fingerprinting which creates a “fingerprint” for each respondent based on computer characteristics (like IP address), which can then be used to identify respondents and exclude individuals who attempt to take the same

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<sup>29</sup> For additional information about SSI, see: <https://www.surveysampling.com/about/faqs/>, <http://www.esomar.org/uploads/public/knowledge-and-standards/documents/ESOMAR-28-Questions-to-Help-Buyers-of-Online-Samples-September-2012.pdf>, accessed December 14, 2015.

<sup>30</sup> For a description of SSI’s methodologies <https://www.surveysampling.com/technology/data-quality/> and how it complies with ESOMAR standards see <https://www.surveysampling.com/site/assets/files/1069/esomar-28-questions.pdf>, accessed December 14, 2015.



survey more than once. SSI monitors its data for speeders, straight liners and other low quality respondents.<sup>31</sup> SSI's standard quality control measures were undertaken in this study.

## **1.8. Quality Control Measures for the Survey**

34. To ensure that my data are of the highest quality, I implemented quality control measures in addition to those undertaken by SSI:

- a. As is standard survey practice for litigation, the survey was conducted in a “double-blind” fashion; that is, neither the staff at SSI nor the respondents were aware of the survey sponsor or the ultimate intention of the survey.<sup>32</sup>
- b. Respondents had to correctly answer a CAPTCHA question to ensure that a person, and not a computer or “bot”, was taking the survey.<sup>33</sup>
- c. Respondents were required to enter their gender and age at the outset of the survey and if these data conflicted with the respondent information on file with SSI, the respondent was excluded.
- d. Respondents were also asked a series of quality control questions at the end of the survey and were terminated and not included in the final study if they did not answer these questions correctly.<sup>34</sup>

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<sup>31</sup> For a description of SSI's quality control measures, see <http://www.surveysampling.com/en/technology/quality>, accessed December 13, 2015.

<sup>32</sup> Diamond, Shari, S. (2012) “Reference Guide on Survey Research,” *Reference Manual on Scientific Evidence*, Committee on the Development of the Third Edition of the Reference Manual on Scientific Evidence; Federal Judicial Center; National Research Council. pp. 410-411 (hereafter, “*Diamond*”).

<sup>33</sup> The acronym CAPTCHA stands for “Completely Automated Public Turing Test to Tell Computers and Humans Apart” (“CAPTCHA: Telling Humans and Computers Apart Automatically,” *CAPTCHA*, available at <http://www.captcha.net/>, accessed December 14, 2015.).

<sup>34</sup> Respondents were asked to select a particular item from a list and were also asked to verify that they did not consult other devices or persons during the survey.

## 1.9. Questionnaire

35. To ensure that panel respondents were part of the relevant population as defined for this case, a series of screening questions was asked.<sup>35</sup> Potential respondents were first asked to identify, from a list, items they had previously purchased for themselves or for someone else in the past six months. This was followed by a question with the same set of items asking respondents which items, if any, they were likely to purchase in the next six months. To qualify, respondents had to be likely to purchase bags (including handbags, tote bags, backpacks, and athletic bags), and or wallets in the next six months.

36. After the screening and introductory questions, qualified respondents were taken to the main portion of the questionnaire. All respondents were then provided with the following instruction:

On the next few screens, you will be shown the brand names of bags (including handbags, tote bags, backpacks, and athletic bags), and wallets.

You will then be asked some questions. We are interested in your honest opinions. There are no right or wrong answers. If for any question you don't know the answer or don't have an opinion, you may say so—please do not guess.

Please take as much time as you would like to look at the next few screens. For each screen, click the forward arrow at the bottom of the screen when you are ready to move on to the next screen. You will not be able to go back to previous screens.

37. Respondents were then shown the name TOD'S as displayed below in Figure 2. There was a five second pause after which respondents could move to the next screen if they were ready.

---

<sup>35</sup> The questionnaire can be found in Exhibit D.

**Figure 2: The Name TOD'S Displayed for Respondents**



38. On the next screen, respondents were provided with the following instruction:

Now you will be shown a series of brand names of bags and wallets.

39. Respondents were then shown a list of ten additional brand names, including

TOMS. The list is discussed in greater detail in Section 1.10 below.

40. After viewing the list of names, respondents were asked a filter question:

Do you think any of these brands are made or put out by the same company that makes or puts out the brand name you saw first?

41. Respondents who indicated that one or more of the brands were made or put out by the first brand were ask to identify which brands and then for each brand identified were asked to explain their opinion.

42. Respondents were then asked:

Do you think any of these brands are associated or affiliated with the company that makes or puts out the brand you saw first?

43. As with the prior question series, respondents who answered that one or more of the brands were affiliated or associated with the company of the first brand were asked to indicate which one(s) and explain why.

44. Finally respondents were asked:

Do you think any of these brands received authorization or approval from the company of the first brand you saw?

45. Respondents who indicated “yes” were asked to identify the brand and explain why for each brand selected. After this final question, respondents were asked a series of quality control questions as described above and then were thanked for their time and the survey was complete.

### **1.10. Stimuli Shown**

46. As indicated above, respondents were shown a list ten names. All of the names on the list were brands of bags which were available at a retail store selling both TOD’S and TOMS brand bags. The brands on the list included brands which sell bags and other accessories at a variety of price points, including more expensive luxury-type brands and less expensive brands.

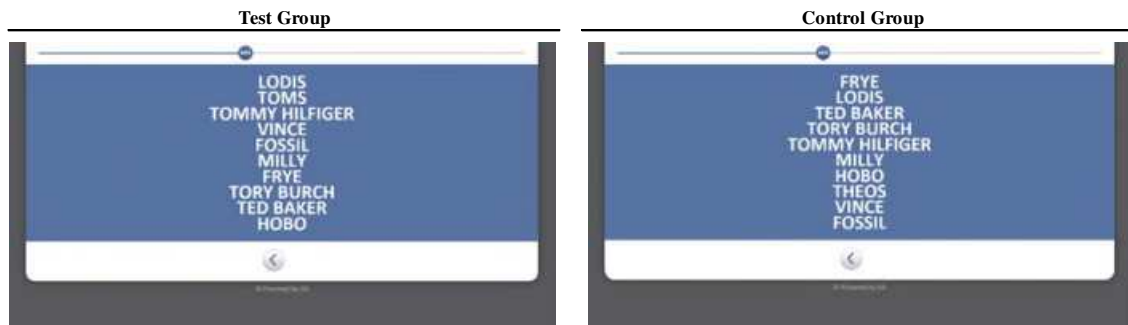
47. Both longer names and names with only four letters appeared on the list to ensure that respondents were not identifying a brand simply based on comparing the length of the name. Additionally, the list included brands other than TOMS which could also be the first name of a person. The inclusion of brands which could also be first names was done to ensure that respondents were not simply matching based on the fact that both TOD’S and TOMS can be a man’s first name.

48. To avoid order effects,<sup>36</sup> the names appeared randomly, such that every name on the list had an opportunity to be placed first, second, third and so on through the list of ten. The list of names is shown below in Figure 3.

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<sup>36</sup> Shari Seidman Diamond discusses order effects in her chapter on survey research (“To control for order effects, the order of the questions and the order of the response choices in a survey should be rotated.”) See *Diamond*, p. 396.

**Figure 3: List of Brand Names**



49. Because a survey evaluating consumer perception may inadvertently cause respondents to guess or otherwise create noise unrelated to the stimuli being tested, my study also included a control condition. Respondents in the control condition received the exact same questionnaire and were also provided with a list of brand names. The control list of names was the same as that shown in the test but included the name “THEOS”, instead of TOMS. This is a very conservative control as the control, like the names TOD’S and TOMS, is a short mark that can be perceived as a man’s name and has the same starting and ending letters as both TOD’S and TOMS (as well as a shared “O” in the middle).

## VIII. RESULTS

50. A total of 397 respondents qualified and completed the survey.<sup>37</sup> Survey respondents included men and women and a variety of ages as shown in Table 2 below. Respondents were also from all across the US and were generally distributed across the four census regions as shown in Table 3 below.<sup>38</sup>

<sup>37</sup> Data can be found in Exhibit E.

<sup>38</sup> The age, gender, and geographic distributions of qualified respondents in my survey are generally similar to the distributions in Field Survey I. Dr. Jay does not weight the data for her results and I also present unweighted data.

**Table 2: Age and Gender of Respondents**

<b>Age</b>	<b>Gender</b>			
	<b>Male</b>		<b>Female</b>	
	----(Count)----	---(Percent)---	----(Count)----	---(Percent)---
18-34	29	26.9%	119	41.2%
35-54	48	44.4%	98	33.9%
55+	31	28.7%	72	24.9%
<b>Total:</b>	<b>108</b>	<b>100 %</b>	<b>289</b>	<b>100 %</b>

*Source: NERA Brand Survey 2015*

**Table 3: Geographic Distribution of Respondents**

<b>Region</b>	<b>Test Respondents</b>		<b>Control Respondents</b>		<b>Total Respondents</b>	
	----(Count)----	---(Percent)---	----(Count)----	---(Percent)---	----(Count)----	---(Percent)---
	----(Count)----	---(Percent)---	----(Count)----	---(Percent)---	----(Count)----	---(Percent)---
Midwest	46	22.9%	36	18.4%	82	20.7%
Northeast	43	21.4%	40	20.4%	83	20.9%
South	72	35.8%	82	41.8%	154	38.8%
West	40	19.9%	38	19.4%	78	19.6%
<b>Total:</b>	<b>201</b>	<b>100 %</b>	<b>196</b>	<b>100 %</b>	<b>397</b>	<b>100 %</b>

*Source: NERA Brand Survey 2015*

51. When respondents were asked if any of the brand names listed were made or put out by the same company, approximately 25 percent of respondents in both the test and control conditions answered “yes”.<sup>39</sup> In the test condition, 35 respondents or 17.4 indicated that TOMS was made or put out by the same company that makes TOD’S. In the control condition, 6.6 percent named THEOS as being made by the same company as puts out TOD’S. These results are shown below in Table 4.

<sup>39</sup> In the test condition, 25.9 percent indicated “yes” and 24.5 percent of respondents shown the control list indicated “yes”.

**Table 4: Respondents Who Believe TOMS (THEOS) is  
From Same Company as TOD’S**

<b><u>Brand Named</u></b>	<b>Test Respondents</b>		<b>Control Respondents</b>	
	-----(Count)-----	-----(Percent)-----	-----(Count)-----	-----(Percent)-----
TOMS	35	17.4%	0	0.0%
THEOS	0	0.0%	13	6.6%
Other	17	8.5%	35	17.9%
None / Don't know*	149	74.1%	148	75.5%
<b>Total Number of Respondents</b>	<b>201</b>	<b>100%</b>	<b>196</b>	<b>100%</b>

*Q1a. Which of these brands are made or put out by the same company as the brand name you saw first?*

*\*Q1. Do you think any of these brands are made or put out by the same company that makes or puts out the brand name you saw first? [ROTATE RESPONSE OPTIONS 1 AND 2]*

*1. Yes*

*2. No [GO TO Q2]*

*3. Don't know / no opinion [GO TO Q2]*

*Source: NERA Brand Survey 2015*

52. When asked if any of the brands on the list are associated or affiliated with the company that makes or puts out the brand shown first, 23.9 percent of respondents in the test condition and 17.9 percent of respondents in the control indicated “yes”. In the test condition, 23 respondents or 11.4 percent named TOMS as the brand associated with TOD’S. In the control condition, seven respondents or 3.6 percent named THEOS as the brand associated with TOD’S. These results are shown below in Table 5.

**Table 5: Respondents Who Associate TOMS (THEOS)  
with TOD'S**

<b><u>Brand Named</u></b>	<b>Test Respondents</b>		<b>Control Respondents</b>	
	-----(Count)----	-----(Percent)----	-----(Count)----	-----(Percent)----
TOMS	23	11.4%	0	0.0%
THEOS	0	0.0%	7	3.6%
Other	25	12.4%	28	14.3%
Not affiliated / don't know*	153	76.1%	161	82.1%
<b>Total Number of Respondents</b>	<b>201</b>	<b>100%</b>	<b>196</b>	<b>100%</b>

*Q2a. Which of these brands are associated or affiliated with the company of the first brand you saw?*

*\*Q2. Do you think any of these brands are associated or affiliated with the company that makes or puts out the brand you saw first? [ROTATE RESPONSE OPTIONS 1 AND 2]*

*1. Yes*

*2. No [GO TO Q3]*

*3. Don't know / no opinion [GO TO Q3]*

*Source: NERA Brand Survey 2015*

53. Finally, respondents were asked if they believe any of the listed brands received authorization or approval from the company that owns TOD'S. A total of 30 respondents or 14.9 percent in the test condition indicated that at least one of the brands has received authorization or approval from the company that owns TOD'S. In the control condition, 27 or 13.8 percent indicated that at least one of the listed brands received authorization from the company that owns TOD'S. Of respondents who viewed the test list, 17 or 8.5 percent indicated that they believe that TOMS received authorization or approval from the company that owns TOD'S. In the control group, five respondents or 2.6 indicated that THEOS received authorization or approval from the company that owns TOD'S. These results are shown below in Table 6.



**Table 6: Respondents Who Indicate TOMS (THEOS)  
Received Approval or Authorization from TOD'S**

<b><u>Brand Named</u></b>	<b>Test Respondents</b>		<b>Control Respondents</b>	
	-----(Count)-----	-----(Percent)-----	-----(Count)-----	-----(Percent)-----
TOMS	17	8.5%	0	0.0%
THEOS	0	0.0%	5	2.6%
Other	13	6.5%	22	11.2%
Not authorized / Don't know*	171	85.1%	169	86.2%
<b>Total Number of Respondents</b>	<b>201</b>	<b>100%</b>	<b>196</b>	<b>100%</b>

*Q3a. Which of these brands received authorization or approval from the company of the first brand you saw?*

*\*Q3. Do you think any of these brands received authorization or approval from the company of the first brand you saw? [ROTATE RESPONSE OPTIONS 1 AND 2]*

*1. Yes*

*2. No [GO TO Q4]*

*3. Don't know / no opinion [GO TO Q4]*

*Source: NERA Brand Survey 2015*

54. To estimate the total potential confusion between TOMS and TOD'S for Class 18 goods, I combine the counts of respondents confused for each of the source, association and authorization questions. No respondent is double-counted, that is, any respondent evincing confusion in response to more than one question is only counted once. As shown below in Table 7, a total of 49 respondents or 24.4 percent are confused and believe that TOMS is a brand put out by, is associated with, or received authorization from TOD'S for goods such as bags, backpacks, handbags, or wallets. In the control, a total of 20 respondents or 10.2 percent believe that the control name, THEOS, is a brand put out by, is associated with, or received authorization from TOD'S. Using the control to net potential guessing, yields a rate of 14.2 percent.

**Table 7: Respondents Confused by TOMS**

	<u>Test Respondents</u>		<u>Control Respondents</u>		<u>Net</u>
	----(Count)----	----(Percent)----	----(Count)----	----(Percent)----	----(Percent)----
Confused	49	24.4%	20	10.2%	14.2%
<b>Total Number of Respondents</b>	<b>201</b>		<b>196</b>		

*Q1, Q2, and Q3 series.*

*Source: NERA Brand Survey 2015*

55. Respondents in the test condition who are confused by the name TOMS generally indicate it is the similarity in names, with a number in fact asserting that the names are the same. Additionally, almost half of the respondents who were confused by TOMS did not name any of the other nine brands listed. In other words, 24 of the total 201 respondents or 11.9 percent believed that TOMS was the only brand made by, associated with, or authorized by TOD'S.

56. These results demonstrate that there is a likelihood of confusion between TOMS and TOD'S when the brand names appear in relation to Class 18 goods.<sup>40</sup>

57. The survey as designed is conservative; only the brand names are shown to respondents and the name TOMS was one of ten brands shown to respondents. Moreover, to minimize guessing, the list of additional brands shown to respondents included names of similar length and character (i.e. brands which could be first names). Finally, the results demonstrating confusion are conservative because the study also included a control condition. The control condition eliminates confusion that is not attributable specifically to the TOMS name.

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<sup>40</sup> While this survey did not specifically test for Class 9 goods, it is reasonable to assume that the results of such a study would be largely similar and the overall conclusion would be the same.

## IX. CONCLUSIONS

58. As discussed above, my review of the Field Surveys submitted by Dr. E. Deborah Jay indicates that these studies do not account for all possible confusion relevant in this matter. First, the Field Survey results are limited to the potential confusion which would occur in populations who know TOD'S as a "famous" brand. Additionally, the Field Surveys caused a number of respondents to simply read the name TOMS and such responses do not address the potential for respondents to associate TOMS with TOD'S.

59. The Field Survey results cannot be used to address confusion which may occur when the brand names are seen by consumers in proximity. Evidence from retail stores, online vendors and the Applicant/Respondent's own pleadings, indicate that both TOD'S and TOMS are sold in the same retail locations.

60. I designed and conducted survey using a format which can evaluate confusion which may occur when the brand names are seen in proximity. My survey demonstrates that a net 14 percent of consumers believe that TOMS is a brand from the same company, is associated with, or received authorization from the owner of the TOD'S brand. These results demonstrate that confusion is, in fact possible.

61. My opinions and conclusions as expressed in this report are to a reasonable degree of professional and scientific certainty.



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Sarah Butler, Vice President

December 15, 2015

# **EXHIBIT 31**

---

**From:** Ederer, Louis S.  
**Sent:** Wednesday, December 16, 2015 8:16 PM  
**To:** Mandel, Richard  
**Cc:** Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin  
**Subject:** RE: Tod's/Toms

Richard:

Suffice to say we disagree with everything you say in your below email. Not only that, but if we had not waited a day to respond, we might not have understood the real reason for your belated attempt to amend your pleadings in this now 1-1/2 year old case.

First, not even the liberal standards of Rule 15 permit Tod's to sandbag our client in the way that you have surreptitiously tried to do. As you can imagine, we did not appreciate learning for the first time last night, upon receiving Ms. Butler's "rebuttal" report, that Tod's proposed withdrawal of its dilution claim, three days prior to the close of fact discovery, was actually intended to support Ms. Butler's position and provide her with a purported basis for criticizing Dr. Jay's survey — what Ms. Butler refers to as Dr. Jay's reliance on "irrelevant assertions of fame." Indeed, we find it remarkable that Tod's now acts as if its repeated allegations of fame, in pleadings you have signed and filed with the Board over the last *four years* — not to mention the ones you signed in this action — simply never existed. We also have no doubt that the Board will find this chronology, and the sudden decline in strength and consumer recognition of the TOD'S mark, of significant interest. In any case, your request that we consent to the proposed amendment is declined.

Second, with regard to Mr. Sincini, as you know, as Mr. Castiglioni testified, and as your client's own corporate filings show, Mr. Sincini is a member of the board of virtually every Tod's S.p.A. U.S. subsidiary, including the longstanding chairman of Deva Inc. (whose head of directly operated stores is one of your key witnesses in this proceeding), and is regularly present in the U.S. to carry out his responsibilities. Given that, once again, you elected to make an eleventh-hour amendment to Tod's initial disclosures, deliberately timed to protect your ability to call Mr. Sincini as a trial witness, we are confident the Board will see your tactics for what they are, and compel Mr. Sincini to sit for a deposition in New York, or, in the alternative, preclude him from testifying altogether.

Let us know if you would like to discuss these issues any further, or if you would like to set up briefing schedules for motions to the Board.

Finally, with respect to the Butler report, while we believe that, at the very least, the survey portion is improper rebuttal, and the entire premise of the report is contrived, for now we will simply reserve all of our rights with respect to its proposed use. That said, we call upon you to immediately produce the following materials:

- A readable (*i.e.*, native) copy of the file attached to the report as Exhibit E
- All verbatim responses to the survey
- Documents reflecting the number of people screened out from survey, not just the number of those qualifying
- Documents reflecting the number of people invited to participate in the survey and the number of acceptances
- A copy of any invitation and/or reminder emails to take the survey

Yours truly,

---

Louis S. Ederer  
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[louis.ederer@aporter.com](mailto:louis.ederer@aporter.com)  
[www.arnoldporter.com](http://www.arnoldporter.com)

---

**From:** Mandel, Richard [mailto:[RSM@cjl.com](mailto:RSM@cjl.com)]  
**Sent:** Tuesday, December 15, 2015 2:40 PM  
**To:** Ederer, Louis S.  
**Cc:** Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin  
**Subject:** RE: Tod's/Toms

Lou,

We think you are connecting two separate issues that bear no relation to each other. The new claim, which is based on information that is solely within Toms' knowledge, has nothing to do with Mr. Sincini or any other Tod's witness and does not require any additional discovery from Tod's. Mr. Sincini would not be offering any testimony in the case that bears on the new claim we seek to add. Moreover, we do not accept that we have delayed in asserting this claim, as it was only as a result of the recently concluded deposition of Toms' designated 30(b)(6) witness that we had sufficient grounds to assert such a claim. Under these circumstances, and given the liberal standards of Rule 15, we feel confident that the Board will permit the amendment, whether or not we have your consent. Forcing us to file a motion will only serve to delay matters further and we would ask you to reconsider your position on this issue. However, if you do not consent, we will file a motion seeking leave to amend.

As far as Mr. Sincini is concerned, the issue comes down to the same one we have previously discussed with respect to Tod's' designated 30(b)(6) witness, Mr. Varsavi. Mr. Sincini does not reside in the United States. Nor is he scheduled to be in the United States during the next thirty days. Accordingly, we do not believe you are entitled to an oral deposition of him in New York, and you would be required to proceed by way of a deposition upon written questions. We assumed based on your decision not to take Mr. Varsavi's deposition on written questions that you would not be interested in pursuing such a deposition for Mr. Sincini either. After all, he was repeatedly identified in Mr. Castiglioni's deposition as having knowledge regarding certain information on the enforcement decisions Tod's made, and you did not indicate any interest in pursuing his deposition following Mr. Castiglioni's testimony. He also was identified in interrogatory responses concerning the decision to file the notice of opposition. In view of his clear disclosure through other discovery, we did not even need to supplement our initial disclosures, but did so anyway in order to avoid any misunderstanding. We have no objection to extending the discovery period if you wish to take Mr. Sincini's deposition on written questions, but do not see any reason why the inclusion of his name in our supplemental initial disclosures should now somehow entitle you to an oral deposition. The circumstances are the same as they have always been – he does not reside in the United States and thus we are not required to produce him for an oral discovery deposition.

If you are interested in taking Mr. Sincini's deposition on written questions, please let us know and as indicated we will adjust the discovery schedule as necessary to accommodate that request. Also, let us know if you insist on having us file a motion seeking leave to amend.

**Richard S. Mandel, Esq.**  
Cowan, Liebowitz & Latman, P.C.



---

**From:** Ederer, Louis S. [<mailto:Louis.Ederer@APORTER.COM>]  
**Sent:** Monday, December 14, 2015 6:17 PM  
**To:** Mandel, Richard  
**Cc:** Emert, Aryn M.; Salzmänn, Matthew T.; Wolverton, Benjamin  
**Subject:** RE: Tod's/Toms

Richard:

We are prepared to consent to the amendment under the following conditions:

- 1) That Mycoskie be given a total of 30 days within which to answer the amended pleading, amend its initial disclosures if it sees fit, and produce any additional documents relating to the issues raised by the amendment.
- 2) That Mr. Sincini be produced in the New York for an oral deposition within 30 days. A notice of deposition is attached hereto. Given the evidence elicited at the Castiglioni deposition as to Sincini's role at Deva Inc., as well as the fact that you waited until three business days before the close of fact discovery to add him to your initial disclosures, you have no basis whatsoever for refusing to produce him.
- 3) That fact discovery be extended by 30 days for the sole and exclusive purpose of allowing the foregoing to proceed, and for no other purpose.

To be clear, if you are not prepared to agree to all of the foregoing, Mycoskie does not consent to the amendment of the pleadings, since you have waited a year and a half to introduce a completely new issue into the proceedings, having nothing to do with the likelihood of confusion dispute between the parties.

If you wish to discuss this matter, please contact me.

Sincerely,

---

Louis S. Ederer  
Partner  
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---

**From:** Ederer, Louis S.  
**Sent:** Friday, December 11, 2015 4:01 PM  
**To:** Mandel, Richard  
**Cc:** Emert, Aryn M.; Salzmänn, Matthew T.; Wolverton, Benjamin  
**Subject:** RE: Tod's/Toms

Richard:

I will be discussing the matter with my client, and will get back to you by Monday.

Thanks,

---

Louis S. Ederer  
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**From:** Mandel, Richard [<mailto:RSM@cll.com>]  
**Sent:** Thursday, December 10, 2015 6:17 PM  
**To:** Ederer, Louis S.  
**Cc:** Emert, Aryn M.  
**Subject:** Tod's/Toms

Lou,

Enclosed please find our supplemental production of documents TOD 16641-16644. TOD 16644 contains the information you requested during depositions regarding Marcolin's distribution of eyewear, while the other documents contain updated sales information.

I am also enclosing supplemental initial disclosures, which add Stefano Sincini and Andrea Varsavi as additional knowledgeable individuals under Fed. R. Civ. P. 26(a)(1)(A). They were both obviously disclosed in interrogatory responses and deposition testimony, so the supplementation is not really required under the rules. See Fed. R. Civ. P. 26(e)(1)(A) (only requiring supplementation when the additional information has not otherwise been made known during the discovery process). Nevertheless, in an abundance of caution, we have supplemented our disclosures to avoid any potential issues.

Finally, we enclose a proposed amended combined notice of opposition/cancellation petition for which we seek your consent to file. The amendment would drop the dilution claim we have asserted and add a claim based on lack of a bona fide intent to use with respect to certain Class 18 products based on the recent deposition testimony of Mycoskie's designated 30(b)(6) witness. We have enclosed a clean copy as well as redlines showing changes from the previously filed cancellation petition and notice of opposition, which have now also been combined into a single pleading in light of the consolidation of both proceedings. We do not seek any additional discovery as a result of the amendment and are prepared to proceed on the current schedule, as it may be modified by the Board to allow for expert discovery – a topic we can address in more detail after the rebuttal expert period expires.

Let us know your position on the amendment so we can see whether it is necessary to file a motion seeking leave to amend.

**Richard S. Mandel, Esq.**  
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# **EXHIBIT 32**

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. 86/004,044  
Filed: July 8, 2013  
For Mark: TOMS  
Published in the *Official Gazette*: April 29, 2014

TOD'S S.P.A.,	)	Opposition No.: 91218001
	)	
Opposer,	)	<b>APPLICANT'S RESPONSES AND</b>
	)	<b>OBJECTIONS TO OPPOSER TOD'S</b>
v.	)	<b>S.P.A.'S FIRST SET OF</b>
	)	<b>INTERROGATORIES</b>
MYCOSKIE, LLC,	)	
	)	
Applicant.	)	
	)	

Applicant Mycoskie, LLC ("Mycoskie"), by and through its undersigned counsel, hereby responds to Opposer Tod's S.p.A. ("Opposer")'s First Set of Interrogatories (the "Interrogatories") as follows:

**GENERAL OBJECTIONS**

Mycoskie makes the following General Objections to Opposer's Interrogatories, which apply to each Interrogatory regardless of whether the General Objections are expressly incorporated into the specific objections below:

1. Mycoskie objects to the Interrogatories to the extent they seek to impose obligations that exceed those under the Federal Rules of Civil Procedure and 37 C.F.R. § 2.120.
2. Mycoskie objects to the Interrogatories to the extent that they may unfairly seek to restrict the facts Mycoskie may rely on at trial, or to the extent that they require Mycoskie to analyze or formulate contentions on matters for which Mycoskie's investigation and discovery have not yet been completed. Since discovery has not been completed, Mycoskie is not yet necessarily in possession of all the facts and documents upon which Mycoskie intends to rely.

Mycoskie reserves the right to supplement, amend, or modify these responses at a future date.

3. Mycoskie objects to the Interrogatories to the extent they seek information that is not relevant or reasonably calculated to lead to the discovery of admissible evidence. To the extent that Mycoskie responds to these Interrogatories, it does not concede that the information sought or disclosed is relevant to this proceeding.

4. Mycoskie objects to the Interrogatories to the extent they are vague, overly broad or unduly burdensome.

5. Mycoskie objects to the Interrogatories to the extent they call for, or could be construed to call for, the disclosure of proprietary, trade secret or other commercially protected information for which no necessity and relevance has been shown, and which are without the protection of an appropriate protective order and the implementation of procedures that will ensure the continued confidentiality of such information.

6. Mycoskie objects to the Interrogatories to the extent they seek information that is privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law. Mycoskie does not waive, and intends to preserve, and is preserving all applicable privileges or protections with respect to any information protected by such a privilege or protection. In the event that any privileged or protected information is disclosed, such disclosure is inadvertent and will not constitute a waiver of any privilege or protection.

7. Mycoskie objects to the Interrogatories to the extent that they fail to specify a relevant time period. The absence of a limited time period makes these Interrogatories overly broad and unduly burdensome in scope.

8. Mycoskie's responses to the Interrogatories are made to the best of Mycoskie's

present knowledge, information and belief. Said responses are at all times subject to such additional or different information that discovery or further investigation may disclose and, while based on the present state of Mycoskie's recollection, are subject to such refreshing of recollection, and such additional knowledge of facts, as may result from Mycoskie's further discovery or investigation. Mycoskie reserves the right to make use of, or to introduce at any hearing or trial, information responsive to the Interrogatories but discovered subsequent to the date of these responses, including, but not limited to, any such information obtained in discovery herein.

9. Mycoskie objects to the Interrogatories on the basis that discovery is ongoing, and expressly reserves the right to amend its responses to the Interrogatories if and when additional information becomes available.

10. Mycoskie preserves its objections as to the competency, relevance, materiality, privilege and admissibility of any information provided in response to these Interrogatories. Mycoskie also expressly reserves the right to object to further discovery into the subject matter of the Interrogatories and to the introduction into of evidence of any responses to the Interrogatories.

11. Mycoskie's responses to the Interrogatories shall not be interpreted to concede the truth of any factual assertion or implication contained in the Interrogatories.

12. Mycoskie objects to the Interrogatories to the extent that they seek information set forth in documents that are outside Mycoskie's possession, custody or control.

13. Mycoskie objects to the Interrogatories to the extent that they seek information that Opposer equally may otherwise obtain from public sources or with less burden and expense by using other means of discovery.

14. Mycoskie objects to the Interrogatories to the extent that they are cumulative, duplicative, repetitive, or overlapping.

15. Mycoskie reserves the right to object on any ground at any time to such other or supplemental interrogatories as Opposer may propound involving or relating to the subject matter of these Interrogatories.

16. Mycoskie objects to the Interrogatories pursuant to Federal Rule of Civil Procedure 26(b)(2)(C) to the extent that the burden and/or expense of attempting to ascertain the requested information outweighs any conceivable benefit considering the needs of this proceeding, the parties' resources, the importance of the issues at stake in the action, and the importance of the discovery in resolving the issues.

17. Mycoskie objects to the definition of "Applicant" on the grounds that it is overly broad and unduly burdensome and purports to impose obligations on Mycoskie to produce information and/or documents outside its possession, custody or control. For avoidance of doubt, Mycoskie's instant responses incorporate information and documents obtained from its parent company, TOMS Shoes, LLC, and said company's predecessors-in-interest.

### **OBJECTIONS AND RESPONSES TO INTERROGATORIES**

#### **INTERROGATORY NO. 1:**

State the date when Applicant first selected Applicant's Mark for use as a trademark and identify all persons who participated in such selection.

#### **RESPONSE TO INTERROGATORY NO. 1:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the basis that it contains multiple subparts. Mycoskie further objects to this Interrogatory on the basis that the phrase "first selected" is vague and ambiguous as used therein. Mycoskie further objects to this Interrogatory

on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks information that is not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce non-privileged documents, pursuant to Fed. R. Civ. P. 33(d), from which the answer to this Interrogatory may be determined.

**INTERROGATORY NO. 2:**

Describe in detail the reason(s) for the original selection of the designation "TOMS" as a mark by Applicant, including, without limitation, the intended meaning or connotation of the term "TOMS."

**RESPONSE TO INTERROGATORY NO. 2:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the basis that it contains multiple subparts. Mycoskie further objects to this Interrogatory on the basis that the phrases "the reasons for", "original selection" and "intended meaning and connotation" are vague and ambiguous as used therein. Mycoskie further objects to this Interrogatory on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks information that is not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce documents, pursuant to Fed. R. Civ. P. 33(d), from which the answer to this Interrogatory may be determined.

**INTERROGATORY NO. 3:**

Identify any trademark searches or other searches, opinions, investigations, analyses or studies related to the selection, design, and/or adoption of Applicant's Mark for use or intended use in the United States or in commerce, including, without limitation, the persons involved, the

date(s), and the data or results of those searches, opinions, investigations, analyses or studies.

**RESPONSE TO INTERROGATORY NO. 3:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the basis that it contains multiple subparts. Mycoskie further objects to this Interrogatory on the grounds that it is overly broad and unduly burdensome in scope in that it seeks the identification of any trademark searches or other searches, opinions, investigations, analyses or studies related to the selection, design, and/or adoption of Mycoskie's TOMS mark for use or intended use in the United States or in commerce regardless of the International Classes searched, investigated or analyzed. Mycoskie further objects to this Interrogatory on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks information that is not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Interrogatory to the extent it calls for information that is privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce non-privileged documents, pursuant to Fed. R. Civ. P. 33(d), if any, from which the answer to this Interrogatory may be determined.

**INTERROGATORY NO. 4:**

State whether Applicant (or any person or entity authorized by Applicant) has made any use of Applicant's Mark in the United States or in commerce as of the present date with respect to any of the goods listed in the Application, and if so, identify all such goods.

**RESPONSE TO INTERROGATORY NO. 4:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the basis that it contains multiple



subparts. Mycoskie further objects to this Interrogatory on the basis that the phrase “made any use of” is vague and ambiguous as used therein.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce non-privileged documents, pursuant to Fed. R. Civ. P. 33(d), if any, from which the answer to this Interrogatory may be determined.

**INTERROGATORY NO. 5:**

For each of the goods identified in response to Interrogatory No. 4 above, identify:

- (a) The date of first use of Applicant’s Mark on or in connection with such goods;
- (b) The period of time during which such goods were or are being distributed, offered for sale, sold or rendered;
- (c) The geographic area(s) in which such goods were or are being distributed, offered for sale, sold or rendered;
- (d) The annual volume of sales for each year to the present, both by dollar amount and unit amount, for each of the goods sold;
- (e) The retail and wholesale price for each of the goods sold; and
- (f) The channels of trade (e.g., types of retail stores, catalogs, mail order, on-line, promotional sales, private sales, etc.) through which each of the goods was or is being distributed or sold to the ultimate purchaser, consumer or user.

**RESPONSE TO INTERROGATORY NO. 5:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the basis that it contains multiple subparts. Mycoskie further objects to this Interrogatory on the basis that it is overly broad and unduly burdensome in scope. Mycoskie further objects to this Interrogatory on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie’s standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will

produce non-privileged documents, pursuant to Fed. R. Civ. P. 33(d), if any, from which the answer to this Interrogatory may be determined.

**INTERROGATORY NO. 6:**

(a) Describe each instance where any person has by word or deed or otherwise, including, without limitation, by misdirected mail, e-mail, telephone calls, orders or inquiries, suggested or reflected any confusion between Opposer and Applicant or their respective trademarks or goods or services; and

(b) Identify all persons knowledgeable about any such instances referred to in subparagraph (a) above and describe the nature of their knowledge.

**RESPONSE TO INTERROGATORY NO. 6:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the basis that it contains multiple subparts. Mycoskie further objects to this Interrogatory on the basis that it is overly broad and unduly burdensome in scope. Mycoskie further objects to this Interrogatory on the basis that the phrases “or otherwise” and “suggested or reflected” are vague and ambiguous as used therein. Mycoskie further objects to this Interrogatory on the basis that it is overly broad and unduly burdensome in scope in that it seeks the description of instances “suggest[ing] or reflect[ing]” types of potential confusion and/or mistake that have no bearing on the registrability of Mycoskie’s standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it is unaware of any instances of confusion as between Mycoskie and Opposer or Mycoskie’s TOMS mark and Opposer’s TOD’S mark.

**INTERROGATORY NO. 7:**

State whether Applicant was aware of Opposer’s TOD’S Marks prior to:

(a) July 8, 2013, when Applicant filed the Application;

(b) any use by Applicant of Applicant’s Mark in the United States or in commerce in connection with the goods identified in the Application; or

(c) any use by Applicant of Applicant's Mark in the United States or in commerce in connection with any goods or services.

**RESPONSE TO INTERROGATORY NO. 7:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the basis that it contains multiple subparts. Mycoskie further objects to this Interrogatory on the basis that it is overly broad and unduly burdensome in scope. Mycoskie further objects to this Interrogatory on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks information that is not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that despite reasonable inquiry it is unable to identify precise responses to the foregoing inquiries inasmuch as, among other things, Mycoskie is an organization comprised of numerous individuals each of which may or may not have obtained awareness of Opposer's TOD'S marks at different times and under different circumstances. Nevertheless, Mycoskie states that it was generally aware of the existence of the Tod's brand prior to July 2013.

**INTERROGATORY NO. 8:**

Identify all "identical and/or related products and services" that Applicant contends have co-existed under Opposer's TOD'S Marks and Applicant's Mark, as alleged in paragraph 5 of Applicant's "Facts Common To All Affirmative Defenses" in its Answer in this opposition, and with respect to all such products or services:

- (a) Identify the period of time during which Applicant alleges such co-existence took place;
- (b) Identify all retail locations in which Applicant contends such co-existence took place; and
- (c) State whether use of the TOMS mark in connection with any such identified products or services was made in the form of Applicant's TOMS Design Mark.

**RESPONSE TO INTERROGATORY NO. 8:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the basis that it contains multiple subparts. Mycoskie further objects to this Interrogatory on the basis that it is overly broad and unduly burdensome in scope. Mycoskie further objects to this Interrogatory on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks information that is not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce non-privileged documents, pursuant to Fed. R. Civ. P. 33(d), if any, from which the answer to this Interrogatory may be determined.

**INTERROGATORY NO. 9:**

Identify all retail stores in the United States in which products bearing Applicant's Mark are sold.

**RESPONSE TO INTERROGATORY NO. 9:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the grounds that it is vague and ambiguous as to time. Mycoskie further objects to this Interrogatory to the extent seeks information outside Mycoskie's possession, custody or control. Mycoskie further objects to this Interrogatory on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks information that is not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will

produce non-privileged documents, pursuant to Fed. R. Civ. P. 33(d), if any, from which the answer to this Interrogatory may be determined.

**INTERROGATORY NO. 10:**

Identify each product or service on or in connection with which Applicant uses or has used Applicant's Mark in the United States or in commerce, and for each such product or service:

(a) Identify the date of first use of Applicant's Mark in connection with such product or service; and

(b) Identify the annual volume of sales (in dollars and units) made under Applicant's Mark by Applicant in the United States or commerce for each year from the date of first use to the present.

**RESPONSE TO INTERROGATORY NO. 10:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the basis that it contains multiple subparts. Mycoskie further objects to this Interrogatory on the basis that it is duplicative of other Interrogatories, including Interrogatory No. 5. Mycoskie further objects to this Interrogatory on the grounds that it is overly broad and unduly burdensome in scope. Mycoskie further objects to this Interrogatory on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks information that is not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce non-privileged documents, pursuant to Fed. R. Civ. P. 33(d), if any, from which the answer to this Interrogatory may be determined.

**INTERROGATORY NO. 11:**

Identify each different stylization and/or design format in which Applicant has used marks comprising or containing the word TOMS in the United States or in commerce, and with respect to each such stylization and/or design format, identify the period of time during which such use has been

made and the goods or services on or in connection with which such use has been made.

**RESPONSE TO INTERROGATORY NO. 11:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the basis that it contains multiple subparts. Mycoskie further objects to this Interrogatory on the basis that it is duplicative of other Interrogatories, including Interrogatory No. 5. Mycoskie further objects to this Interrogatory on the grounds that it is overly broad and unduly burdensome in scope. Mycoskie further objects to this Interrogatory on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce non-privileged documents, pursuant to Fed. R. Civ. P. 33(d), if any, sufficient to identify the each different stylization and/or design format in which Mycoskie has used marks comprising or containing the word TOMS in the United States or in commerce in connection with goods covered by International Class 18.

**INTERROGATORY NO. 12:**

Describe each context in which Applicant uses marks containing or comprising the word TOMS in the United States or in commerce in a form other than shown in Applicant's TOMS Design Mark.

**RESPONSE TO INTERROGATORY NO. 12:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the basis that it contains multiple subparts. Mycoskie further objects to this Interrogatory on the basis that it is duplicative of other Interrogatories, including Interrogatory No. 11. Mycoskie further objects to this Interrogatory on

the basis that the phrase “context in which” is vague and ambiguous as used therein. Mycoskie further objects to this Interrogatory on the grounds that it is overly broad and unduly burdensome in scope. Mycoskie further objects to this Interrogatory on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie’s standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie refers to its response to Interrogatory No. 11.

**INTERROGATORY NO. 13:**

State whether Applicant has any documentation, including, without limitation, business plans, marketing plans, memos, correspondence or draft proposals of any kind, reflecting Applicant’s bona fide intention prior to or as of July 8, 2013 to use Applicant’s Mark in the United States or in commerce in connection with each of the goods identified in the Application, and if so, identify all such documentation.

**RESPONSE TO INTERROGATORY NO. 13:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the basis that it contains multiple subparts. Mycoskie further objects to this Interrogatory on the grounds that it is overly broad and unduly burdensome in scope. Mycoskie further objects to this Interrogatory on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie’s standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce non-privileged documents, pursuant to Fed. R. Civ. P. 33(d), sufficient to identify its bona fide intention prior to or as of July 8, 2013 to use the TOMS mark in commerce in connection with each of the goods identified in its Application to register the TOMS standard character word

mark in International Class 18.

**INTERROGATORY NO. 14:**

Describe in detail all steps taken by Applicant prior to July 8, 2013 in connection with the intended use of Applicant's Mark in the United States or in commerce in connection with each of the goods identified in the Application.

**RESPONSE TO INTERROGATORY NO. 14:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the grounds that the phrase "all steps taken" is vague and ambiguous as used therein. Mycoskie further objects to this Interrogatory on the basis that it is overly broad and unduly burdensome in scope in that it seeks a detailed description of "all steps taken" by Mycoskie in connection with the intended use of Mycoskie's TOMS mark in International Class 18 prior to July 8, 2013 — in other words, a detailed description of every action relating to the design, development and distribution of products bearing the TOMS mark in International Class 18 prior to the filing of Mycoskie's application to register the TOMS mark in International Class 18. Mycoskie further objects to this Interrogatory on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks information that is not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that work began on handbag concepts on or about May 22, 2013, and that continuing efforts to develop a handbag line under Mycoskie's TOMS mark followed.

**INTERROGATORY NO. 15:**

Describe in detail all steps taken by Applicant on or after July 8, 2013 in connection with the intended use of Applicant's Mark in the United States or in commerce in connection with each of the goods identified in the Application.



**RESPONSE TO INTERROGATORY NO. 15:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the grounds that the phrase “all steps taken” is vague and ambiguous as used therein. Mycoskie further objects to this Interrogatory on the basis that it is overly broad and unduly burdensome in scope in that it seeks a detailed description of “all steps taken” by Mycoskie in connection with the intended use of Mycoskie’s TOMS mark in International Class 18 on or after July 8, 2013 — in other words, a detailed description of every action relating to the design, development and distribution of products bearing the TOMS mark in International Class 18 after the filing of Mycoskie’s application to register the TOMS mark in International Class 18. Mycoskie further objects to this Interrogatory on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks information that is not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie’s standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce non-privileged documents, pursuant to Fed. R. Civ. P. 33(d), sufficient to demonstrate the intended use the TOMS mark in connection with goods covered by International Class 18 that postdates July 8, 2013.

**INTERROGATORY NO. 16:**

Describe with specificity the factual basis upon which Applicant alleges that the current opposition is barred by:

- (a) Estoppel;
- (b) waiver;
- (c) laches;

- (d) acquiescence; and
- (e) unclean hands.

**RESPONSE TO INTERROGATORY NO. 16:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Interrogatory on the basis that it contains multiple subparts. Mycoskie further objects to this Interrogatory on the grounds that discovery is ongoing and the Interrogatory is premature. Mycoskie further objects to this Interrogatory to the extent it seeks information that is privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Dated: February 17, 2015

ARNOLD & PORTER LLP

By: 

Louis S. Ederer  
399 Park Avenue  
New York, New York 10022  
Tel: 212.715.1000  
Fax: 212.715.1399

*Attorneys for Applicant  
Mycoskie, LLC*

**Verification for Applicant Mycoskie, LLC's Responses to  
Opposer Tod's S.P.A.'s First Set of Interrogatories**

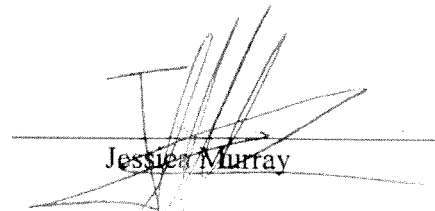
I, Jessica Murray, declare:

I am Intellectual Property Director of Toms Shoes LLC, parent company of applicant Mycoskie LLC in the above-entitled proceeding, and I am authorized to make this verification on applicant's behalf.

I have read the foregoing responses contained in **RESPONSES AND OBJECTIONS TO OPPOSER TOD'S S.P.A.'S FIRST SET OF INTERROGATORIES** and know the contents thereof. Because the matters stated in the document identified above are a corporate response, such matters are not all necessarily within my personal knowledge or within the personal knowledge of any single individual.

Subject to these limitations, I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct to the best of my knowledge.

Executed in Los Angeles, California, on this 17th day of February, 2015.

  
Jessica Murray

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing  
**RESPONSES AND OBJECTIONS TO OPPOSER TOD'S S.P.A.'S FIRST SET OF  
INTERROGATORIES** was served upon the following attorneys of record for Opposer Tod's  
S.p.A. by U.S. Mail, this 17th day of February, 2015:

Richard S. Mandel, Esq.  
COWAN, LIEBOWITZ & LATMAN, P.C.  
1133 Avenue of the Americas  
New York, New York 10036-6799

*Attorneys for Opposer Tod's S.p.A.*

A handwritten signature in dark ink, appearing to read 'Matthew T. Salzmann', is written over a horizontal line.

Matthew T. Salzmann

# **EXHIBIT 33**

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. 86/004,044  
Filed: July 8, 2013  
For Mark: TOMS  
Published in the *Official Gazette*: April 29, 2014

TOD'S S.P.A.,	)	Opposition No.: 91218001
	)	
Opposer,	)	<b>APPLICANT'S RESPONSES AND</b>
	)	<b>OBJECTIONS TO OPPOSER TOD'S</b>
v.	)	<b>S.P.A.'S FIRST REQUEST FOR</b>
	)	<b>PRODUCTION OF DOCUMENTS AND</b>
MYCOSKIE, LLC,	)	<b>THINGS</b>
	)	
Applicant.	)	

Applicant Mycoskie, LLC ("Mycoskie"), by and through its undersigned counsel, hereby responds to Opposer Tod's S.p.A. ("Tod's" or "Opposer")'s First Request for Production of Documents and Things (the "Requests") as follows:

**GENERAL OBJECTIONS**

Mycoskie makes the following General Objections to Tod's Requests, which apply to each Request regardless of whether the General Objections are expressly incorporated into the specific objections below:

1. Mycoskie objects to the Requests to the extent they seek documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. To the extent that Mycoskie responds to these Requests and/or produces responsive documents, it does not concede that such documents are relevant to this proceeding.

2. Mycoskie objects to the Requests to the extent they are vague, overbroad and unduly burdensome, and seek to impose obligations that exceed those under the Federal Rules of Civil Procedure and 37 C.F.R. § 2.120.

3. Mycoskie objects to the Requests to the extent they call for, or could be construed to call for, the disclosure of proprietary, trade secret or other commercially protected information for which no necessity and relevance has been shown, and which are without the protection of an appropriate protective order and the implementation of procedures that will ensure the continued confidentiality of such information.

4. Mycoskie objects to the Requests to the extent they seek documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law. Mycoskie does not waive, and intends to preserve, any applicable privilege or protection. In the event that any privileged or protected document or information is disclosed, such disclosure is inadvertent and will not constitute a waiver of any applicable privilege or protection.

5. Mycoskie objects to the Requests to the extent they seek documents outside of Mycoskie's possession, custody or control.

6. Mycoskie objects to the Requests to the extent they seek documents that are equally available to Tod's or that are otherwise available in the public domain. The burden of obtaining such documents is the same for Mycoskie as it is for Tod's.

7. Mycoskie objects to the Requests pursuant to Federal Rule of Civil Procedure 26(b)(2)(C) to the extent that the burden and/or expense of attempting to ascertain the requested materials outweighs any conceivable benefit considering the needs of this proceeding, the parties' resources, the importance of the issues at stake in the action, and the importance of the discovery in resolving the issues.

8. Mycoskie objects to the Requests to the extent they are unintelligible and/or incapable of being responded to in their current form. Accordingly, Mycoskie will produce

documents which it believes are responsive to each such Request and are relevant to the subject matter of this proceeding.

9. Mycoskie objects to the Requests pursuant to Federal Rule of Civil Procedure 26(b)(2)(C) to the extent that they are cumulative, duplicative, repetitive, and/or overlapping, or that the requested information can be obtained from some other source that is more convenient, less burdensome, or less expensive.

10. Mycoskie's responses to the Requests are made to the best of its present knowledge, information and belief. Said responses are at all times subject to such additional or different documentation or information that discovery or further investigation may disclose, and, while based on the present state of Mycoskie's recollection, are subject to such refreshment of recollection, and such additional knowledge of facts, as may result from Mycoskie's further discovery or investigation. Mycoskie reserves the right to make use of, or to introduce at any hearing or trial, documents responsive to the Requests but discovered subsequent to the date of these responses, including, but not limited to, any such documents obtained through subsequent discovery.

11. Mycoskie objects to each and every Request that does not limit itself to a clear and reasonably relevant time period. The absence of a limited time period makes the Requests overly broad and unduly burdensome in scope.

12. Mycoskie reserves all objections or other questions as to the competency, relevance, materiality, privilege or admissibility as evidence in any subsequent proceeding or trial of this or any other action, for any purpose whatsoever, of its responses herein, and any document or thing identified or provided in response to the Requests.

13. Mycoskie objects to the Requests to the extent they seek to require Mycoskie to



produce documents at a time and in a manner not mutually agreed upon or mandated by the Trademark Trial and Appeal Board. Mycoskie's production of documents will be made in a reasonable manner and on a rolling basis, subject to any subsequent agreement between the parties.

14. Mycoskie objects to the definition of "Applicant" on the grounds that it is overly broad and unduly burdensome and purports to impose obligations on Mycoskie to produce documents outside its possession, custody or control. For avoidance of doubt, Mycoskie's instant responses incorporate information and documents obtained from its parent company, TOMS Shoes, LLC, and said company's predecessors-in-interest.

#### **OBJECTIONS AND RESPONSES TO DOCUMENT REQUESTS**

##### **DOCUMENT REQUEST NO. 1:**

Specimens of each of the different goods sold by Applicant in the United States or in commerce in connection with Applicant's Mark, including, without limitation, each different color combination and each different design or stylization in which such mark is used by Applicant.

##### **RESPONSE TO DOCUMENT REQUEST NO. 1:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the grounds that it is overly broad and unduly burdensome in scope in that it seeks the production of a specimen of each and every good sold in the United States or in commerce in connection with Mycoskie's TOMS mark since April 2006, including a specimen of "each different color combination and each different design or stylization" in which Mycoskie's TOMS mark has been used. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International

Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce photographs of representative goods from each product or service class in which the TOMS mark is registered in the United States.

**DOCUMENT REQUEST NO. 2**

Specimens of each label, hangtag, tag, product package, package insert, sticker, hologram, package material or other device which bears Applicant's Mark, and which has been used by Applicant in the United States or in commerce.

**RESPONSE TO DOCUMENT REQUEST NO. 2:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the grounds that it is overly broad and unduly burdensome in scope in that it seeks the production of a specimen of each and every "label, hangtag, tag, product package, package insert, sticker, hologram, package material or other device" bearing Mycoskie's TOMS mark that has been used in the United States or in commerce since April 2006. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce and/or make available for inspection representative labels, hangtags, tags, product packages, package inserts, stickers, holograms and/or package materials used in connection with each product or service class in which the TOMS mark is registered in the United States, to the extent such materials exist within its possession, custody, or control and are located following a reasonably diligent search.

### **DOCUMENT REQUEST NO. 3**

Specimens of each point-of-sale material, circular, flyer, poster, sticker, sales sheet, leaflet, brochure, catalog, sign, price list, on-line or email advertisement, print advertisement, radio or television advertisement, service order list or other advertising material or promotional item which bears Applicant's Mark, and which has been used by Applicant in the United States or in commerce.

### **RESPONSE TO DOCUMENT REQUEST NO. 3:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the grounds that it is overly broad and unduly burdensome in scope in that it seeks the production of a specimen of each and every "point-of-sale material, circular, flyer, poster, sticker, sales sheet, leaflet, brochure, catalog, sign, price list, on-line or email advertisement, print advertisement, radio or television advertisement, service order list or other advertising material or promotional item" bearing Mycoskie's TOMS mark that has been used in the United States or in commerce since April 2006. Mycoskie further objects to this Request to the extent it is duplicative of Request No. 2. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce and/or make available for inspection representative promotional and advertising materials bearing Mycoskie's TOMS mark, to the extent such materials exist within its possession, custody, or control and are located following a reasonably diligent search.

### **DOCUMENT REQUEST NO. 4**

All documents concerning Applicant's conception, creation, design, clearance and/or selection of Applicant's Mark, including, without limitation, all documents concerning the reasons for Applicant's original selection of the term "TOMS" as a trademark and the intended

connotation of such designation.

**RESPONSE TO DOCUMENT REQUEST NO. 4:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that the terms “conception” and “selection” are vague and ambiguous as used therein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks “[a]ll documents” concerning Mycoskie’s “conception, creation, design, clearance and/or selection of” the TOMS mark. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie’s standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it calls for production of documents or information that is privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

**DOCUMENT REQUEST NO. 5**

All documents concerning any trademark searches or other searches, opinions, investigations, analyses or studies conducted or reviewed by or on behalf of Applicant concerning Applicant’s Mark.

**RESPONSE TO DOCUMENT REQUEST NO. 5:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that the phrase “other

searches” is vague and ambiguous as used therein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks “[a]ll documents” concerning any trademark searches or other searches, opinions, investigations, analyses or studies concerning Mycoskie’s TOMS mark. Mycoskie further objects to this Request to the extent it is duplicative of Request No. 4. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie’s standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it calls for production of documents or information that is privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

#### **DOCUMENT REQUEST NO. 6**

All documents concerning Applicant’s adoption and first use of Applicant’s Mark in the United States or in commerce.

#### **RESPONSE TO DOCUMENT REQUEST NO. 6:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that the term “adoption” is vague and ambiguous as used therein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks “[a]ll documents” concerning Mycoskie’s “adoption and first use of” the TOMS mark in the United States or in commerce.

Mycoskie further objects to this Request to the extent it is duplicative of Request No. 4.

Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it calls for production of documents or information that is privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, sufficient to show Mycoskie's first use of the TOMS mark in United States commerce, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

#### **DOCUMENT REQUEST NO. 7**

Documents sufficient to identify all retail stores in the United States in which products bearing Applicant's Mark are sold and the period of time during which such products have been sold in such stores.

#### **RESPONSE TO DOCUMENT REQUEST NO. 7:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the grounds that it is overly broad and unduly burdensome in scope in that it seeks the production of documents sufficient to show "all retail stores in the United States" that have sold any products, in any product categories, bearing Mycoskie's TOMS mark since April 2006. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents sufficient to show all retail accounts in the United States to whom any products bearing Mycoskie's TOMS mark have been sold, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

**DOCUMENT REQUEST NO. 8**

Documents sufficient to identify each product or service on or in connection with which Applicant uses or has used Applicant's Mark in the United States or in commerce and the date of first use of Applicant's Mark in connection with each such product or service.

**RESPONSE TO DOCUMENT REQUEST NO. 8:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are available in the public domain.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

**DOCUMENT REQUEST NO. 9**

Documents sufficient to identify the annual volume of sales (in dollars and units) made under Applicant's Mark by Applicant in the United States or commerce for each year from the date of first use to the present with respect to each different product or service sold under Applicant's Mark.

**RESPONSE TO DOCUMENT REQUEST NO. 9:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set

forth herein. Mycoskie further objects to this Request on the grounds that it is overly broad and unduly burdensome in scope in that it seeks the production of documents sufficient to show annual sales for “each different product or service sold under” Mycoskie’s TOMS mark since April 2006. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie’s standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents sufficient to show annual sales (dollars and units) of products bearing Mycoskie’s TOMS mark in the United States, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

**DOCUMENT REQUEST NO. 10**

Documents sufficient to identify (a) each different stylization and/or design format in which Applicant is using or has used marks comprising or containing the word TOMS in the United States or in commerce; (b) the period of time during which each such use has been made; and (c) the goods or services on or in connection with which such use has been made.

**RESPONSE TO DOCUMENT REQUEST NO. 10:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the grounds that it is overly broad and unduly burdensome in scope in that it seeks the production of documents sufficient to identify “each different stylization and/or design format in which Applicant is using or has used marks comprising or containing the word TOMS in the United States”, “the period of time during which each such use has been made”, and “the goods or services on or in connection with which such use has been made.” Mycoskie further objects to this Request to the extent it is duplicative



of Request No. 1. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

**DOCUMENT REQUEST NO. 11**

All documents concerning the advertising, marketing or promotion of goods sold under Applicant's Mark in the United States or in commerce, including, without limitation, any media plans, public relations materials, press kits and correspondence with advertising agencies, public relations firms, media planners, graphic designers, web site designers or any other such entities in the advertising and promotional field.

**RESPONSE TO DOCUMENT REQUEST NO. 11:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning the advertising, marketing or promotion of goods sold under Mycoskie's TOMS mark in the United States or in commerce. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will

produce relevant, responsive, non-privileged media plans, public relations materials and press kits, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

**DOCUMENT REQUEST NO. 12**

Documents sufficient to identify the amount of money expended by Applicant in advertising and promoting goods sold under Applicant's Mark in the United States or in commerce for each year from the date of first use to the present.

**RESPONSE TO DOCUMENT REQUEST NO. 12:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

**DOCUMENT REQUEST NO. 13**

All documents concerning each trade show, convention, exposition or conference at which goods sold under Applicant's Mark have been displayed, advertised, promoted, offered for sale or sold in the United States or in commerce.

**RESPONSE TO DOCUMENT REQUEST NO. 13:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that the term "conference" is vague and ambiguous as used therein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning each trade show, convention, exposition or conference at which goods sold

under Mycoskie's TOMS mark have been displayed, advertised, promoted, offered for sale or sold in the United States or in commerce. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents sufficient to identify representative trade shows, conventions or expositions at which goods sold under Mycoskie's TOMS mark have been displayed, advertised, promoted, offered for sale or sold in the United States or in commerce, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

#### **DOCUMENT REQUEST NO. 14**

All documents concerning any actual or proposed authorization, license, assignment, grant, conveyance or other transfer of the right from or on behalf of Applicant to any third party to use Applicant's Mark in the United States or in commerce.

#### **RESPONSE TO DOCUMENT REQUEST NO. 14:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning any actual or proposed authorization, license, assignment, grant, conveyance or other transfer of the right from or on behalf of Mycoskie to any third party to use the TOMS mark in the United States or in commerce. Mycoskie further objects to this Request on the basis that it is not

reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents sufficient to identify any actual authorization, license, assignment, grant, conveyance or other transfer of the right from or on behalf of Mycoskie to any third party to use the TOMS mark in the United States or in commerce, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

#### **DOCUMENT REQUEST NO. 15**

Documents sufficient to identify each website, web auction, web hosting, web listing, web posting, web page or social media page (whether owned by Applicant or third parties), including its Internet address, on or through which goods sold under Applicant's Mark have been or are currently being promoted, advertised, displayed, offered for sale, sold or otherwise distributed.

#### **RESPONSE TO DOCUMENT REQUEST NO. 15:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request to the extent it seeks documents that are available in the public domain. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of documents sufficient to identify "each website, web auction, web hosting, web listing, web posting, web page or social media page (whether owned by Applicant or third parties)" on or through which goods bearing Mycoskie's TOMS mark have been or are currently being promoted, advertised,

displayed, offered for sale, sold or otherwise distributed. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents sufficient to identify representative authorized e-commerce resellers of goods sold under the TOMS mark, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

#### **DOCUMENT REQUEST NO. 16**

Apart from the current opposition, all documents concerning any objections, claims, demands or actions lodged or filed against the use or registration or proposed use or registration of Applicant's Mark, including, without limitation, cease and desist letters, complaints and/or Notices of Opposition.

#### **RESPONSE TO DOCUMENT REQUEST NO. 16:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the grounds that it is vague and ambiguous, especially as to time and geographic scope. Mycoskie further objects to this Request to the extent it seeks documents that are equally available to Opposer or that are otherwise available in the public domain. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning any objections, claims, demands or actions lodged or filed against Mycoskie's use or registration of the TOMS mark. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the

registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

**DOCUMENT REQUEST NO. 17**

All documents concerning any objections, claims, demands or actions lodged or filed by Applicant against third parties concerning the use or registration or proposed use or registration of any marks alleged to violate Applicant's rights in Applicant's Mark, including, without limitation, cease and desist letters, complaints and/or Notices of Opposition.

**RESPONSE TO DOCUMENT REQUEST NO. 17:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the grounds that it is vague and ambiguous, especially as to time and geographic scope. Mycoskie further objects to this Request to the extent it seeks documents that are equally available to Opposer or that are otherwise available in the public domain. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning any objections, claims, demands or actions lodged or filed by Mycoskie against third parties concerning the use or registration or proposed use or registration of any marks alleged to violate Mycoskie's TOMS mark. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18.

Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

**DOCUMENT REQUEST NO. 18**

All documents concerning Opposer or Opposer's TOD'S Marks, and/or any goods or services marketed, manufactured, distributed, offered for sale, sold, licensed or rendered by Opposer in connection with Opposer's TODS Marks.

**RESPONSE TO DOCUMENT REQUEST NO. 18:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning Opposer or Opposer's TOD'S marks. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent

search.

**DOCUMENT REQUEST NO. 19**

All documents concerning Applicant's knowledge of Opposer, Opposer's TOD'S Marks, and/or any goods or services marketed, manufactured, distributed, offered for sale, sold, licensed or rendered by Opposer in connection with Opposer's TOD'S Marks prior to:

- (a) July 8, 2013, when Applicant filed the Application.
- (b) any use by Applicant of Applicant's Mark in the United States or in commerce in connection with the goods identified in the Application; or
- (c) any use by Applicant of Applicant's Mark in the United States or in commerce in connection with any goods or services.

**RESPONSE TO DOCUMENT REQUEST NO. 19:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning Opposer, Opposer's TOD'S marks and/or any goods or services marketed, manufactured, distributed, offered for sale, sold, licensed or rendered by Opposer in connection with Opposer's TOD'S Marks. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.



### **DOCUMENT REQUEST NO. 20**

All documents concerning any consumer studies, market research, focus groups, surveys, polls or other research, studies or data compiled or commissioned by or on behalf of Applicant concerning Applicant's Mark.

### **RESPONSE TO DOCUMENT REQUEST NO. 20:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning "concerning any consumer studies, market research, focus groups, surveys, polls or other research, studies or data compiled or commissioned by or on behalf of" Mycoskie relating to the TOMS mark. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

### **DOCUMENT REQUEST NO. 21**

All documents reflecting or indicating any confusion on the part of any member of the public between Opposer and Applicant or their respective trademarks or goods or services.

### **RESPONSE TO DOCUMENT REQUEST NO. 21:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that it is not reasonably

calculated to lead to the discovery of admissible evidence to the extent it calls for production of documents concerning anything other than United States-based confusion as between the use of Mycoskie's TOMS mark and Opposer's TOD'S mark on goods covered by International Class 18. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning "any confusion on the part of any member of the public between Opposer and Applicant or their respective trademarks or goods or services." Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

#### **DOCUMENT REQUEST NO. 22**

All documents identified in Applicant's Initial Disclosures in this opposition.

#### **RESPONSE TO DOCUMENT REQUEST NO. 22:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

**DOCUMENT REQUEST NO. 23**

All documents concerning the actual or intended channels of trade for goods or services sold or rendered or intended to be sold or rendered in connection with Applicant's Mark in the United States or in commerce.

**RESPONSE TO DOCUMENT REQUEST NO. 23:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning "the actual or intended channels of trade for goods or services sold or rendered or intended to be sold or rendered in connection with" Mycoskie's TOMS mark. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents sufficient to demonstrate the intended channels of trade for goods sold under the TOMS mark in International Class 18, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

#### **DOCUMENT REQUEST NO. 24**

All documents concerning the actual or intended target audience for goods or services sold or intended to be sold in connection with Applicant's Mark in the United States or in commerce, including, without limitation, documents concerning the age, gender and other demographics of such customers or potential customers.

#### **RESPONSE TO DOCUMENT REQUEST NO. 24:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the grounds that the phrase "intended target audience" is vague and ambiguous as used therein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning "the actual or intended target audience for goods or services sold or intended to be sold in connection with" Mycoskie's TOMS mark. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents sufficient to demonstrate its target consumers for products to be sold under the TOMS mark in International Class 18, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

#### **DOCUMENT REQUEST NO. 25**

All documents, including, without limitation, business plans, marketing plans, memos, correspondence or draft proposals of any kind, reflecting Applicant's bona fide intention prior to or as of July 8, 2013 to use Applicant's Mark in the United States or in commerce in connection

with each of the goods identified in the Application.

**RESPONSE TO DOCUMENT REQUEST NO. 25:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of “[a]ll documents” concerning Mycoskie’s “bona fide intention prior to or as of July 8, 2013 to use” Mycoskie’s TOMS mark in International Class 18. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie’s standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents sufficient to demonstrate a bona fide intent to use the TOMS mark in connection with goods covered by International Class 18 that predate July 8, 2013, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

**DOCUMENT REQUEST NO. 26**

All documents concerning any steps taken by Applicant prior to July 8, 2013 in connection with the intended use of Applicant’s Mark in the United States or in commerce in connection with each of the goods identified in the Application.

**RESPONSE TO DOCUMENT REQUEST NO. 26:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request to the extent it is duplicative of Request

No. 25. Mycoskie further objects to this Request on the grounds that the phrase “any steps taken” is vague and ambiguous as used therein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of “[a]ll documents” concerning “any steps taken” by Mycoskie in connection with the intended use of Mycoskie’s TOMS mark in International Class 18 prior to July 8, 2013 — in other words, every document concerning the design, development and distribution of products bearing the TOMS mark in International Class 18 prior to the filing of Mycoskie’s application to register the TOMS mark in International Class 18. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie’s standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents sufficient to demonstrate a bona fide intent to use the TOMS mark in connection with goods covered by International Class 18 that predate July 8, 2013, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

#### **DOCUMENT REQUEST NO. 27**

All documents concerning any steps taken by Applicant on or after July 8, 2013 in connection with the intended use of Applicant’s Mark in the United States or in commerce in connection with each of the goods identified in the Application.

#### **RESPONSE TO DOCUMENT REQUEST NO. 27:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set

forth herein. Mycoskie further objects to this Request on the grounds that the phrase “any steps taken” is vague and ambiguous as used therein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of “[a]ll documents” concerning “any steps taken” by Mycoskie in connection with the intended use of Mycoskie’s TOMS mark in International Class 18 on or after July 8, 2013. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents sufficient to demonstrate a bona fide intent to use the TOMS mark in connection with goods covered by International Class 18, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

#### **DOCUMENT REQUEST NO. 28**

All documents concerning each distributor, supplier, manufacturer, vendor, licensee or any other third party with whom Applicant had any discussions concerning the intended use of Applicant’s Mark in the United States or in commerce in connection with the goods identified in the Application.

#### **RESPONSE TO DOCUMENT REQUEST NO. 28:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of “[a]ll documents” concerning “each distributor, supplier, manufacturer, vendor, licensee or any other third party with whom Applicant had any discussions concerning the intended use of Applicant’s Mark in the United States or in commerce in connection with the goods identified in the Application.” Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the

discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

**DOCUMENT REQUEST NO. 29**

All documents concerning any instructions on the manner in which Applicant's Mark or any other marks comprising or containing the word TOMS, including, without limitation, Applicant's TOMS Design Mark, is to be used, including, but not limited to, any style guides concerning the usage of such marks.

**RESPONSE TO DOCUMENT REQUEST NO. 29:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning instructions on the manner in which Mycoskie's TOMS marks are to be used. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.



### **DOCUMENT REQUEST NO. 30**

All documents concerning the co-existence of “identical and/or related products and services” under Opposer’s TOD’S Marks and Applicant’s Mark, as alleged in paragraph 5 of Applicant’s “Facts Common To All Affirmative Defenses” in its Answer in this opposition, including, without limitation, documents concerning the period of time during which such alleged co-existence took place, the retail locations in which such alleged co-existence took place and the format and/or stylization in which Applicant’s Mark was used.

### **RESPONSE TO DOCUMENT REQUEST NO. 30:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of “[a]ll documents” concerning the co-existence of “identical and/or related products and services” under Opposer’s TOD’S Marks and Mycoskie’s TOMS mark. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents sufficient to demonstrate and identify the co-existence of “identical and/or related products and services” under Opposer’s TOD’S mark and Mycoskie’s TOMS mark, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

### **DOCUMENT REQUEST NO. 31**

All documents reflecting Applicant’s use in the United States or in commerce of marks comprising or containing the word TOMS in a form other than shown in Applicant’s TOMS Design Mark.

### **RESPONSE TO DOCUMENT REQUEST NO. 31:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request to the extent it is duplicative of Request No. 1. Mycoskie further objects to this Request on the basis that it is overly broad and unduly

burdensome in scope in that it seeks the production of “[a]ll documents” concerning the use of Mycoskie’s TOMS mark “in a form other than” Mycoskie’s TOMS Design Mark in the United States or in commerce. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie’s standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents sufficient to show representative examples of Mycoskie’s use of the TOMS mark in a form other than the TOMS Design Mark, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

#### **DOCUMENT REQUEST NO. 32**

All documents concerning the extent to which and/or contexts in which Applicant uses marks comprising or containing the word TOMS in a form other than shown in Applicant’s TOMS Design Mark in the United States or in commerce.

#### **RESPONSE TO DOCUMENT REQUEST NO. 32:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the grounds that the phrases “the extent to which” and “contexts in which” are vague and ambiguous as used therein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of “[a]ll documents” concerning the use of Mycoskie’s TOMS mark “in a form other than” Mycoskie’s TOMS Design Mark. Mycoskie further objects to this Request on

the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request on the basis that it is duplicative of Request No. 31. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents sufficient to show representative examples of Mycoskie's use of the TOMS mark in a form other than the TOMS Design Mark, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

**DOCUMENT REQUEST NO. 33**

All documents concerning any decisions to register Applicant's Mark in standard character form as opposed to the form of Applicant's TOMS Design Mark.

**RESPONSE TO DOCUMENT REQUEST NO. 33:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request to the extent that it incorrectly implies that Mycoskie has not also sought registration of its TOMS Design Mark in International Class 18. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning "any decisions to register" Mycoskie's TOMS mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

**DOCUMENT REQUEST NO. 34**

All documents concerning any decision to discontinue, phase out, limit or reduce use or registration of Applicant's TOMS Design Mark.

**RESPONSE TO DOCUMENT REQUEST NO. 34:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the grounds that the phrases and/or terms "discontinue", "phase out", "limit" and "reduce use or registration of" are vague and ambiguous as used therein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning "any decision to discontinue, phase out, limit or reduce use or registration of Applicant's TOMS Design Mark". Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

**DOCUMENT REQUEST NO. 35**

All documents concerning any expansion plans with respect to Applicant's Mark.

**RESPONSE TO DOCUMENT REQUEST NO. 35:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the grounds that the phrase "expansion plans" is vague and ambiguous as used therein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning any "expansion plans" relating to Mycoskie's TOMS mark. Mycoskie further objects to this Request on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks materials that are not relevant to the subject matter of this proceeding, namely the registrability of Mycoskie's standard character TOMS word mark in International Class 18. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

**DOCUMENT REQUEST NO. 36**

All documents concerning communications between Opposer and Appicant [sic] concerning the current opposition or any dispute concerning the use or registration of Opposer's TOD [sic] Marks and Applicant's Mark.

**RESPONSE TO DOCUMENT REQUEST NO. 36:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents" concerning communications between Mycoskie and Opposer concerning the use of registration of Opposer's TOD Marks or Mycoskie's TOMS mark. Mycoskie further objects to this Request on the basis that it seeks documents that are equally available to Tod's, and that the burden of obtaining such

documents is the same for Mycoskie as it is for Tod's. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

#### **DOCUMENT REQUEST NO. 37**

All documents identified or otherwise referred to by Applicant in answering Opposer's First Set of Interrogatories above.

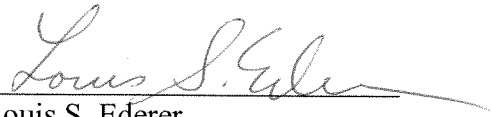
#### **RESPONSE TO DOCUMENT REQUEST NO. 37:**

Mycoskie incorporates by reference the above-stated General Objections as if fully set forth herein. Mycoskie further incorporates by reference each and every objection contained in its response and objections to Opposer's First Set of Interrogatories. Mycoskie further objects to this Request on the basis that it is overly broad and unduly burdensome in scope in that it seeks the production of "[a]ll documents identified or otherwise referred to by" Mycoskie in responding to Opposer's First Set of Interrogatories. Mycoskie further objects to this Request to the extent it seeks documents that are privileged or exempt from discovery under the attorney-client privilege, work product doctrine, or other privilege or exemption under applicable law.

Subject to and without waiving the foregoing objections, Mycoskie states that it will produce relevant, responsive, non-privileged documents, if any, to the extent such documents exist within its possession, custody, or control and are located following a reasonably diligent search.

Dated: February 17, 2015

ARNOLD & PORTER LLP

By: 

Louis S. Ederer  
399 Park Avenue  
New York, New York 10022  
Tel: 212.715.1000  
Fax: 212.715.1399

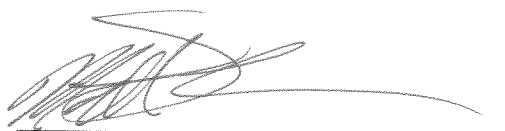
*Attorneys for Applicant  
Mycoskie, LLC*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing  
**APPLICANT'S RESPONSES AND OBJECTIONS TO OPPOSER TOD'S S.P.A.'S FIRST  
REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS** was served upon the  
following attorneys of record for Opposer Tod's S.p.A. by U.S. mail, this 17th day of February,  
2015:

Richard S. Mandel, Esq.  
COWAN, LIEBOWITZ & LATMAN, P.C.  
1133 Avenue of the Americas  
New York, New York 10036-6799

*Attorneys for Opposer Tod's S.p.A.*

A handwritten signature in dark ink, appearing to read 'Matthew T. Salzmann', is written over a horizontal line.

Matthew T. Salzmann



# **EXHIBIT 34**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

----- X  
TOD'S S.P.A.,

*Opposer,*

v.

MYCOSKIE, LLC,

*Applicant.*  
----- X

**Opposition No.: 91218001**

**APPLICANT'S FIRST SET OF  
INTERROGATORIES DIRECTED  
TO OPPOSER TOD'S S.P.A.**

PROPOUNDING PARTY: Mycoskie, LLC

RESPONDING PARTY: Tod's S.p.A.

SET NUMBER: One

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure and 37 C.F.R. § 2.120, Applicant Mycoskie, LLC, by and through its undersigned attorneys, hereby directs its First Set of Interrogatories (the "Interrogatories") to Opposer Tod's S.p.A., to be answered separately and fully, in writing and under oath, within thirty (30) days of the date of service hereof.

The Interrogatories are governed by the following Definitions and Instructions:

**DEFINITIONS**

As used herein, the terms below shall have the following meanings:

1. "Mycoskie" and "Applicant" shall refer to Applicant Mycoskie, LLC, including any subsidiaries, parents, affiliates, divisions, agents, servants, employees, representatives, officers, directors, accountants, attorneys, persons or entities under Mycoskie's control, or acting or purporting to act on behalf of Mycoskie.

2. “Tod’s,” “You” or “Your” shall refer to Opposer Tod’s S.p.A., and any of its subsidiaries, parents, affiliates, divisions, licensors, licensees, agents, servants, employees, representatives, officers, directors, accountants, attorneys, and investigators, and any other persons or entities under Tod’s control, or acting or purporting to act on behalf of Tod’s.

3. “Application” shall refer to the U.S. Trademark application (Serial No. 86/004,044) Mycoskie filed on July 8, 2013 to register TOMS in International Class 18.

4. The “TOMS Mark” and “Applicant’s Mark” shall refer to the standard character TOMS word mark that is the subject of the Application, and other registrations and/or applications for the standard character TOMS word mark owned by Mycoskie.

5. “Notice of Opposition” shall refer to the Notice of Opposition Tod’s filed with the Trademark Trial and Appeal Board of the United States Patent and Trademark Office on August 25, 2014 against the Application.

6. The “TOD’S Mark” shall refer to the TOD’S mark, whether used in connection with the federal registrations listed in Paragraph 4 of the Notice of Opposition or otherwise.

7. “Document” shall include, without limitation, all written or graphic matter or any other means of preserving thought or expression of every type and description regardless of origin or location, whether written, recorded, transcribed, taped, punched, filmed, microfilmed, or in any other way produced, reproduced or recorded, and including, but not limited to: originals, drafts, computer-sorted and computer-retrievable information, copies or duplicates that are marked with any notation or annotation, copies or duplicates that differ in any way from the original, correspondence, memoranda, reports, notes, minutes, contracts, agreements, books, records, checks, vouchers, invoices, purchase orders, ledgers, diaries, logs, calendar notes, computer printouts, computer disks, card files, lists of persons attending meetings or

conferences, sketches, diagrams, calculations, evaluations, analyses, directions, work papers, press clippings, sworn or unsworn statements of employees, requisitions, manuals or guidelines, audit work papers, financial analyses, tables of organizations, charts, graphs, indices, advertisements or other promotional materials, audited and unaudited financial statements, trade letters, trade publications, newspapers or newsletters, diagrams, photographs, e-mail, electronic or mechanical records, telegrams, telecopies, audiotapes, and all other receptacles or repositories housing or containing such documents, and all other media used to record, in any form, information. A draft, annotated or otherwise non-identical copy is a separate document within the meaning of this term. "Document" shall also include any removable "Post-It" notes or other attachments affixed to any of the foregoing, as well as the file, folder tabs, and labels appended to or containing any documents. "Document" expressly includes all Electronic Data stored on any Electronic Media.

8. "Electronic Data" shall mean the original (or identical duplicate when the original is not available) and any non-identical copies (whether non-identical because of notes made on copies or attached comments, annotations, marks, transmission notations, or highlighting of any kind) of writings of every kind and description whether inscribed by mechanical, facsimile, electronic, magnetic, digital, or other means. "Electronic Data" includes, by way of example and not by limitation, computer programs (whether private, commercial or work-in-progress), programming notes or instructions, activity listings of electronic mail receipts and/or transmittals, output resulting from the use of any software program, including word processing documents, spreadsheets, database files, charts, graphs and outlines, electronic mail, and any and all miscellaneous files and/or file fragments, regardless of the media on which they reside and regardless of whether said Electronic Data exists in an active file, deleted file or file fragment.

“Electronic Data” includes, but is not limited to, any and all items stored on computer memories, hard disks, diskettes and cartridges, network drives, network memory storage, archived tapes and cartridges, backup tapes, floppy disks, CD-ROMs, removable media such as Zip disks and their equivalent, magnetic tapes of all types, microfiche, and any other vehicle used for digital data storage and/or transmittal. “Electronic Data” also includes the file, folder tabs, and/or containers and labels appended to, or associated with each original and/or copy.

9. “Electronic Media” shall mean any magnetic or other storage media device used to record Electronic Data. Electronic Media devices may include, but are not limited to, computer memories, hard disks, diskettes and cartridges, network drives, network memory storage, archived tapes and cartridges, backup tapes, floppy disks, CD-ROM, removable media such as Bernoulli Boxes and their equivalent, magnetic tapes of all types, microfiche, punched cards, and any other vehicle used for digital data storage and/or transmittal.

10. “Concerning” shall mean directly or indirectly, in whole or in part, referring to, relating to, connected with, commenting on, discussing, impacting upon, affecting, responding to, explaining, showing, indicating, describing, analyzing, reflecting or constituting.

11. “Market Research” shall mean any type of research, study survey, or analysis of consumers or potential consumers of a product or potential product, including, but not limited to, polls, focus groups, consumer surveys, market analyses, behavioral analyses, and consumer research, whether or not such investigations were completed, discontinued, or fully carried out. As used herein, “Market Research” also includes all research materials sufficient to show the complete results and methods of the research, including, but not limited to, summary reports, screening questionnaires, coding materials, and verbatim responses of survey subjects.

12. “Person” shall mean any natural person, corporation, partnership, company, joint venture, trust, agency, governmental agency or department, and any other business, governmental, legal, for-profit or nonprofit organization, association or entity.

13. “Identify” shall mean to give, to the extent known, the person’s full name, present or last known address, and when referring to a natural person, additionally, the present or last known place of employment. Once a person has been identified in accordance with this paragraph, only the name of that person need be listed in response to subsequent discovery requesting the identification of that person. When referring to documents, “Identify” shall mean to give, to the extent known, the (a) type of document; (b) general subject matter; (c) date of the document; and (d) author(s), addressee(s), and recipient(s).

### **INSTRUCTIONS**

1. You are to answer each Interrogatory separately and under oath.
2. If You object to any Interrogatory contained herein, You may state the objection in the manner prescribed by the Federal Rules of Civil Procedure, but You shall answer the Interrogatory subject to the objection which You have stated.
3. If You contend that any Interrogatory herein calls for any information that is subject to the attorney-client privilege, work-product protection or any other legal privilege or protection, identify the specific grounds on which You are asserting a privilege or protection, on whose behalf the privilege or protection exists and each Person whom You know or believe has knowledge of such information.
4. If You are unable to answer fully any Interrogatory herein, You must answer to the extent possible, and provide whatever information is in Your possession, custody or control concerning any unanswered portion.

5. Unless otherwise stated in an individual Request, all Documents requested are for the period between the date of first use of the TOD'S Mark through the date of these Requests (the "Time Period"), and include: (a) all Documents dated, prepared or received during the Time Period; and (b) all Documents that relate to, refer to, or contain any information concerning all or any portion of the Time Period, or to any event or circumstance during that Time Period — whether dated, prepared, or received before, during, or after the Time Period.

6. The use of the singular shall be deemed to include the plural and vice versa. The terms "and" and "or" shall be interpreted liberally as conjunctive, disjunctive or both, depending on the context, so as to have their broadest meaning. Whenever necessary to bring within the scope of an Interrogatory information that might otherwise be construed to be outside its scope, the use of a verb in any tense shall be construed as the use of the verb in other tenses. The term "all" includes "any" and vice versa. Words in the masculine, feminine or neuter form include the others.

7. The obligation to produce information requested herein is of a continuing nature pursuant to Rule 26(e) of the Federal Rules of Civil Procedure.

## **INTERROGATORIES**

### **INTERROGATORY NO. 1**

Identify the Person most knowledgeable Concerning the sale of goods and/or services bearing the TOD'S Mark in the United States.

### **INTERROGATORY NO. 2**

Identify the Person most knowledgeable Concerning the advertising, marketing and promotion of goods and/or services bearing the TOD'S Mark in the United States.

**INTERROGATORY NO. 3**

Identify every retail outlet that sells and/or offers for sale goods and/or services bearing the TOD'S Mark in the United States.

**INTERROGATORY NO. 4**

Identify every Person with knowledge of any instance of confusion as between goods and/or services bearing the TOD'S Mark and goods and/or service bearing Applicant's Mark.

**INTERROGATORY NO. 5**

State the date on which You first became aware of Applicant.

**INTERROGATORY NO. 6**

Describe the circumstances under which You first became aware of Applicant, and Identify the Person(s) who first became aware of Applicant.

**INTERROGATORY NO. 7**

State the date on which You first became aware of Applicant's Mark.

**INTERROGATORY NO. 8**

Describe the circumstances under which You first became aware of Applicant's Mark, and Identify the Person(s) who first became aware of Applicant's Mark.

**INTERROGATORY NO. 9**

State the date on which you first became aware of Applicant's Mark being used on the goods that are the subject of the Application.

**INTERROGATORY NO. 10**

Describe the circumstances under which You first became aware of Applicant's Mark being used on the goods that are the subject of the Application, and Identify the Person(s) who first became aware of such use.



**INTERROGATORY NO. 11**

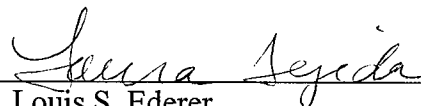
Identify any Market Research, brand recognition studies or similar research conducted by You or on by any Person on Your behalf regarding public perception of the TOD'S Mark in the United States.

**INTERROGATORY NO. 12**

Identify the Person most knowledgeable Concerning any Market Research, brand recognition studies or similar research conducted by You or on by any Person on Your behalf regarding public perception of the TOD'S Mark in the United States.

Dated: December 3, 2014

ARNOLD & PORTER LLP

By:   
Louis S. Ederer  
Laura W. Tejada  
399 Park Avenue  
New York, New York 10022  
Tel: 212.715.1000  
Fax: 212.715.1399

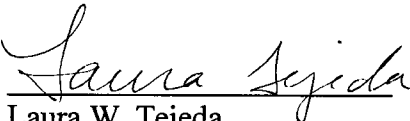
*Attorneys for Applicant  
Mycoskie, LLC*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on December 3, 2014 a copy of the foregoing  
APPLICANT'S FIRST SET OF INTERROGATORIES DIRECTED TO OPPOSER TOD'S  
S.P.A. was served by First Class Mail and email upon the following counsel of record for  
Opposer Tod's S.p.A.:

Richard S. Mandel  
Cowan Liebowitz & Latman PC  
1133 Avenue of the Americas  
New York, NY 10036

*Attorneys for Opposer  
Tod's S.p.A.*

  
\_\_\_\_\_  
Laura W. Tejeda

# **EXHIBIT 35**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 86/004,044  
Filed: July 8, 2013  
For Mark: TOMS  
Published in the Official Gazette: April 29, 2014

-----X

TOD'S S.P.A, :

Opposer, : Opposition No. 91218001

v. : **OPPOSER'S RESPONSES TO**  
**APPLICANT'S FIRST SET OF**  
**INTERROGATORIES**

MYCOSKIE, LLC,

Applicant. :

-----X

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and 37 C.F.R. §2.120,  
Opposer Tod's S.p.A. hereby responds to Applicant's First Set of Interrogatories as follows:

**GENERAL OBJECTIONS TO ALL REQUESTS**

A. Opposer objects to all interrogatories to the extent they purport to require the disclosure of information which is subject to the attorney-client privilege, the attorney's work product privilege or any other applicable privilege or immunity on the ground that such discovery is impermissible under Rule 26(b) of the Federal Rules of Civil Procedure. None of Opposer's specific responses shall be construed to mean that Opposer intends to provide privileged information or produce privileged documents in the absence of an intentional waiver. Any inadvertent disclosure of privileged information or production of privileged documents shall

not constitute a waiver of an otherwise valid claim of privilege, and any failure to assert a privilege as to certain information or documents shall not be deemed to constitute a waiver of the privilege as to any other information or documents so protected.

B. Opposer objects to all interrogatories to the extent they seek disclosure of confidential or proprietary technical, commercial, financial/economic or business information or trade secrets. Such information or documents containing or comprising such information will only be provided in accordance with the terms of the Board's standard protective order applicable to this case or some other protective order agreed to by the parties and entered by the Board.

C. Opposer objects to all interrogatories insofar as they purport to require the disclosure of information outside its possession, custody or control.

D. Opposer objects to the definition of "Tod's," "You" or "Your" on the grounds that they are overbroad and unduly burdensome and purport to impose obligations on Opposer to provide information outside its possession, custody or control.

E. Opposer states that it has made a good faith effort to respond to the interrogatories, but reserves the right to provide any additional information that might be located at any future time.

F. Without waiving these general objections and the additional objections set forth below in response to specific requests, Opposer responds, subject to these objections, as set forth below.

## **RESPONSES TO INTERROGATORIES**

### **INTERROGATORY NO.1:**

Identify the Person most knowledgeable Concerning the sale of goods and/or services bearing the TOD'S Mark in the United States.

### **RESPONSE NO. 1**

Opposer objects to this interrogatory on the grounds that it is vague and ambiguous.

Subject to and without waiving those objections, Opposer identifies:

Claudio Castiglioni  
General Brand Manager (Tod's)  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

Stephanie Rothfeld  
Director of Retail (Tod's)  
Deva Inc.  
650 Madison Ave.  
New York, New York 10601

### **INTERROGATORY NO.2:**

Identify the Person most knowledgeable Concerning the advertising, marketing and promotion of goods and/or services bearing the TOD'S Mark in the United States.

### **RESPONSE NO. 2**

Opposer objects to this interrogatory on the grounds that it is vague and ambiguous.

Subject to and without waiving those objections, Opposer identifies:

Claudio Castiglioni  
General Brand Manager (Tod's)  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

Stephanie Rothfeld  
Director of Retail (Tod's)  
Deva Inc.  
650 Madison Ave.  
New York, New York 10601

Stephanie Hamda  
Senior VP Communications  
Deva Inc.  
450 West 15<sup>th</sup> Street  
New York, New York 10011

**INTERROGATORY NO.3:**

Identify every retail outlet that sells and/or offers for sale goods and/or services bearing the TOD'S Mark in the United States.

**RESPONSE NO. 3**

Opposer objects to this interrogatory on the ground that it is overbroad and unduly burdensome and seeks information which is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving those objections, Opposer will produce documents, pursuant to Fed. R. Civ. P. 33(d), from which the answer to this interrogatory as reasonably construed can be derived.

**INTERROGATORY NO.4:**

Identify every Person with knowledge of any instance of confusion as between goods and/or services bearing the TOD'S Mark and goods and/or service bearing Applicant's Mark.

**RESPONSE NO. 4**

Opposer objects to this interrogatory on the grounds that it is overbroad and unduly burdensome. Subject to and without waiving those objections, Opposer identifies:

Stephanie Rothfeld  
Director of Retail (Tod's)  
Deva Inc.  
650 Madison Ave.  
New York, New York 10601

Silvia Pinotti  
Advertising Planner Associate for Online Commerce  
Tod's S.p.A.  
Corso Venezia 30  
Milan 29121  
ITALY

**INTERROGATORY NO.5:**

State the date on which You first became aware of Applicant.

**RESPONSE NO. 5**

Opposer objects to this interrogatory on the grounds that it is vague and ambiguous, overbroad and unduly burdensome and seeks information which is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving those objections, Opposer states that despite reasonable inquiry it is unable to identify a date on which Opposer first became aware of Applicant inasmuch, among other things, Opposer is an organization comprised of numerous individuals each of which may or may not have obtained awareness of Applicant at different times and under different circumstances.

**INTERROGATORY NO.6:**

Describe the circumstances under which You first became aware of Applicant, and Identify the Person(s) who first became aware of Applicant.

**RESPONSE NO. 6**

Opposer objects to this interrogatory on the grounds that it is vague and ambiguous, overbroad and unduly burdensome and seeks information which is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving those objections, Subject to and without waiving those objections, Opposer states that despite reasonable inquiry it is unable to describe the circumstances under which Opposer first became aware of Applicant inasmuch, among other things, Opposer is an organization comprised of



numerous individuals each of which may or may not have obtained awareness of Applicant at different times and under different circumstances.

**INTERROGATORY NO.7:**

State the date on which You first became aware of Applicant's Mark.

**RESPONSE NO. 7**

Opposer objects to this interrogatory on the grounds that it is vague and ambiguous, overbroad and unduly burdensome and seeks information which is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving those objections, Opposer states that despite reasonable inquiry it is unable to identify a date on which Opposer first became aware of Applicant's Mark inasmuch, among other things, Opposer is an organization comprised of numerous individuals each of which may or may not have obtained awareness of Applicant's Mark at different times and under different circumstances.

**INTERROGATORY NO.8:**

Describe the circumstances under which You first became aware of Applicant's Mark, and Identify the Person(s) who first became aware of Applicant's Mark.

**RESPONSE NO. 8**

Opposer objects to this interrogatory on the grounds that it is vague and ambiguous, overbroad and unduly burdensome and seeks information which is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving those objections, Opposer states that despite reasonable inquiry it is unable to describe the circumstances under which Opposer first became aware of Applicant's Mark inasmuch, among other things, Opposer is an organization comprised of numerous individuals each of which may

or may not have obtained awareness of Applicant's Mark at different times and under different circumstances.

**INTERROGATORY NO.9:**

State the date on which you first became aware of Applicant's Mark being used on the goods that are the subject of the Application.

**RESPONSE NO. 9**

Opposer objects to this interrogatory on the grounds that it is vague and ambiguous, overbroad and unduly burdensome and seeks information which is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving those objections, Opposer states that despite reasonable inquiry it is unable to identify a date on which Opposer first became aware of Applicant's Mark being used on the goods that are the subject of the Application inasmuch, among other things, Opposer is an organization comprised of numerous individuals each of which may or may not have obtained awareness of Applicant's Mark being used on the goods that are the subject of the Application at different times and under different circumstances.

**INTERROGATORY NO.10:**

Describe the circumstances under which You first became aware of Applicant's Mark being used on the goods that are the subject of the Application, and Identify the Person(s) who first became aware of such use.

**RESPONSE NO. 10**

Opposer objects to this interrogatory on the grounds that it is vague and ambiguous, overbroad and unduly burdensome and seeks information which is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving those objections, Opposer states that despite reasonable inquiry it is unable to identify a date on which

Opposer first became aware of Applicant's Mark being used on the goods that are the subject of the Application inasmuch, among other things, Opposer is an organization comprised of numerous individuals each of which may or may not have obtained awareness of Applicant's Mark being used on the goods that are the subject of the Application at different times and under different circumstances.

**INTERROGATORY NO.11:**

Identify any Market Research, brand recognition studies or similar research conducted by You or on by any Person on Your behalf regarding public perception of the TOD'S Mark in the United States.

**RESPONSE NO. 11**

Opposer objects to this interrogatory on the grounds that it is vague and ambiguous, overbroad and unduly burdensome and seeks information which is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving those objections, Opposer will produce documents, pursuant to Fed. R. Civ. P. 33(d), from which the answer to this interrogatory as reasonably construed can be derived.

**INTERROGATORY NO.12:**

Identify the Person most knowledgeable Concerning any Market Research, brand recognition studies or similar research conducted by You or on by any Person on Your behalf regarding public perception of the TOD'S Mark in the United States.

**RESPONSE NO. 12**

Opposer objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving those objections, Opposer identifies:

Claudio Castiglioni  
General Brand Manager (Tod's)  
Tod's S.p.A.  
Corso Venezia 30

Milan 29121  
ITALY

Stephanie Rothfeld  
Director of Retail (Tod's)  
Deva Inc.  
650 Madison Ave.  
New York, New York 10601

Dated: New York, New York  
February 4, 2015

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.  
Attorneys for Opposer

By: 

Richard S. Mandel  
1133 Avenue of the Americas  
New York, New York 10036-6799  
(212) 790-9200

**VERIFICATION**

On behalf of Opposer, Claudio Castiglioni declares as follows: I am General Brand Manager (Tod's) for Opposer Tod's S.p.A. and am authorized to make this verification on behalf of Opposer; I have read the foregoing Opposer's Responses to Applicant's First Set of Interrogatories and know the responses set forth therein to be true and accurate to the best of my knowledge and belief. I declare under penalty of perjury under the laws of the United States that the foregoing is true and accurate.

Dated: Milan, Italy  
February \_\_, 2015

  
\_\_\_\_\_  
CLAUDIO CASTIGLIONI

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the attached Opposer's Responses to Applicant's First Set of Interrogatories Directed to Opposer Tod's S.P.A. by mailing a copy thereof by first class mail, postage prepaid, on Applicant's counsel of record on February 6, 2015 addressed as follows:

Louis S. Ederer, Esq.  
Arnold & Porter LLP  
555 12th St NW, Suite 100  
Washington, D.C. 20004-1206

Louis S. Ederer, Esq.  
Arnold & Porter LLP  
399 Park Avenue  
New York, New York 10022

  
RICHARD S. MANDEL, ESQ.

# **EXHIBIT 36**

F 12000002858

(Requestor's Name)

(Address)

(Address)

(City/State/Zip/Phone #)

☐ PICK-UP

☐ WAIT

☐ MAIL

(Business Entity Name)

(Document Number)

Certified Copies \_\_\_\_\_ Certificates of Status \_\_\_\_\_

Special Instructions to Filing Officer:

Richard Spata gave  
authorization to correct  
#4.

Office Use Only

4099-

W12000016954



100225141851

03/23/12--01027--006 \*\*70.00

12 JUL 10 PM 4:19

FILED  
CLERK OF STATE  
DIVISION OF CORPORATIONS

CP 7/10/12



## COVER LETTER

**TO:** New Filing Section  
Division of Corporations

**SUBJECT:** Deva, Inc.

Name of corporation - must include suffix

Dear Sir or Madam:

The enclosed "Application by Foreign Corporation for Authorization to Transact Business in Florida," "Certificate of Existence," or "Certificate of Good Standing" and check are submitted to register the above referenced foreign corporation to transact business in Florida.

Please return all correspondence concerning this matter to the following:

Richard Spata

Name of Person

Deva, Inc.

Firm/Company

450 West 15th Street

Address

New York, NY 10011

City/State and Zip code

r.spata@todsgroup.com

E-mail address: (to be used for future annual report notification)

For further information concerning this matter, please call:

Richard Spata

Name of Person

at ( 212 ) 223-2466

Area Code & Daytime Telephone Number

**STREET/COURIER ADDRESS:**

New Filing Section  
Division of Corporations  
Clifton Building  
2661 Executive Center Circle  
Tallahassee, FL 32301

**MAILING ADDRESS:**

New Filing Section  
Division of Corporations  
P.O. Box 6327  
Tallahassee, FL 32314

12 JUL 10 PM 4:19  
RECEIVED  
DIVISION OF STATE  
CORPORATIONS

Enclosed is a check for the following amount:

☒ \$70.00 Filing Fee

☐ \$78.75 Filing Fee &  
Certificate of Status

☐ \$78.75 Filing Fee &  
Certified Copy

☐ \$87.50 Filing Fee,  
Certificate of Status &  
Certified Copy



FLORIDA DEPARTMENT OF STATE  
Division of Corporations

May 1, 2012

RICHARD SPATA  
450 WEST 15TH STREET  
NEW YORK, NY 10011

SUBJECT: TOD'S DEVA, INC.  
Ref. Number: W12000016954

We have received your document for TOD'S DEVA, INC. and your check(s) totaling \$70.00. However, the document has not been filed and is being retained in this office for the following:

You failed to make the correction(s) requested in our previous letter.

A certificate of existence or a certificate of good standing, dated no more than 90 days prior to the delivery of the application to the Department of State, duly authenticated by the secretary of state or other official having custody of the records in the jurisdiction under the laws of which it is incorporated/organized, must be submitted to this office. A translation of the certificate under oath of the translator must be attached to a certificate which is in a language other than the English language. A photocopy of this certificate is not acceptable.

If you have any further questions concerning your document, please call (850) 245-6052.

Claretha Golden  
Regulatory Specialist II  
New Filing Section

Letter Number: 412A00013172

FILED  
SECRETARY OF STATE  
DIVISION OF CORPORATIONS  
12 JUL 10 PM 4: 19



FLORIDA DEPARTMENT OF STATE  
Division of Corporations

March 26, 2012

RICHARD SPATA  
450 WEST 15TH STREET  
NEW YORK, NY 10011

SUBJECT: DEVA, INC.  
Ref. Number: W12000016954

We have received your document for DEVA, INC. and your check(s) totaling \$70.00. However, the enclosed document has not been filed and is being returned for the following correction(s):

The name of your corporation is not available in Florida. An out-of-state corporation whose name is not available must adopt an alternate corporate name for use in Florida. The alternate corporate name must contain "Incorporated," "Company," "Corporation," "Inc.," "Co.," "Corp.," "Inc.," "Co.," or "Corp." Please enter the alternate corporate name in the space provided in number one of the application.

Simply adding "of Florida" or "Florida" to the end of a name is not acceptable.

A certificate of existence or a certificate of good standing, dated no more than 90 days prior to the delivery of the application to the Department of State, duly authenticated by the secretary of state or other official having custody of the records in the jurisdiction under the laws of which it is incorporated/organized, must be submitted to this office. A translation of the certificate under oath of the translator must be attached to a certificate which is in a language other than the English language. A photocopy of this certificate is not acceptable.

Please return the corrected original and one copy of your document, along with a copy of this letter, within 60 days or your filing will be considered abandoned.

If you have any questions concerning the filing of your document, please call (850) 245-6052.

Claretha Golden  
Regulatory Specialist II  
New Filing Section

Letter Number: 312A00010213

REC-111111  
12 APR 25 AM 10:31  
DIVISION OF CORPORATIONS

FILED  
SECRETARY OF STATE  
DIVISION OF CORPORATIONS  
12 JUL 10 PM 4:19

**APPLICATION BY FOREIGN CORPORATION FOR AUTHORIZATION TO TRANSACT  
BUSINESS IN FLORIDA**

*IN COMPLIANCE WITH SECTION 607.1503, FLORIDA STATUTES, THE FOLLOWING IS SUBMITTED TO  
REGISTER A FOREIGN CORPORATION TO TRANSACT BUSINESS IN THE STATE OF FLORIDA.*

1. Deva, Inc.  
(Enter name of corporation; must include "INCORPORATED," "COMPANY," "CORPORATION,"  
"Inc.," "Co.," "Corp.," "Inc.," "Co.," or "Corp.")

Tod's Deva, Inc.

(If name unavailable in Florida, enter alternate corporate name adopted for the purpose of transacting business in Florida)

2. Delaware 3. 13-3393010  
(State or country under the law of which it is incorporated) (FEI number, if applicable)

4. 11/20/1986 5. Perpetual  
(Date of incorporation) (Duration: Year corp. will cease to exist or "perpetual")

6. January 1, 2012  
(Date first transacted business in Florida, if prior to registration)  
(SEE SECTIONS 607.1501 & 607.1502, F.S., to determine penalty liability)

7. 450 West 15th Street, New York, NY 10011  
(Principal office address)

450 West 15th Street, New York, NY 10011  
(Current mailing address)

8. Retail sales ship to Florida customers. Related Corp. has store in Florida.  
(Purpose(s) of corporation authorized in home state or country to be carried out in state of Florida)

9. Name and street address of Florida registered agent: (P.O. Box NOT acceptable)

Name: NRAI SERVICES, INC.

Office Address: 515 East Park Avenue

Tallahassee, Florida 32301  
(City) (Zip code)

10. Registered agent's acceptance:

*Having been named as registered agent and to accept service of process for the above stated corporation at the place designated in this application, I hereby accept the appointment as registered agent and agree to act in this capacity. I further agree to comply with the provisions of all statutes relative to the proper and complete performance of my duties, and I am familiar with and accept the obligations of my position as registered agent.*

NRAI SERVICES, INC.

By Jessica Metzger, JESSICA METZGER, ASSISTANT SECRETARY  
(Registered agent's signature)

11. Attached is a certificate of existence duly authenticated, not more than 90 days prior to delivery of this application to the Department of State, by the Secretary of State or other official having custody of corporate records in the jurisdiction under the law of which it is incorporated.

FILED  
SECRETARY OF STATE  
RECORDS & CORPORATIONS  
12 JUL 10 PM 4:19

12. Names and business addresses of officers and/or directors:

FILED  
SECRETARY OF STATE  
DIVISION OF CORPORATIONS

**A. DIRECTORS**

Chairman: Stefano Sincini

12 JUL 10 PM 4:19

Address: 450 West 15th Street, New York, NY 10011

Vice Chairman: Claudio Castiglioni

Address: 450 West 15th Street, New York, NY 10011

Director: Marco Giacometti

Address: 450 West 15th Street, New York, NY 10011

Director: \_\_\_\_\_

Address: \_\_\_\_\_

**B. OFFICERS**

President: Marco Giacometti

Address: 450 West 15th Street, New York, NY 10011

Vice President: \_\_\_\_\_

Address: \_\_\_\_\_

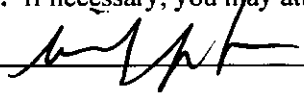
Secretary: \_\_\_\_\_

Address: \_\_\_\_\_

Treasurer: Richard Spata

Address: 10 Bernard Drive, Howell, NJ 07731

**NOTE:** If necessary, you may attach an addendum to the application listing additional officers and/or directors.

13.  \_\_\_\_\_  
Signature of Director or Officer

The officer or director signing this document (and who is listed in number 12 above) affirms that the facts stated herein are true and that he or she is aware that false information submitted in a document to the Department of State constitutes a third degree felony as provided for in s.817.155, F.S.

14. RICHARD SPATA / CFO \_\_\_\_\_  
(Typed or printed name and capacity of person signing application)

# Delaware

PAGE 1

*The First State*

I, JEFFREY W. BULLOCK, SECRETARY OF STATE OF THE STATE OF DELAWARE, DO HEREBY CERTIFY "DEVA, INC." IS DULY INCORPORATED UNDER THE LAWS OF THE STATE OF DELAWARE AND IS IN GOOD STANDING AND HAS A LEGAL CORPORATE EXISTENCE SO FAR AS THE RECORDS OF THIS OFFICE SHOW, AS OF THE NINETEENTH DAY OF JUNE, A.D. 2012.

AND I DO HEREBY FURTHER CERTIFY THAT THE SAID "DEVA, INC." WAS INCORPORATED ON THE TWENTIETH DAY OF NOVEMBER, A.D. 1986.

AND I DO HEREBY FURTHER CERTIFY THAT THE FRANCHISE TAXES HAVE BEEN PAID TO DATE.

FILED  
SECRETARY OF STATE  
DIVISION OF CORPORATIONS  
12 JUL 10 PM 4:19

2108196 8300

120753062

You may verify this certificate online  
at [corp.delaware.gov/authver.shtml](http://corp.delaware.gov/authver.shtml)



  
Jeffrey W. Bullock, Secretary of State  
AUTHENTICATION: 9653297

DATE: 06-19-12

**2013 FOREIGN PROFIT CORPORATION ANNUAL REPORT**

DOCUMENT# F12000002858

**Entity Name:** TOD'S DEVA, INC.**Current Principal Place of Business:**450 WEST 15TH STREET  
NEW YORK, NY 10011**Current Mailing Address:**450 WEST 15TH STREET  
NEW YORK, NY 10011**FEI Number:** 13-3393010**Certificate of Status Desired:** No**Name and Address of Current Registered Agent:**NRAI SERVICES, INC.  
515 E. PARK AVE.  
TALLAHASSEE, FL 32301 US*The above named entity submits this statement for the purpose of changing its registered office or registered agent, or both, in the State of Florida.***SIGNATURE:**\_\_\_\_\_  
Electronic Signature of Registered Agent\_\_\_\_\_  
Date**Officer/Director Detail :**

Title	D
Name	SINCINI, STEFANO
Address	450 WEST 15TH STREET
City-State-Zip:	NEW YORK NY 10011

Title	D
Name	CASTIGLIONI, CLAUDIO
Address	450 WEST 15TH STREET
City-State-Zip:	NEW YORK NY 10011

Title	PD
Name	GIACOMETTI, MARCO
Address	450 WEST 15TH STREET
City-State-Zip:	NEW YORK NY 10011

Title	T
Name	SPATA, RICHARD
Address	10 BERNARD DRIVE
City-State-Zip:	HOWELL NJ 07731

*I hereby certify that the information indicated on this report or supplemental report is true and accurate and that my electronic signature shall have the same legal effect as if made under oath; that I am an officer or director of the corporation or the receiver or trustee empowered to execute this report as required by Chapter 607, Florida Statutes; and that my name appears above, or on an attachment with all other like empowered.*

**SIGNATURE:** RICHARD SPATA

CFO

01/08/2013

\_\_\_\_\_  
Electronic Signature of Signing Officer/Director Detail\_\_\_\_\_  
Date

**2014 FOREIGN PROFIT CORPORATION ANNUAL REPORT**

DOCUMENT# F12000002858

**Entity Name:** TOD'S DEVA, INC.

**Current Principal Place of Business:**

450 WEST 15TH STREET  
NEW YORK, NY 10011

**Current Mailing Address:**

450 WEST 15TH STREET  
NEW YORK, NY 10011

**FEI Number: 13-3393010**

**Certificate of Status Desired:** No

**Name and Address of Current Registered Agent:**

NRAI SERVICES, INC.  
1200 SOUTH PINE ISLAND ROAD  
PLANTATION, FL 33324 US

*The above named entity submits this statement for the purpose of changing its registered office or registered agent, or both, in the State of Florida.*

**SIGNATURE:**

Electronic Signature of Registered Agent

Date

**Officer/Director Detail :**

Title D  
Name SINCINI, STEFANO  
Address 450 WEST 15TH STREET  
City-State-Zip: NEW YORK NY 10011

Title T  
Name SPATA, RICHARD  
Address 10 BERNARD DRIVE  
City-State-Zip: HOWELL NJ 07731

Title CEO  
Name LORENZINI, ROBERTO  
Address C/O DEVA, INC.  
450 WEST 15TH ST. 501  
City-State-Zip: NEW YORK NY 10011

*I hereby certify that the information indicated on this report or supplemental report is true and accurate and that my electronic signature shall have the same legal effect as if made under oath; that I am an officer or director of the corporation or the receiver or trustee empowered to execute this report as required by Chapter 607, Florida Statutes; and that my name appears above, or on an attachment with all other like empowered.*

**SIGNATURE: RICHARD SPATA**

**CFO**

**03/01/2014**

Electronic Signature of Signing Officer/Director Detail

Date



**2015 FOREIGN PROFIT CORPORATION ANNUAL REPORT**

DOCUMENT# F12000002858

**Entity Name:** TOD'S DEVA, INC.

**Current Principal Place of Business:**

450 WEST 15TH STREET  
NEW YORK, NY 10011

**Current Mailing Address:**

450 WEST 15TH STREET  
NEW YORK, NY 10011

**FEI Number: 13-3393010**

**Certificate of Status Desired:** No

**Name and Address of Current Registered Agent:**

NRAI SERVICES, INC.  
1200 SOUTH PINE ISLAND ROAD  
PLANTATION, FL 33324 US

*The above named entity submits this statement for the purpose of changing its registered office or registered agent, or both, in the State of Florida.*

**SIGNATURE:**

Electronic Signature of Registered Agent

Date

**Officer/Director Detail :**

Title D  
Name SINCINI, STEFANO  
Address 450 WEST 15TH STREET  
City-State-Zip: NEW YORK NY 10011

Title T  
Name SPATA, RICHARD  
Address 10 BERNARD DRIVE  
City-State-Zip: HOWELL NJ 07731

Title CEO  
Name LORENZINI, ROBERTO  
Address C/O DEVA, INC.  
450 WEST 15TH ST. 501  
City-State-Zip: NEW YORK NY 10011

*I hereby certify that the information indicated on this report or supplemental report is true and accurate and that my electronic signature shall have the same legal effect as if made under oath; that I am an officer or director of the corporation or the receiver or trustee empowered to execute this report as required by Chapter 607, Florida Statutes; and that my name appears above, or on an attachment with all other like empowered.*

**SIGNATURE: RICHARD SPATA**

**CFO**

**01/06/2015**

Electronic Signature of Signing Officer/Director Detail

Date